United States Court of Appeals

for the Second Circuit

APPENDIX

76-7041

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

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Appeal No. 76-7041

GEORGE LERNER and
JULIUS ELLMAN,

Plaintiffs-Appellants,

-against-

CHILD GUIDANCE PRODUCTS, INC. and
QUESTOR CORPORATION,

Defendants-Appellees.

Appeal From the United States District Court
For The Southern District of New York

Honorable William C. Conner, District Judge

PLAINTIFFS-APPELLANTS' APPENDIX

VOLUME II

PAUL J. SUTTON
BARRY G. MAGIDOFF

Attorneys for
Plaintiffs-Appellants

MISKIN & SUTTON
521 Fifth Avenue
New York, N.Y. 10017

Of Counsel.

UNITED STATES COURT OF APPEALS
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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

GEORGE LERNER, et ano. Plaintiffs vs. CHILD GUIDANCE PRODUCTS, INC., et ano. Defendants.	Before: HON. WILLIAM C. CONNOR, District Judge. 73 Civ. 2006

New York, December 15,16,17, 1975

STENOGRAPHER'S MINUTES

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF NEW YORK

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GEORGE LERNER, et ano.,

Plaintiffs

vs. 73 Civ. 2006

CHILD GUIDANCE PRODUCTS, INC., et ano.,

Defendants.

----------x

Before:

HON. WILLIAM C. CONNOR,

District Judge

New York, N. Y.
December 15, 1975 - 10 a.m.

APPEARANCES:

PAUL J. SUTTON, ESQ.
Attorney for the Plaintiff

HAYS, ST. JOHN, ABRAMSON & HEILBRON, ESQS.
Attorneys for the Defendant
By: ELIAS MESSING, ESQ.
ROBERT B. RUSSELL, ESQ.
DONALD D. BAHR, ESQ.
ELMER GORN, ESQ.

(In open court.)

(The case was called by the Clerk.)

THE CLERK: Are you ready?

MR. SUTTON: The plaintiff is ready.

MR. MESSING: The defendant is ready.

(A jury was duly impaneled and sworn.)

(Two alternate jurors were sworn.)

THE COURT: I am going to make first a few general remarks about the order of proceedings, so you will know what to expect as we go along. As I indicated a moment ago, this trial is going to be divided into two parts. The first part will involve the issue of patent infringement, that is the question whether the patent claims cover these two accused devices.

I use the term patent claims, and I better tell you that a patent is divided into several parts. I have here in my hand a copy of the patent in suit. This is what is called a soft copy. In other words, it is just a printed copy which anybody can buy by writing to the patent office and paying 50 cents. The first sheet of it consists of the drawings of the patented device, or a typical device of the type covered by the patent. Then the next two pages, or not quite two pages consist of the specifications of the patent, and this is a description of the invention

with particular reference to the illustrative device shown in the patent drawing. And then the patent concludes with the claims which start at the bottom of the second page of text and go over onto the third page, and there are twelve claims, and the claims are brief statements of what the patentee considers to be his invention. In other words, they define the invention in specific words or terms. Each one of those claims constitutes, in effect, a separate patent and each must be considered independently of the others, except where a claim is made dependent on another claim.

There are two independent claims in the patent. That is, they are claims which are complete in and of themselves, and those are claims one and seven. Then there are a number of dependent claims which refer back to those two claims. For example, claim two reads, "a toy musical instrument as defined in claim one wherein", and so forth. So it incorporates by reference everything that is in claim one, and adds some additional elements or description. So claim two is not infringed unless claim one is infringed, and in addition the added elements or description in claim two must also apply to the accused device, or their equivalents must be present in the accused device.

There are two ways to infringe a claim. One is literal infringement, that is the words of the claims apply word for word on the device which is accused to infringe. The other kind of infringement is infringement under what we call the doctrine of equivalence. If you cannot find an element called for in the claim in the accused device, the accused device may still infringe if it contains the equivalent of what is described in that part of the claim. I will explain all of this in greater detail when I make my final instructions or charge. But I wanted you to understand at least a few of the terms we will be using during the trial, so that you won't be completely mystified as the evidence goes in, and will be able to follow it a little better.

Now, the second part of the trial will be devoted to the question whether the patent is valid. The patent may be invalid if any of the claims can be read element for element, that is, if all of the elements apply literally to a prior patent or publication. The claims also may be invalid if they do not read element for element on the prior patent or publication, but if the differences between the claimed invention and the prior art would have been obvious at the time the invention was made to a person having ordinary skill in the art.

I will explain all of these standards a little bit more in detail at the time of my final charge. Don't try to memorize what I have said. I am giving you just a little preview of what the case is going to be about. We will begin with opening statements by the attorneys, in which they will tell you what they think the evidence will show. Those opening statements are not evidence in the case. They are merely a hopeful indication by the attorneys as to what they expect the evidence will or will not show. When you go to make your verdict, you disregard what the counsel have told you in their opening statements, and base your verdict only upon the actual evidence which will come to you in the form of testimony from witnesses in the witness box, and from the exhibits that will be introduced into evidence during the trial, either physical exhibits such as the accused toys themselves or documentary exhibits such as the patent in suit and the prior patents which are being relied upon either to invalidate the patent in suit or to require a narrower construction of the terms of the patent claims.

In addition, there are certain stipulations of fact that have been made by counsel. A stipulation of fact is merely an agreement between counsel that a certain set of facts exists. That stipulation is binding upon the jury,

and no evidence is required because the facts stipulated must be deemed as having already been established without the introduction of any evidence.

After the opening statements have been concluded we will begin with the actual introduction of evidence in the case. The plaintiff, having the burden of proof on the issue of infringement, will put in its evidence first. After its case is closed, then the defendant will have a chance to put in its evidence, and then the plaintiff will have an opportunity to put in any rebuttal evidence it desires on the issue of infringement. After that evidence is in, the attorneys will make their final arguments or summations on the issue of infringement. They will, in those summations, attempt to tell you what they think the evidence has or has not shown. Again, those final arguments or summations are not evidence in the case. They are merely the attorneys' version of what the evidence has or has not shown.

After those summations the Court will then give you its final instructions or charge as to the applicable law and legal standards to be applied in determining your verdict, and after that you will retire to the jury room for final consideration of your verdict.

Until you go to the jury room for your final

deliberations, do not discuss the case with your fellow jurors or anyone else. The reason for this is that if you express a point of view early in the case it is sore times difficult or embarrassing to change that point of view. Try to keep an open mind until all of the evidence is in on a particular issue, and then you will retire to the jury room and at that time discuss with your jurors your versions of the evidence and your votes as to the issues of fact to be determined by you in reaching your verdict.

We will have now the opening statement by plaintiff's counsel, Mr. Sutton.

MR. SUTTON: May counsel approach the bench for a second?

THE COURT: Yes.

(At the side bar.)

MR. SUTTON: Do you think it would be more appropriate for his Honor to talk about the limited nature of this trial from the standpoint of the five elements, or can I do that?

THE COURT: You can do that in your summation. I have gone into more detail than I normally do in an opening statement.

MR. RUSSELL: I have a number of copies of the patent in suit. Would you like me to hand one to each of

the jurors, your Honor?

THE COURT: I will permit you to do that after it is introduced in evidence. If you want to do that. I think you have to be careful to make sure they don't sit there reading the patent while the evidence is going in.

MR. RUSSELL: Yes, sir.

(In open court.)

THE COURT: I perhaps should make one further comment by way of explanation. As to the claims of the patent which are charged to be infringed, and about which you will hear testimony, each one of those claims is what we call a combination of elements claim. Each lists a number of elements or features of the invention, and in order to establish infringement of a claim it is necessary to establish that each one of those elements or features or its equivalent is present in the accused device. As to a number of the elements or features that are described in the claims of the patent that are being contested here, counsel have stipulated that those elements are present in the accused devices. We are litigating really about five elements or features of the claims which are not literally present in the accused device, and it will be your function as jurors to determine whether or not the accused devices embody the equivalent of those five elements. Repeating:

What you are going to be determining in this first part of the trial directed to infringement is whether or not these two accused toy musical instruments, the Melody Bell-O-Phone and the Big Mouth Singers, incorporate evuivalents of the five disputed elements of the patent claims.

Mr. Sutton.

MR. SUTTON: Good morning.

The plaintiffs seated before you here, Mr Julius Ellman and Mr. George Lerner, are toy designers, and the plaintiffs will show and attempt to prove to you that they purchased the patent in suit by buying it from the inventor, a Mr. Musser, Dr. Musser. He has an honorary degree in music. They purchased it pursuant to what we will prove to be is a valid assignment or agreement of sale. We will show that after purchasing the patent that is involved in this lawsuit they were unable to sell a device that they originated themselves, called Jolly Jingle Tone. We will show that when they approached the Ideal Toy Company that the Ideal Toy Company would not take their item until they purchased or made some arrangement with the owner of this patent here in suit, and once they did they would then consider it. In fact, we will show that the plaintiffs went out to California or communicated with Mr. Musser, they

purchased the patent, they went back to Ideal and Ideal Toy Company agreed to go ahead with their item, but then thereafter discovered the existence of two items that are involved in this lawsuit that the plaintiffs are claiming infringe the patent in suit, the Big Mouth Singers and the Melody Bell-O-Phone. We will show you the internal workings of both items. The plaintiffs will show you the internal workings of the device covered by the patent in suit, and we will attempt to show that they operate in substantially the same way. They accomplish the same result. They produce the same type of musical sound, what we will call a carillon, or continually ringing sound.

I would like to state in conclusion that it is our understanding of the law that according to a Supreme Court decision of this country --

THE COURT: I will instruct them as to the law. You just tell them what the evidence will show.

MR. SUTTON: Fine. In conclusion, we will show that the devices accused of infringing, namely the Melody Bell-O-Phone and the Big Mouth Singers, operate in the same way and equivalent fashion to the Bell Organ, which is the subject of the patent in suit.

Thank you.

THE COURT: Mr. Russell.

MR. RUSSELL: Good morning.

Ladies and gentlemen, what the defendant intends to show is first that you have hear an art, meaning the art of making musical instruments for toys, in which a great deal has been done years and years ago. All of the elements of the patent in suit was known, were known and used before. This is merely a rehash, we will attempt to show, of everything that was known.

Therefore, in the presentation of our evidence we have here books which represent the prior patents, and we will present evidence to show yourselves that if there was an invention in this device, it has to be very narrowly construed because everything in even the combinations of the claim, and we will come to the claim of the patent, was in the prior art and, therefore, you would, in applying a standard of equivalency, leniency is what that means, you will have to form a restricted view of it.

For instance, my brother has said that the instruments work the same way, they make noise the same way. That form of making the noise was known, and we will show that the inventor, Mr. Musser, actually saw the device which was patented years before, which makes that very same year, this is before he made his invention.

The question of whether or not the learned

who are plaintiffs went and purchased a patent in order to convince a company to take their device, their Jolly Jingle Tone device, we will show that the Ideal Toy Company did not accept it. The patented device was off the market a long time before. This is also evidence to the effect that no major improvement which commanded the market was involved in the patented device.

We are now directing our attention specifically to the issue of equivalence. We will put on as experts two gentlemen that are skilled in the toy musical art, and they will show first that every element and even most of the combinations of the patented claim are in the prior art and, secondly, when it comes to each of the individual elements, you will recall that the Court said that for an infringement to be found you must not -- you must hold every element of the claimed structure to be there. We have found there are five elements which are missing. It has been stipulated there are five elements of the accused structures which are missing from the patent. You have to decide whether what is used in the accused structure is the equivalent. In order to be the equivalent, as it works out, the specific device must do the same work in substantially the same way to accomplish the same result.

Our evidence will show that of these five

elements it does not do the same work, it does not do it in substantially the same way to accomplish the same result, and this is our view which will lead to special holdings of non-equivalence, which would lead to a holding of non-infringement.

JUROR 2: May I ask a question?

THE COURT: Yes.

JUROR 2: Did you say it is not true that the Ideal Toy Company asked them to buy a patent before the Ideal Toy Company would accept that thing?

MR. RUSSELL: I was a bit confused in my wording at that point. Perhaps the Ideal Toy Company told them to do that. We have no way of knowing. What happened was that the Ideal Toy Company did not make the Jolly Jingle Tone, even though they bought the patent. Plaintiffs bought the patent in suit, turned around back to Ideal Toy and said"Now we have it, will you make our device,"and they did not make the Jolly Jingle Tone. They didn't go on the market with it.

THE COURT: We will now take a ten minute mid-morning break. That will give you a chance to get your coats put in the jury room or wherever you want to keep them. We will come back in ten minutes and start the presentation of the actual evidence.

(In open court. Jury present.)

MR. SUTTON: At this time I call one of the plaintiffs, Mr. Julius Ellman, to the stand.

J U L I U S E L L M A N , called as a witness by the plaintiffs, being first duly sworn, testified as follows:

DIRECT EXAMINATION

BY MR. SUTTON:

Q Can you tell us your address, please?

A 1672 East Seventh Street, Brooklyn, New York 11230.

Q How old are you?

A Fifty-three.

Q Are you married?

A Yes.

Q Do you have any children?

A Yes.

Q What do you do for a living, Mr. Ellman?

A I am a professional toy inventor-designer.

Q Can you speak up, please.

A I am a professional toy inventor-designer.

Q Do you work in association with the other plaintiff, Mr. Lerner, in that capacity?

A Yes.

A Yes.

Q How long have you been in the business of designing or inventing toys?

A Approximately twenty years.

MR. SUTTON: At this time I offer plaintiffs' Exhibit No. 1 into evidence, a certified copy of the patent in suit. It has been pre-marked.

MR. RUSSELL: No objection.

(Plaintiffs' Exhibit 1 received in evidence.)

Q I show you Plaintiffs' Exhibit 1, which is a copy of a patent in suit, and I would like to ask you whether you have seen that patent before?

A Yes, I have.

Q Have you read through it before the trial?

A Yes.

Q Do you understand this patent is the subject of this lawsuit?

A Yes.

Q Mr. Ellman, are you or Mr. Lerner the inventor in this patent?

A No.

Q Who is the inventor?

A Dr. Clair Omar Musser.

Q Mr. Ellman, do you and Mr. Lerner own this patent today?

A Yes, we do.

MR. SUTTON: I offer into evidence Plaintiffs' Exhibit No. 2.

MR. RUSSELL: No objection.

(Plaintiffs' Exhibit 2 received in evidence.)

Q I place Plaintiffs' Exhibit No. 2 before you, and ask you whether you have seen that document before?

A Yes, I have.

Q Is that document the means by which you and Mr. Lerner claim in this trial to have become the owners of the patent also before you in this suit?

A Yes, it is.

Q Did you pay money for it, for the patent?

A Yes, we did.

Q How much money did you and Mr. Lerner pay Dr. Musser for the patent in suit?

A $1,000.

Q When did that happen? When did you actually buy this patent?

A I believe it was the spring or summer of 1972.

Q I would like now to briefly get an idea of your

background, and I will ask you whether over the number of years that you have said you have been a toy designer and inventor, whether you have had success with one or more items that you have invented in cooperation with Mr. Lerner?

A Yes, we have.

Q We have a table before me here full of exhibits. Segregating the group of exhibits in front of Mr. Lerner here, immediately prior to this trial did you place these exhibits on the table?

A Yes.

Q Are each of these exhibits, perhaps with the exception of Mr. Potato Head, toys or games or inventions that you with or without Mr. Lerner have played a role in designing and inventing?

A Yes.

Q Have each of these inventions of you and Mr. Lerner been marketed?

A Yes, they have.

Q Are any of them today being marketed?

A Yes, they are.

Q Does any specific one come to mind?

A Particularly one which is currently enjoying a lot of success, and which is on national television right now by Ideal Toy Company, Trap Tennis.

Q This item?

A Yes.

Q Have you and Mr. Lerner obtained patents in the past on your inventions? When I say your inventions, I am talking about either your inventions alone or in collaboration with Mr. Lerner.

A Many times.

MR. RUSSELL: I object to counsel's continuous characterization of things as inventions. I think he should refer to devices,and there is certainly no evidence that they are inventions.

THE COURT: You haven't been listening to the speeches or reading the papers of Judge Giles Rich, the Court of Customs and Patent Appeals. He claims all these things are inventions. The issue is whether they are patentable inventions. I am going to overrule the objection.

Q Directing myself to that specific issue just raised by Mr. Russell, I would like to show you a group of patents and ask you whether you recognize any of them?

A Yes, I recognize all of them.

Q Take your time and look at them. I appreciate that you have seen this before the trial, but I want you to confirm that.

A All right.

Yes, I recognize all of them.

MR. SUTTON: Your Honor, in order to qualify Mr. Ellman as a technical expert, not a patent expert, I offer these. I would like to save a lot of time and trouble. I would like to offer all of these items unless your Honor would like to go through each one of them, as examples of toys and games that have been invented by the plaintiffs and have been marketed by either themselves or companies that they have licensed.

THE COURT: I question whether or not it is really necessary to put them all into evidence. They are here.

MR. SUTTON: Perhaps I will just show one as an example of design.

Q I hand you what is called a Targ-o-Rama, and I would like you to please very quickly show us what this item is. Firstly, did you and Mr. Lerner invent this?

A Yes, we own the patent rights. We invented it and we own the patent on it.

Very briefly, we said this was the world's safest target gun because nothing ever leaves the gun. It has a reciprocating barrel. This was marketed by Hasbro. It works like this. I make it look easy because I practice.

Etcetera.

Q In designing this specific item, Targ-o-Rama, and the other items on the table here, did you and Mr. Lerner have to retain technical people to do the design, or did you and Mr. Lerner cooperate in coming up with prototypes, engineering prototypes at least, in each case?

A In each case all by ourselves.

Q In each case who usually made the engineering prototype that was used in attempting to market your item?

A The finished prototype was usually made by Mr. Lerner.

Q On one or more of these items before you on this table here, that I have characterized broadly as inventions or items that you and Mr. Lerner have designed, have major corporations accepted licenses under your patents to produce them?

A Yes.

Q Have they remunerated you with payments or royalties of one form or another?

A Yes.

Q Mr. Ellman, I would like you to direct yourself to Plaintiff's Exhibit 1, a certified copy of the patent in suit here, and I would like to ask you to turn to the single sheet of drawings of that patent and I ask you

whether you see in Figure 4 the structure corresponding to Plaintiffs pre-marked Exhibit 6 B? Do you see that 6 B is a cutaway of part of Figure 4?

A Yes, I do.

MR. RUSSELL: May counsel approach the bench for a second?

THE COURT: I don't think it is necessary.

Will you stipulate that this is an enlargement of part of Figure 4?

MR. SUTTON: Yes, your Honor. I represent that to the Court, part of the Figure 4.

THE COURT: I understand.

MR. RUSSELL: I don't know what it is, and furthermore --

THE COURT: My question was directed to you. Will you compare it to Figure 4 of the patent and state whether or not it is an enlargement of a part of Figure 4?

MR. SUTTON: I will state and represent to the Court that Mr. Lerner physically made this sketch and this is the encircled item that I encircled and asked him to enlarge so that the jury would be able to see it instead of this small copy of the patent.

MR. RUSSELL: I have another question. That is whether this witness is qualified. I understand my brother

to say he was qualifying him as an expert.

THE COURT: As a technical expert, yes.

MR. RUSSELL: I wanted to approach the bench on should I at this point have any voir dire?

THE COURT: You may, if you want.

MR. RUSSELL: At this point?

THE COURT: If you want. He is offering, I assume, Plaintiffs' Exhibit 6 B in evidence, and I will ask whether you object to its introduction.

MR. RUSSELL: It is the first time I have seen it, your Honor. I would like to see it. I can see that it is substantially the same as a portion of Figure 1.

THE COURT: Figure 4, you mean.

MR. RUSSELL: Right, Judge.

THE COURT: It will be received.

(Plaintiffs' Exhibit 6 B received in evidence.)

THE COURT: If you want voir dire of this witness on technical qualifications, you may proceed.

VOIR DIRE

BY MR. RUSSELL:

Q Mr. Ellman, you have testified that Exhibit 6 B corresponds to the patent in suit to Figure 4 in the patent in suit.

I would like to call your attention, Mr. Ellman, to a statement in your deposition at page 65 and 66, and I will read to you the colloquy that took place, to refresh your recollection of it --

THE COURT: Let me ask you this: Does this relate to his technical qualifications as an expert?

MR. RUSSELL: The witness said that he was not mechanically qualified to testify as to the structure involved in this patent.

MR. SUTTON: I object.

THE COURT: If that is --

MR. RUSSELL: That is what he said.

THE COURT: Don't tell me what he said. If that is the general subject matter of your present inquiry you may proceed.

Q It goes on page 65 "I want to know from this witness if there is any functional importance in having a key support ledge, 16, extending outwardly from the instrument?

"MR. SUTTON: I object to the question because that is not the question you have asked previously.

"MR. RUSSELL: That is not the ground for an objection. You can only object if the question is objectionable.

"MR. SUTTON: I object to the line of questioning.

"Q Would you answer that please.

"A Would you define what you mean by ledge?

"Q You are looking at it, Exhibit E 1, look at Exhibit E 1, would you please, Item 16, the patent in suit.

"A I am not mechanically equipped to define anything here."

I want to know, Mr. Ellman, do you consider that you are mechanically equipped to interpret this drawing, Exhibit 6 B, in the light of your previous statement that you are not mechanically equipped?

MR. SUTTON: Your Honor, we have taken only a portion of the line of questioning. The line of questioning deals with interpretation of claims.

THE COURT: You can go into anything further if you want to, if you are not objecting to the question.

A At that particular time most of the wording used related to patent language. I was not familiar with patent language. We leave that to our attorneys. Since that time I have very carefully gone over the patent lang language. My counsel has helped me to interpret what each word means, and I have carefully studied and believe that I am now in a position to be mechanically able to act as an

expert on my behalf.

Q So in November 20, 1973, the date of your deposition, you were not so qualified?

A At that time I had not even looked at the patent because our counsel said it was a valid patent, it covered the item and that was good enough for us. We didn't spend time going through the patent at that time.

THE COURT: Your statement was "I am not mechanically equipped to define".

THE WITNESS: At that time I was not.

Q You have gotten equipped since then?

A I think so.

Q Isn't it a fact that you never even opened up one of these instruments to look at its insides at the time of your previous deposition in 1973?

A I don't recall. I believe I did. I am almost positive I did, but I don't recall. We work on many items and I don't recall whether I opened it up at that time.

THE COURT: That is not relevant to his qualifications to testify as an expert at this moment.

MR. RUSSELL: I believe, your Honor, the fact that he had never opened up one of these toy musical instruments to look on the inside has something to do with the standing of this man to be able to testify about his

mechanical structure.

THE COURT: I don't believe so. I am going to overrule that part of the proposed examination on voir dire. All we are investigating right now is his qualifications at this moment to testify as a technical expert.

MR. RUSSELL: Thank you, your Honor.

No further voir dire.

DIRECT EXAMINATION CONTINUED

BY MR. SUTTON:

Q Prior to this trial, have you read through that patent in front of you? You have a certified copy in front of you, but did you read through another copy of this patent prior to the trial?

A Yes, I have.

Q Do you believe that you understand how the mechanism that is shown in that patent works as described by the patent?

A Yes, I do.

Q Do you recognize an item that I am going to place my hand on that is entitled Bell Organ, and which has been pre-marked as Plaintiffs' Exhibit 3? Have you seen this before?

A Yes, I have.

MR. SUTTON: I would like to offer Plaintiffs' Exhibit 3 into evidence at this time, and pursue a line of questioning.

MR. RUSSELL: No objection.

(Plaintiffs' Exhibit 3 received in evidence.)

Q What is your understanding that this device, this physical device represents? What is this?

A It is a musical instrument which makes a repetitive bell-like sound, or otherwise known as a carillon sound when you press one of the keys down and the motor is running.

Q Is that the sound you are talking about?

A Yes.

Q Where did this item physically come from? How did I and you happen to come into possession of this item?

A That item was sent to me by Dr. Musser, and I in turn turned it over to you.

Q Did he ask you for money before he turned it over to you, or was this pursuant to your prior understanding?

A We had already, I believe, purchased a patent from him, and then when he found out that we were involved in litigation, he sent it to us.

Q Did it come in this box that I show you?

A Yes.

Q Do you see any patent markings on this box?

A I see it says "Patent Pending" on the box.

Q Did you put that on there?

A No.

Q It was on the box when you received it?

A It is printed on the box.

Q Mr. Ellman, I would like to bring Plaintiffs' Exhibit No. 3, the Bell Organ, over to you, and I hope the jury can see from here that the top of the housing has been taped so that it can be opened, and I would like to ask you how one produces this continuous or carillon sound? Physically how does one obtain that sound when using this toy musical instrument?

A By turning on the motor and pressing the key.

Q Could you please point, for the benefit of the jury, to the motor that you are referring to?

A This is the motor right here.

Q What element or elements when I press down this key which is under the No. 5, where is that sound produced? What causes that sound or tone?

A The key lifts up a resiliently supported tone bar in contact with revolving washers.

Q Let's go back a bit in more detail. I would

like to refer your attention to Plaintiffs' Exhibit 6 B, which is kind of hard for me to see from there, but perhaps if I bring it closer.

THE COURT: The witness may step down. I am not sure the jury can see it from that far away. He can move it closer to the jury, and Mr. Russell may step around so he can see it too if he can.

MR. RUSSELL: Thank you, your Honor.

Q You heard me previously refer to Plaintiffs' Exhibit 6 B as a portion of the Figure 4 of the patent here in suit.

A Yes.

Q Does this, what is shown in Plaintiffs' Exhibit 6 B, substantially accurately show in diagram form the structure that you displayed up there at the witness stand?

A Yes, it does.

Q Could you please point with my red pen to the key that you depressed?

A Right here, Item 28.

Q Could you please point to the tone bar that you referred to as being resiliently mounted on the key?

A 32.

Q When you say resiliently mounted, what is it you are referring to?

A It is actually mounted on sort of rubber supports so that it allows the tone bar to vibrate.

Q Are the rubber supports you are talking about those to which arrows from No. 38 are shown extending?

A Yes.

Q What strikes the tone bar? You talked about washers. Would you please point to the washers and give us the numbers?

A No. 42, the blue sleeve washers come around in rotation and actually strike the tone bar once they are in proper position.

Q What supports these washers?

A They are actually held on by this little bracket, I guess you call it, No. 46.

Q What is 46 attached to?

A To a bar, a continuous bar which is rotated by the motor.

Q What is Item 54 in the drawing?

A That is a belt drive.

Q When you say belt, what would we understand it to be?

A A rubber band, spring, pulley.

Q Is it accurate that the motor drives that long bar or rod to which the washers are attached by means of

that rubber band?

A Is it accurate?

Q Yes, is that an accurate statement?

A Yes.

Q I would like to ask you, is the key shown in its resting position here in this figure?

A Yes, it is.

Q Where is it supported? Is it supported in more than one point?

A In the resting position it is actually supported in two places.

Q Please point to the places where it is supported.

A No. 22 and No. 26.

Q No. 22 supports one end of the key?

A Yes.

Q And No. 26 supports a portion somewhere midway between the other and the end we just referred to?

A Yes.

MR. SUTTON: I offer Plaintiffs' pre-marked Exhibit 6 C, which has been constructed by Mr. Lerner to schematically show the operation in enlarged form, for the purpose of the jury being able to see it, of the motion that we are now describing with reference to Plaintiffs' Exhibit 6 B.

MR. RUSSELL: I have no objection, your Honor, as long as it is understood that it is not evidence in itself, it is merely used to elaborate and characterize the witness's testimony.

MR. SUTTON: I am going to use this for purposes of showing the jury and those present what is within the device that is Plaintiffs' Exhibit 3 on the witness stand, not that this chart is an infringing item or is evidence other than that.

THE COURT: It will be received as a working model, not to scale, of the device shown in the patent drawing.

MR. RUSSELL: Incompletely showing.

MR. SUTTON: This is only a portion of the device that we are examining as Plaintiffs' Exhibit 3.

Q Have you seen this before, Mr. Ellman?

A Yes, I have.

Q Have you seen this at my offices prior to this trial today?

A Yes.

Q Is this long blue object, is that long blue object corresponding to the key that you previously referred to as Item No. 28?

A Yes.

Q Would you please press that key and tell us in your own words what happens when we press the key?

A I press the key and up to the stop point over here or resting point, which brings the tone bar in just the right proximity with these loose washers that are going around in circle.

Q When you say it brings it to a right point, what would happen if this stop point, and so every one can see I am going to remove the stop point and ask you to again press the key and tell us what would happen without the stop point.

A I would go right in and stop the whole thing from working, and hamper the sound. It would clog the works. It would not work.

Q But by replacing the stop point as you referred to it, the limit of movement of the key or the motion of the key is limited, is that correct?

A Yes, sir.

Q Does this key pivot?

A Yes, it does.

Q It is shown in this model as being connected by a rivet. Referring now to the drawing, tell us how the key 28 in the drawing is pivoted such as in the device that Dr. Musser has come up with.

A The key is resting right on this little protrusion No. 26, resting right on there.

Q Is that an upstanding projection, 26?

A Yes, it is.

Q Looking at this drawing, do you see how this key extends from the inside of the housing out to where it would be played? Does it extend through any kind of opening?

A Yes, it does. There would have to be an opening right here.

Q I would now like to show you a device pre-marked Plaintiffs' Exhibit No. 4, and I ask you whether you have seen this device entitled Big Mouth Singers before?

A Yes, I have.

MR. SUTTON: I have one item marked Plaintiffs' Exhibit 4, and I have another one which I have taken the screws out so I can take apart and I have another item which is intact.

I would like, for the purpose of the trial, to offer only the one item and we can show in its companion how the device works. I offer into evidence at this point Plaintiffs' Exhibit 4.

THE COURT: Is that the one that has the screws removed?

MR. SUTTON: Yes, this is the one where the top can be removed.

THE COURT: I would suggest that with respect to any further exhibit that they be shown in advance to the other side so that they can make their inspection and determine whether they want to object to the introduction of the exhibit.

MR. SUTTON: These have, your Honor.

Let the record show that opposing counsel has snapped keys that I removed prior to the trial back onto the rod by simply pushing them down on the rod, and I will go into this in more detail in a second.

MR. RUSSELL: I have no objection to Exhibit 4, nor do I have objection to counsel adding a further Exhibit 1. Exhibit 4 is the open one so you can open it up and see what is inside. The other one in its assembled state can be used as Exhibit 4 A.

What is the purpose of the second one?

MR. SUTTON: This willbecome more apparent in a second. I am taking keys out of Plaintiffs' Exhibit 4 and those keys once out won't be able to be played.

MR. RUSSELL: I have no objection to 4 as it stands, and the second one I guess the purpose will arise.

MR. SUTTON: We can make it 4 A, whichever the

Court pleases.

THE COURT: It is up to you.

(Plaintiffs' Exhibit 4 received in evidence.)

Q Have you seen this device before?

A Yes, I have.

Q I have just put the top back on the other item and I want to ask you if you can hear me play the sound?

A Yes, I hear it.

Q Is the sound similar to the sound produced by the Bell Organ, Plaintiffs' Exhibit 3?

A Yes, it is.

Q In addition to the mechanism that produces the sound, do you see any decorative features on the top of the Big Mouth Singers?

A I do.

Q Do you see when I press down these keys that mouth, I assume corresponding to the name Big Mouth, open on the figures above the mechanism?

A Yes.

Q Have you examined this item prior to this trial?

A Yes, I have.

Q Can you tell us whether the opening of these mouths for decorative purposes, plays any role in the

working of the mechanism?

A No, it does not.

Q I would like now to press down the starting button of Plaintiffs' Exhibit 4, and I ask you in front of the jury to press the key or any key down to its limit. What happened just then?

A You took away the stop so I can't get the sound. I stopped it.

Q Can you do that with all the keys and see if that is the case?

A Each one, yes.

Q Is it your testimony that some sort of limit or stop is required in order for this type of device to function properly?

A Yes.

Q I am now going to place the cover back on the item, and I hope I can do it quickly, and without bothering with the screws, when I press the item button, would you please again press the corresponding keys. They seem to work now, don't they?

A Yes.

Q Why is that? What stops or limits the movement of the keys in the device Plaintiffs' Exhibit 4?

A There is a stop provided in the cover right here,

sort of a stopping point. You push it down and it stops. There is no way to go beyond that. It just stops right there.

Q Let's talk about the stop that you are referring to. I would like to refer to Plaintiffs' Exhibit 6 B, which is a portion of Figure 4 of the patent. Now we are dealing with the Musser device. That is the device covered by the patent that you purchased, you and Mr. Lerner. What provides the stop for the key in the Musser device? We didn't have that problem with the rotating rods stopping working in the Musser device. What stopped the key from rotating beyond its permissible limit?

A This resting point 16 here.

Q Is that 16, or does that 16 correspond to anything on this model here?

A Yes, this little yellow piece here.

Q Is it critical that the stop that we just referred to as limiting the movement of the keys so it functions properly be in this exact position, or can a designer choose an alternate position for a stop to prevent the key from going too far?

A There are many alternate positions.

Q In fact, can I not, and this was prearranged for the benefit of those in court, I am going to take the

stop and placing it in another position in a pre-punched hole, and by pressing the key you see that the placement, the exact placement of the stop is not critical in terms of being in one specific location.

A That is correct.

MR. RUSSELL: I object, your Honor. This is counsel testifying as to what is or is not critical, your Honor.

THE COURT: Yes. Your questions are quite leading.

Q Mr. Ellman, I show you once again the Musser device, Plaintiffs' Exhibit 3, the Bell Organ, and ask you to press the key and ask you to describe what happens.

A When I press the key I hit a stop. I can't press any further, and the tone bar is brought in to contact with the revolving washers. I am pressing very hard, putting a lot of pressure on this, and I can't go any further.

Q What causes that key to stop at that point in the device you are holding in your hand, Plaintiffs' Exhibit 3?

A There are stopping points provided under each one of these keys.

Q You say stopping points. Do you recognize any

specific language in reading through the patent that those stopping points are referred to?

A A ledge on which these keys come to rest.

Q I would like to show you the Melody Bell-O-Phone, Plaintiffs' Exhibit 5, and ask you whether you recognize that item?

A I do.

MR. SUTTON: I offer this item into evidence at this time to pursue a line of questioning.

MR. RUSSELL: I do object to this one, your Honor. There are several problems involved. It is not the same construction as the one we have.

Are you planning to complete the exhibit? It does not have the keys or anything.

MR. SUTTON: Yes. I believe the Court's copy does have the keys in place and at this time I would like to read --

MR. RUSSELL: I would have no objection to the Court's copy.

MR. SUTTON: I am introducing this copy as one marked by the defendants, and I would like to read from the stipulated agreed facts, Item No. 12, Defendant corporations have admitted selling both the Big Mouth Singers device and the Melody Bell-O-Phone ddvice, and whether there are one

or more constructions of the Melody Bell-O-Phone or not, that is another issue. We would be happy to look at other items that have been marketed, but this is an item that has been marketed by the defendant corporations.

THE COURT: What about it, Mr. Russell, do you find to be different from the models you have seen?

MR. RUSSELL: The one your Honor has has a bar running across the bar that limits the motion of the keys.

MR. SUTTON: This device has projections beneath the base of each key to limit the motion.

THE COURT: The one I have has in effect a ledge or surface that extends underneath the keys.

MR. RUSSELL: They don't touch that surface when they are depressed, your Honor.

THE COURT: They are different. There is no question that Exhibit 5 was manufactured by the defendants, is there?

MR. RUSSELL: I think we would have to agree that it is. As you will recall, the fifth element we are going to discuss is involved in this issue. I would not have raised the fifth element if I only had Exhibit 5 in front of me. I believe that we will have to regard two forms of construction with respect to the Melody-Bell-O-Phone.

MR. SUTTON: I will represent to the Court that

this is one and the same exhibit presented for inspection during the deposition of the President of the defendant company, Child Guidance Corporation, and a significant amount of questions were raised of Mr. Crain at that time with reference to this very device, so that it is our understanding that this is at least one device that has been marketed by the defendant corporations.

THE COURT: Let me ask you this: Now that you have seen the model that the Court has, do you charge it to be an infringement of the patent in suit?

MR. SUTTON: Can I study it during the recess, your Honor?

THE COURT: You may. Plaintiffs' Exhibit 5 will be received.

***

(Plaintiffs' Exhibit 5 received in evidence.)

Q Mr. Ellman, I show you Plaintiffs' Exhibit 5, the Melody Bell-O-Phone device, and I ask you whether this devide has an element corresponding to the blue item here we have already talked about as being a key?

A Yes,it does.

Q Would you please point to that?

A This sort of translucent looking plastic piece here.

Q Do each of these items you have characterized as keys support a tone bar?

A Yes, these colored bars.

Q Does this device work in substantially the same way as the device shown to you, Plaintiffs' Exhibit 4, the Big Mouth Singers?

A Yes.

Q Does this device work in substantially the same way as the device shown to you as Plaintiffs' Exhibit No. 3, the Bell Organ?

A Yes, it does.

Q At this point I would like to show you another working model or chart pre-marked as Plaintiffs' Exhibit 6 D, and we offer this into evidence on the same basis as Plaintiffs' Exhibit 6 C, as being a working model, not to scale, not the exact shape and only a portion of the device. I would also like to add for the benefit of all -- first, I should really wait for it to be introduced into evidence.

THE COURT: Any objection?

MR. RUSSELL: I assume it is the same basis that the previous chart was accepted. It is not in itself evidence, as I understand it.

THE COURT: These are just partial working models which don't necessarily indicate the correct shape

and size of the respective parts.

MR. SUTTON: For Mr. Russell and the Court's benefit, in the case of the Melody Bell-O-Phone the device shown at the bottom model is shown as one piece. In fact in the working model there are two pieces, one to be engaged by the finger and that piece in turn engages what Mr. Ellman has characterized as the key. So there is no misrepresentation here, this model was made as one piece incorporating both of those as being integral units.

Q Have you seen this Plaintiffs' Exhibit 6 D be before, Mr. Ellman?

A Yes, I have.

THE COURT: Plaintiffs' Exhibit 6 D is received on the basis indicated.

Q I point to the first or topmost working model on Plaintiffs' Exhibit 6 D with the name Musser on the left, and I ask you whether you recognize that?

A Yes, I did.

Q Is there a similarity between that model with the name Musser next to it and that which has already been discussed as Plaintiffs' Exhibit 6 C?

A Yes.

Q Is there a stop for limiting the movement of the keys?

A Yes, there is.

Q Would you please point to it please, for the benefit of the jury.

A Yes.

Q I now point to the second or middle model which has the words Big Mouth Singers next to it, and I ask you whether you have seen this before?

A Yes, I have.

Q I ask that you go over to my desk while I am holding this chart, and pick up the key. I have just removed this key from the Big Mouth Singers. Do you see a similarity and shape between the key you just handed me and the blue portion of the model next to the name Big Mouth Singers on it in Plaintiffs' Exhibit 6 D?

A Yes.

Q Would you please press that blue portion and tell us what happens?

A As I press it, it comes to rest against this brake or block which stops it in proper proximity.

Q I now ask you to direct your attention, Mr. Ellman, to the lowermost model which has the name Melody Bell-O-Phone next to it, and I would ask that you do likewise with the blue member and tell us what happens.

A As I press down it comes to rest on the gray

stopping point here and brings the tone bar in proximity.

Q In the physical Melody Bell-O-Phone is this upper part of the blue that you just pressed with your finger integrally attached, or integral with the elongated part?

A Yes, it is.

Q I would like to show you the model itself.

THE COURT: Do you understand what the word integral means?

THE WITNESS: Working in cooperation with --

THE COURT: No, it means one and the same piece.

THE WITNESS: It is not one and the same piece, no.

Q I show you the Melody-Bell-O-Phone item and I ask you what in the device itself corresponds to the stop that you just referred to in the bottom model?

A Yes. You have these little red projections coming up from the bottom here, and they act as a stop.

MR. SUTTON: I would now offer into evidence a photograph blown up, pre-marked Plaintiffs' Exhibit 6 A, of a portion of my opponent's proposed charges to the jury, which show five elements, five claim elements that are the subject of this initial trial as to equivalency, and I offer this into evidence at this time.

MR. RUSSELL: Objection, your Honor. I again don't consider this to be evidence.

THE COURT: There is no dispute as to the fact that this is a verbatim reproduction of the portions of the claim in dispute, is there?

MR. RUSSELL: I don't think it is quite exactly the claims, your Honor. It is something taken out of my brief --

THE COURT: Over the lunch hour you compare it with the claims word for word, and if there is any discrepancy call it to the Clerk's attention.

MR. RUSSELL: Thank you, your Honor.

Q Mr. Ellman, I show you Plaintiffs' Exhibit 6 A now introduced into evidence, and I ask you whether you have seen this specific chart before?

A Yes, I have.

Q Do you recognize the writing on there as comprising claim type language from a patent?

A Yes.

Q Mr. Ellman, I would like to carry you through each of these elements, A, B, C, D and E, and I would like, if you can, to show us wherein, first, the Musser device which is the Bell Organ, second, the Melody or rather Big Mouth Singers, Plaintiffs' Exhibit 4, and then the Melody

Bell-O-Phone, Plaintiffs' Exhibit 5, where structure corresponding to these elements exists. Do you understand the question?

A Yes, I do.

THE COURT: Before you start that, I have an appointment at lunch, so I am going to have to eat a little earlier than my usual lunch hour. We will recess now, and come back at 1:45. I ask that you all be here promptly so we can start without any delay.

In the meantime don't discuss the case with your fellow jurors or anyone else.

(The jury left the courtroom.)

(Adjourned to 1:45 p.m.)

AFTERNOON SESSION

2:00 p.m.

(In open court. Jury present.)

MR. SUTTON: Prior to the recess you asked that I examine the Melody Bell-O-Phone structure on your bench, and I have, and this is a different structure in some respects and what I will be forced to do, I assume, is to add this as another accused device. I haven't been able to take it apart, but the plaintiffs, through their counsel, believe that that device also infringes their patent.

THE COURT: All right.

MR. RUSSELL: We will stipulate that that device can be added to the accused structures, and was sold by defendant. Further, your Honor, on a different subject, you asked me to check this language against the claim. It actually is not the claimed language. There are certain departures from it and in the questions of my witness I intended to have the claim itself before the jury, and to work directly from the claim language.

THE COURT: Can you tell us now what the discrepancies are?

MR. RUSSELL: For the record, Item B referring to the claim, and this would be Claim 1, states, "A key support ledge, as appears on 6 A," and then inserts "attach

to said front side of said housing so as to project," and then, "generally parallel," the word "generally" goes in there, and then "to said slot."

MR. SUTTON: I would have no objection to Mr. Russell simply marking that exhibit and we will work from that.

MR. RUSSELL: Isn't it easier to work the other way around?

THE COURT: He prepared this in an enlarged form so the jury can see it. They can't see the claims unless there is a copy of the patent for each one. I think this is more convenient anyway, because it isolates the elements in question and avoids confusion with respect to the parts of the claim that aren't in question.

MR. RUSSELL: Begging your indulgence, sir, this is the way I intended to do that particular function.

THE COURT: I have no objection to Mr. Sutton's witness referring to the actual photo copy of the claim.

MR. RUSSELL: I will be happy to insert on his chart the words, but it would seem to me I would mess up his chart.

THE COURT: He is giving you permission to do that.

MR. RUSSELL: I will do that.

THE COURT: Maybe you ought to tell him what the changes are and let him put it on and if the lettering leaves anything to be desired from the artistic standpoint it will be his responsibility and not yours.

J U L I U S E L L M A N , resumed.

DIRECT EXAMINATION CONTINUED

BY MR. SUTTON:

Q Mr. Ellman, I would like to call your attention to this chart. Prior to the lunch recess I referred to Plaintiffs' Exhibit 6 A, and I will characterize it now as claim language. There are five elements, A, B, C, D and E, which we have just amended so that they recite parts of the claims, or at least one claim of the patent in suit which is Plaintiffs' Exhibit 1.

I would like now, as to each element, to find out from you whether or not either the exact language of each element A, B, C, D and E, or an equivalent structure is present in three devices, the Bell Organ, which is the Musser device, Plaintiffs' Exhibit 3, the Melody Bell-O-Phone whidh is Exhibit 5, and the Big Mouth Singers, which is Exhibit 4.

Let's first start with the Bell Organ, and I will ask you whether in this device, Plaintiffs' Exhibit 3, there is an elongated slot on the front side of the housing?

A Yes.

Q We haven't taken this apart, but would you please point for the benefit of the jury where the slot is?

A Just below the gray area here where all the keys go into the cowl.

Q Do the keys extend through the slot?

A Yes, they do.

Q Do they extend through the slot from the front to the back?

A Yes, they do.

Q I want to go to element B, a key support ledge attached to said front side of said housing so as to project generally parallel to said slot. Do you see said key ledge or its equivalent in this exhibit?

A Yes, I do.

Q Would you please point to that?

A Yes, here.

Q Is that one and the same structure that you referred to earlier as limiting the movement of the keys?

A Yes, this little gray area here.

Q I refer now to element C, which is a plurality of projections capable of serving as fulcrums for keys mounted on said housing adjacent to said slot so as to project upwards from the lower edge thereof.

We can't take this apart right now, but I am going to refer to Plaintiffs' Exhibit 6 B, and I am going to ask you to show, for the benefit of the jurors, whether a plurality of projections are depicted in Plaintiffs' Exhibit 6 B, and if so where?

A Yes, right at No. 26.

Q Is that referred to in the patent in suit, Plaintiffs' Exhibit 1?

A Yes.

Q Does it have the same number, 26?

A Yes.

Q I now refer to Item No. D, keys having recesses located in the bottoms thereof with each said recess receiving one of said projections and supporting said keys for rotation about said projections.

First of all, the word "projections" is used in Item D. Have you seen that before in our discussion of this chart 6 A?

A Yes.

Q Keys. First point to keys on the Plaintiffs' Exhibit 3 that is in front of you.

A These are the keys.

Q Can you tell us where the keys extend between? In other words, where are their dimensions measured

lengthwise?

A I don't understand the question.

Q Let me ask you, do the keys extend from this end back to this end here?

A They extend from front to back.

Q Keys having recesses located in the bottoms thereof, and we can't see the bottoms of the keys, but we can in a minute if we take this apart. I refer you to Plaintiffs' Exhibit 6 B, and show us where there are keys having recess --

A This bottom here, this forms a recess for this pivoting point here.

Q Keys having recesses located in the bottoms thereof with each said recess receiving one of said projections. Could you please refer to this drawing without my leading you?

A 26 again would be the projection going into the recess, and forming a pivoting point.

Q Does the top of the projection 26, is that received by the recess?

A Yes, it is.

Q Each of said recesses receiving and supporting said keys for rotation about said projections.

Would you refer to 6 B and tell us whether there

are rotations?

A Yes, this being the pivoting point if I press down here, the key would come down to the stop point and bring the tone bar up, which would pivot like that.

Q In fact, I refer you now to Exhibit 6 D, and if we assume that this rivet or pivot point here corresponds to the projections or pivot point you just referred to, can you demonstrate how that works?

A Yes, it rotates around this pivot point to this stop point, and brings the tone bar up to the rotating ring.

Q When it brings it up to the rotating rings what happens?

A It brings it close enough so the rings bounce off while it is rotating, and it causes a continuous vibrating sound.

Q I am turning Plaintiffs' Exhibit 3 on. Would you please do what you did with the key on model 6 D.

Would you press the key and show the jurors what would happen?

A Yes.

Q We will get this working in a second. We covered the first four elements. I want to hit the last, said keys being capable of being engaged on the outside of said housing, and if I close the top of the housing do you

engage the keys on the outside of the housing on Plaintiffs' Exhibit 3?

A Yes, the keys are on the outside.

Q So as to be pushed into engagement with said keys support ledge so as to rotate said keys about said projections to a playing position.

A Rotating up to this pivot point to a playing position.

Q Very quickly I now would like to refer to the Plaintiffs' Exhibit 4. I would like to go through these elements very quickly. I have removed two of the keys from Plaintiffs' Exhibit 4, and what I would like to do is, I want to go right down to D and recite this element again. Keys having recesses located in the bottoms thereof. I have just taken these two keys out just prior to the recommencement of the trial. Can you take that and point to recesses located in the bottom of these keys?

A Yes, this indentation here would be the recess right here on the bottom of the key.

THE COURT: May I see that?

THE WITNESS: Yes, sir.

THE COURT: All right.

Q I am going to take one of these keys, Mr. Ellman.

THE COURT: That is the Melody Bell-O-Phone?

MR. SUTTON: This is the Big Mouth Singers, your Honor. We will show the same thing for the Melody Bell-O-Phone.

THE COURT: All right.

Q I am going to take this key that I have removed. You see where I was able to snapas a result of these recesses on to a rod?

A Yes.

Q Let's go through each element quickly. An elongated slot in the front side of the housing. Let me reassemble the housing for you. Would you please point to an elongated slot in the front of the housing?

A Here.

Q Mr. Ellman, I see that this slot has a number of dividers along its length. Do you know whether those dividers serve any function at all?

A No particular function. It is an elongated slot. It may be part of the design, I don't know.

Q I asked you once before, but I want to reconfirm, do these heads which are quite attractive, do they have anything to do with the formation of the sound in this toy?

A Nothing whatsoever.

Q I move to B, a key support ledge attached to

said front side of said housing so as to project generally parallel to said slot.

Would you please point to the key support ledge, if you see one in this Defendants' Exhibit 4?

A This area running right down here.

Q Is that one and the same surface or ledge that the keys came into contact with to limit their movement that we discussed earlier?

A Yes.

Q I refer to Item C, and we also recognized earlier that if we didn't have the key support ledges, something would happen, is that correct?

A Yes.

Q Let's demonstrate that once again.

Can you show us what would happen?

A Yes, they would go down too far and stop.

Q That key support ledge you referred to provides a limit of movement?

A Exactly.

Q I now come to a point which is Item No. C, and I will ask you whether Item C which reads a plurality of projections capable of serving as fulcrums for keys mounted on said housing adjacent to said slot so as to project upwards from the lower edge thereof.

Mr. Ellman, I am going to ask you to think carefully, are there in this device a plurality of projections of the type I just described?

A There is a rod which serves the same purpose.

Q That is not what I asked you. Are there a plurality of projections, more than one projection?

A No.

Q Is there an equivalent?

A There certainly is.

Q What is the equivalent?

A This rod serves as a plurality of projections, and each key is snapped onto it.

Q In the way I just demonstrated?

A Yes.

Q So this key, the second key that I removed earlier can be snapped onto that rod as you have just seen, so that it will function?

A Yes.

Q So we don't see a plurality of projections, but we have seen an equivalent, is that correct?

A Yes.

Q And that is the rod?

A Yes.

Q Capable of serving as fulcrums for keys. Does

the rod serve as a fulcrum for each key?

A Yes, a pivoting point, a fulcrum.

MR. RUSSELL: If your Honor please, I object, your Honor, to the term equivalent. That is for the Court to decide. This witness should be restricting his testimony not to legal conclusions, but to facts.

THE COURT: I think your point is well taken, though I am not sure that I agree with the argument that equivalence is a legal conclusion. But I do think instead of asking him for his conclusion as to whether or not this is the equivalent, you should either define the term equivalent in your question or you should ask him whether or not these perform the same functions in substantially the same way to achieve substantially the same result.

Q Let me do just that now, Mr. Ellman.

As I have used the word equivalent, let's get away from that word for a second, and I ask you whether the rod that we have just referred to as the key being snapped onto and serving as a fulcrum, does that work in substantially the same way and does it accomplish substantially the same result as the plurality of projections recited in element C on this Chart 6 A?

A Yes, it does.

Q What is that function?

A To simply serve as a pivoting point about which the key rotates.

Q Let's move to element D now. Keys having recesses located in the bottoms thereof, we have already covered that. I started with D first, and we saw that the recesses, I don't mean to put words in your mouth, but we covered that already with the keys before I snapped them in.

Element E, said keys being capable of being engaged on the outside, and I would like to reassemble this so we have an outside. Said keys being capable of being engaged on the outside of said housing so as to be pushed into engagement with said key support ledge, and let's stop there. I would like you to do just that.

A All right.

Q So as to rotate said keys about said projections to a playing position.

Do we rotate the keys about the rod to a playing position?

A We certainly do.

Q I now take the bottom and top half of Plaintiffs' Exhibit 5, which is the Melody Bell-O-Phone, another one of the accused devices marketed by the defendants, and let me do what I did with the Big Mouth Singers. I removed two keys or elongated members, whatever the word is, I don't

mean to characterize it. I am going to take this and I am going to put this elongated element and do you see where I have just snapped that onto a rod?

A Yes, I do.

Q Reading Item D, keys having recesses located in the bottoms thereof, with each said recess receiving one of said projections. Let's stop and look at these items. Do you see a structure that is at all similar to another structure you have seen today?

A Yes, I do.

Q Please tell us what that is.

A The recesses right here serve the identical purpose.

Q What purpose is thast?

A To snap onto the rod as the pivoting points.

Q With each said recess receiving one of said projections, and we have projections in this device, don't we, and when I say projections, a plurality of projections?

A Again, we have a rod.

Q That is not what I asked you. Do we have a plurality of projections?

A No, we do not.

Q Do we have a structure or an element in the structure I am holding in my left hand which works in

substantially the same way and accomplishes substantially the same result as projections or plurality of projections?

A Yes.

Q What element or structure do you see that does that?

A This rod in which the keys are mounted, and they pivot around this rod.

Q If I take this item here, and what would you call this, talking about the plastic part?

A That is a key.

Q If I take this key and snap those recesses over the rod, what happens now when you press those keys?

A The key has been put into position so that it is fixed on the rod and will rotate around it to a playing position.

Q Let's go through each of the elements. An elongated slot in the front side of the housing. Mr. Ellman, do you see an elongated slot in the front of this housing?

A No, I do not.

Q Do you see any structure that works in substantially the same way to accomplish substantially the same result as an elongated slot?

A Yes, these series of slots that come out here.

MR. SUTTON: If I may, your Honor, I would like to borrow the assembled item housing.

THE COURT: It was taken apart this morning.

MR. SUTTON: Perhaps I can show the jury.

Q The top of this housing corresponds to the item I just showed you, Plaintiffs' Exhibit 5.

Do you see a structure that accomplishes the same function and purpose in substantially the same way as an elongated slot?

A Yes, I do.

Q What do you see?

A I see this series of slots in a straight line.

Q What are those slots there for?

A For the keys to come out so that they can be communicated with the finger.

Q A [illegible]upport ledge attached to front side of said housing so as to project generally parallel to said slot.

I am going to give you the bottom half of this device, and I am going to ask you whether you see a key support ledge attached to said front side of said housing so as to project generally parallel to said slot?

A No, I do not.

Q What was the purpose of the key support ledge

that we have already discussed for the Musser device and the Big Mouth Singers?

A To act as a stop point for the keys.

Q Do you see any structure in Plaintiffs' Exhibit 5, the Melody Bell-O-Phone,which works in substantially the same way to accomplish substantially the same result, namely to limit the rotation or to stop the rotation of the keys?

A Yes, I do.

Q Would you please point to that?

A There are a series of projections coming up here, each one of which is a stop point, the little red pieces that I believe I pointed out before.

Q They can't go down any further?

A It restricts the movement.

Q I would like very briefly to direct your attention, what I would like to characterize and offer into evidence as Plaintiffs' Exhibit 5 A, this other structure, if there is no objection?

MR. RUSSELL: No.

(Plaintiffs' Exhibit 5 A received in evidence.)

Q Do you see any structure or elements of the structure in Plaintiffs' Exhibit 5 A which works in

substantially the same way and accomplishes substantially the same result as the key support ledge that limits the rotation of the keys?

A Yes, I do. This bar up here.

Q Would you please press those keys and show us how that happens?

A The bar acts as a stop point. The same function simply put in a different place.

Q In fact, Mr. Ellman, I refer to Plaintiffs' Exhibit 6 C that we examined before, where the key support ledge was shown beneath the key, do you recall that?

A Yes.

Q Have we not in this device replaced the location of the stop means in the form of the key support ledge to a position not exactly as I have just placed it, but above the key to limit the movement?

A Yes.

Q Could we not take this same key support ledge or stop means, however it is characterized, and place it in another position to limit the rotational movement of the key?

A We certainly could.

Q I would like to move on now quickly to element C, plurality of projections capable of serving as fulcrums for keys mounted on said housing.

You previously said there were no plurality of projections, did you not?

A Yes, I did.

Q What did you say was the structure in this device that worked in substantially the same way and accomplished substantially the same result?

A The continuous rod.

Q Is such a rod present in Plaintiffs' Exhibit 5 A in front of you?

A Yes, it is.

Q Are those keys pivotally supported about a rod?

A They certainly are.

Q Is there a recess associated with each key in Plaintiffs' Exhibit 5 A through which that rod extends?

A Yes, there is.

Q Let's move on to Item D, keys having recesses located in the bottoms, you have already described the yolks or recesses which snapped onto the rod. With each said recess receiving one of said projections, and we have already described that for the record, which is substantially the same structure to accomplish substantially the same result as the projections. The final element, said keys being capable of being engaged on the outside of said housing so as to be pushed into engagement with said key

support ledge so as to rotate said keys about said projections to a playing position.

Mr. Ellman, you have characterized these plastic items here as keys?

A Yes.

Q If I place the cover over the bottom of this housing, can you engage those specific plastic elements that you have referred to as keys from outside the housing as recited in E?

A You mean the way you have it now?

Q That is correct.

A No, I cannot.

Q If I take this blue item and place it on top of these springs, one of the springs, is it now possible to engage -- well, is it possible to engage a structure on the outside of the housing so as to be pushed into engagement with said key support ledge so as to rotate said keys about said projections to a playing position?

A Yes.

Q We have already said that this button is not the same physical item as the plastic item beneath that you previously saw me snap onto the rod?

A Yes.

Q Do the combination of this button, and there

are eight of them, and that elongated plastic item function as keys being capable of being engaged on the outside of said housing so as to be pushed into engagement with said key support ledge so as to rotate said keys about said projections to a playing position?

A Yes.

Q Is it broken up into two parts?

A Yes.

Q Does it cooperate with one another?

A The identical function.

Q Mr. Ellman, we have heard conversation today about a crowded art. I would like to ask you whether you individually as a toy designer attempt to keep abreast of the state of the toy art?

A Yes, I do.

Q When new items come out from other designers or competitors or toy companies, do you make any kind of effort at all to keep abreast of these developments?

A I most certainly do.

Q Are you aware of the approximate time that Dr. Musser, the inventor of this patent in suit, came up with this idea and filed his patent application? Do you have any idea of the period we are dealing with?

A I believe it is around 1957.

Q The patent itself will say that the application was filed on October 20, 1958. I would like to ask you, to your knowledge, apart from the items that have been marked more recently by the defendants in this lawsuit, whether you have ever seen a toy musical instrument which produces a carillon sound and which is capable of being manufactured in mass production in the same way that the toys on my table here are shown? Have you ever seen a carillon sound producing toy musical instrument like this?

A Prior to when?

Q Prior to 1958?

A No.

Q What has happened since Dr. Musser's filing his application is not relevant to this issue.

Is the toy musical instrument --

MR. RUSSELL: I object to that on the ground that he is making a statement as to the law and, secondly, it is bad law.

THE COURT: I am going to instruct the jury to disregard the statement made by counsel, Mr. Sutton, as to what is or is not relevant.

Q Mr. Ellman, is there a proliferation of musical instruments in the toy field?

A Yes, there is.

Q Are there xylophones?

A Certainly.

Q Can you give us examples of other types?

A There are all kinds of wind instruments and drum instruments, just about every type of musical instrument has been duplicated as a toy.

Q Can you refer us to any musical instrument which is a toy which performs the functions of the items, the Bell Organ or the Big Mouth Singers or the Melody Bell-O-Phone? Do you know of any other toy instruments which accomplish the results that those accomplish?

A No, I don't.

Q You hesitated.

A Yes, because there are additional items that have come out on the market. It depends what time slot we are talking about.

Q What items?

A Schroeder's Piano brought out by Child Guidance which is also in a similar category.

Q Is this item the Schroeder's Piano that you are referring to?

A Yes.

THE COURT: There is also obviously Melody Mike.

MR. SUTTON: Yes, your Honor. I am not afraid

to state that Melody Mike has been withdrawn from this lawsuit.

THE COURT: I know, but your question was broad enough to include any other musical instruments that produced sounds in a similar way.

THE WITNESS: I stand corrected. I am aware of Melody Mike too.

Q I would like you to tell us a bit about this Jolly Jingle Tone item that was referred to previously, and I would like to introduce this into evidence, and I offer this into evidence as Plaintiffs' Exhibit 8.

MR. RUSSELL: If your Honor please, this device has not been produced before. We have not had it apart. I intend -- well, I do not object to it in terms of the fact that it is a device that is made more recently than the patent. I am agreeable to it. I would hope that I would have a chance to take it apart while we are doing this, or perhaps the witness will.

MR. SUTTON: Either that or we don't have to go into it, whichever you prefer.

MR. RUSSELL: I want to go into it. If you don't do it now I will go into it on cross examination.

MR. SUTTON: Are there any objections to my offering the Jolly Jingle Tone into evidence as Plaintiffs'

Exhibit 8?

MR. RUSSELL: Is this the same one that previous testimony was about?

MR. SUTTON: Yes.

MR. RUSSELL: No objection.

*** (Plaintiffs' Exhibit 8 received in evidence.)

Q Mr. Ellman, who invented this item or who developed it?

A This was a mutual development by George Lerner and myself.

Q When was it developed?

A It was more or less conceived around December 1970 and developed, oh, within about a year after that, maybe a little longer.

Q Is this a production item?

A No, this is a prototype model indicative of the type of finished work that we do when we present our item.

Q You say we do. Who physically made that item, Plaintiffs' Exhibit 8, in front of you?

A Physically this was made by George Lerner.

Q Are there any other models or copies of this Jolly Jingle Tone, Plaintiffs' Exhibit 8, in existence?

A No.

Q Is this design that is in front of you -- withdrawn.

For what purpose was that specific prototype that is in front of you made?

A It was made to be shown to various toy manufacturers. Hopefully they would accept it as a new concept and put it out on the market.

Q Was it shown to Ideal Toy Corporation?

A Yes, it was.

Q Can you tell us in your own words how you came to approach Ideal Toy, and what happened very briefly?

A I will try to be brief.

I am trying to think of the time when we showed it to them. I am a little confused with the dates. I believe it was around September of 1971 we brought this to Ideal Toy Corporation, and a Mr. Julius Cooper, who is their Vice President in charge of research and development, loved the item, however, he said that someone else had brought a similar item to them, that our item was far superior to the other item but in view of the other item he had already made, or they had already made a patent search, and in their patent search they had come up with the Musser patent. He said we don't want to buy any problems, we don't want to get into litigation and, therefore, as much as we love the

item, without the patent we are going to have to turn you down. I then said to Mr. Cooper, I said "Would you let me have a copy of the patent?" At that very same time the house counsel, Mr. Dick Groutin, brought up a copy of the patent and that is how I acquired the name of Dr. Musser.

I then got in touch by long distance telephone with Dr. Musser and advised him that we had a prototype of an item apparently similar or perhaps identical to that covered by his patent, and that we were interested in obtaining the rights of the patent.

Q I am going to interrupt you here, Mr. Ellman.

Did you supply Mr. Musser with anything more specific than just words as far as your description of your item?

A Subsequently I even sent him a picture of this item, and he himself was very thrilled when he saw the item. He is a very famous inventor himself. There are very big musical instruments put out under the Musser name. Besides the phone calls there developed a series of correspondence and we then purchased the patent from Dr. Musser. I shouldn't say that, we obtained an option for the right to buy the patent from Dr. Musser for $1,000. With this option in hand, and this took several months because he was hard to reach and I was hard to reach, and

we worked on a lot of other items in the meantime, but with this option in hand I then went with Ideal Toy Corporation and I said to Mr. Cooper, here is the item, we have the patent. He said great. He immediately put it into their engineering. They costed the item out. They estimated that the item would sell for ten dollars retail. They put it through their promotional division. They already had a promotional campaign prepared on it and in the meantime, about two or three weeks later we concluded the purchase of the patent from Dr. Musser, and just about the time they were ready to go to actual production of cutting steel and making the injection molds and what have you that goes into producing this,one of their engineers in one of their departments said, you know, I think I know of a similar device on the market, and he then came up with the Melody Bell-O-Phone. I am not sure whether they had the Big Mouth Singers, but it was close. They may have had both at that time. When this was produced Ideal then said sorry, but we don't want to go into a diluted market, even though you own the patent, even though you have an item which we feel is superior in design and we could do a job with it, we don't want to go into a diluted market, and no sale.

That is when we instigated litigation against Child Guidance.

Q Mr. Ellman, do you have any personal information, information known to you personally, as to whether or not either the Melody Bell-O-Phone or the Big Mouth Singers mechanisms were derived from the Musser mechanism characterized by Plaintiffs' Exhibit 3, the Bell Organ?

A I can't honestly say. I have no knowledge as to how they obtained the method for doing this.

Q Do you know whether the Bell Organ, the Musser device, was known and marketed successfully in the past?

A Yes, it was.

Q How do you know that?

A Well, because Dr. Musser sent me a series of literature to indicate that in fact it was on a national network and this is back I think in the late 50's, I am not sure just what the date is, and also I think it was once shown at Radio City Music Hall where they had 30 or 40 of them as part of their entertainment.

MR. RUSSELL: If your Honor please, I object. The witness has stated nothing which is real evidence. It is hearsay to the extent of what Dr. Musser may have told him. What the articles may prove is something else, and he says he thought it went in Radio City Music Hall. That doesn't prove anything in terms of was it actually sold or commercially successful.

THE COURT: Did you see it at Radio City Music Hall?

THE WITNESS: No, I did not. However, your Honor, Dr. Musser did send me specific literature which shows it shown at Radio City Music Hall, and specific literature being shown on NBC.

THE COURT: Do you have that literature here?

THE WITNESS: No.

THE COURT: I have to instruct the jury to disregard that then.

MR. SUTTON: I would like to read the deposition from Mr. Musser --

THE COURT: Not at this point. It is out of order. You have a witness on the stand.

MR. SUTTON: You prefer to handle it separately?

THE COURT: If you want to introduce it later, you may do so, but not while you have a witness on the stand.

Q Mr. Ellman, do you know whether one or more parts of the Bell Organ can be placed within the Big Mouth Singer's device to function according to its intended purpose?

A Yes, I do.

Q Have you done this in the past?

A Yes, I have.

Q Which item have you placed from the Bell Organ into the Big Mouth Singers?

A What I would call one of the hearts of the item, actually the rotating rod with the washers on them.

MR. RUSSELL: If your Honor please, I think the witness then said that he was told that that was the element. That makes his testimony hearsay in this instance.

MR. SUTTON: I asked the witness and I will ask him again whether or not this witness himself personally interchanged one or more items from the Bell Organ and into the Big Mouth Singers.

MR. RUSSELL: If you get the record I believe you will see that he was told.

THE COURT: Read the last answer back, please.

(Testimony read.)

THE COURT: Objection overruled.

Q Have you personally taken an item from the Bell Organ and personally placed it without assistance into the Big Mouth Singers?

A Yes, I have.

Q Would you please point to the item that you are referring to?

A Yes, I am talking about this rotating rod with the washers can be taken out of here and placed in here and

made to work perfectly.

Q Mr. Ellman, is the Bell Organ, Plaintiffs' Exhibit 3, the same item as the Melody Bell-O-Phone?

THE COURT: What do you mean, is it the same item? Obviously they are different in some ways.

Q Does the Bell Organ differ in shape from the Melody Bell-O-Phone?

A Yes.

Q Is it different in color?

A Yes.

Q Does it function in substantially the same way to accomplish substantially the same result in producing sound as the Melody Bell-O-Phone?

A Yes, it does.

Q I ask you the same questions concerning the Big Mouth Singers. Is the Bell Organ shaped differently from the Big Mouth Singers?

A Yes, it is.

Q Does it have a different appearance?

A Yes.

Q Does it function substantially the same way to accomplish substantially the same result in producing sound as the Big Mouth Singers item?

A Yes, it does.

Q Is the Bell Organ substantially the same item disclosed within the patent in suit here, Plaintiffs' Exhibit 1?

A Yes.

MR. SUTTON: I have no further questions of this witness, your Honor.

THE COURT: Mr. Russell.

MR. RUSSELL: I would like the witness to take apart the Bell Organ and the Jolly Jingle Tone, your Honor. We have the other elements apart, so that their portions can be seen, and we are at a disadvantage unless the same elements can be seen in the other devices.

THE COURT: Which one is it you want him to dismantle?

MR. RUSSELL: The Bell Organ, which is the replica of the patent in suit, and the Jolly Jingle Tone which is before the witness.

THE COURT: Do you have any objection to that, Mr. Sutton?

MR. SUTTON: Not at all, your Honor.

THE WITNESS: May I say something?

THE COURT: Yes.

THE WITNESS: This can be taken apart within limits. I want you to understand this is a model. As a

model we take certain liberties. We don't necessarily make undercuts perhaps that can be done in production. So that certain things are glued or cemented together simply to hold together as a model, and not made necessarily for assembly. So when I take off this cover you will find that the cover actually has an electrical connection going to the base so that it can't be moved too far away from the rest of the base, and the rest of it is very difficult to take apart without breaking parts apart. This is the only model existing, and this represents a year and a half work. I wanted the Court to take this into consideration.

THE COURT: Why is this relevant to the question of whether or not the two accused devices contain elements which are the equivalents of those called for in the patent claims?

MR. RUSSELL: It has to do with the structures and the functions. It is a question of also an illustration of the type of things that are done in this field. I think in particular the thing that I need to have the testimony on with respect to the Jolly Jingle Tone is the method of mounting the keys and the method of limiting the action of the keys in the direction of the motion toward the tone bar.

THE COURT: As I understand it, the Jolly Jingle Tone is something that was designed by the Plaintiffs

entirely independently of the patentee, Mr. Musser, and before they ever heard of Mr. Musser?

MR. SUTTON: That is correct.

THE COURT: Then it is relevant in that respect. It shows what somebody independently skilled in the art would have done.

THE WITNESS: There again, I was asked by Dr. Musser who would like that to be returned to exercise extreme care in taking that apart.

THE COURT: I suggest you let somebody else do that, Mr. Russell, because that has to be returned to Mr. Musser.

CROSS EXAMINATION

BY MR. RUSSELL:

Q Now, Mr. Ellman, we have before you five instruments, the Bell Organ, which is the patent in suit, the Jolly Jingle Tone here on the left, and on the other table we have the two accused structures.

I would like to call your attention to the keys in the Musser device. I am having problems taking this device apart. May I ask whether you have taken this device apart?

A I am not too familiar with that device. I have taken out the rotating rod and I have taken out the keys

occasionally.

Q You have taken out the rotating rod, but not the keys?

A I also said I have taken out the keys occasionally, but I am not overly familiar with the device.

Q Mr. Ellman, perhaps it would be useful if you stepped down because what we are looking at is rather small.

You were talking about recesses in the bottoms of the keys and projections sticking up into the recesses. I would like to call your attention to the little recess at the bottom of the key that I have pulled out of the Bell Organ, and I am pointing my pencil to a portion and ask you if that corresponds to what you testified about earlier?

A Yes, it does.

MR. RUSSELL: May I demonstrate to the jury?

There is a little recess which has walls on either side. I have taken a second key out.

First I will ask the witness, I am pointing to an item called projection in the patent.

THE WITNESS: Yes.

MR. RUSSELL: Ladies and gentlemen of the jury, you will see a little projection coming up, two of them. Do you see these projections?

Q We have just covered the recess and the

projection fitting into it. Are you aware, Mr. Ellman, that the function of this recess is not only to pivot the key but also to limit its sidewise motion? That the keys cannot be slid up and down?

A Of course.

THE COURT: When you say up and down, I assume you mean lengthwise in the slot?

MR. RUSSELL: Longitudinally in the slot, yes, your Honor.

THE COURT: That is not really up and down, but from side to side.

MR. RUSSELL: I stand corrected, your Honor, thank you.

Q Mr. Ellman, I hand you a copy of the patent, and call your attention to Column 2, lines 51 through 55, where it says "The length of the recesses 30, and the projections 26, are preferably the same so as to hold the keys 28 against movement along the length of the slot 20."

Do you see that?

A Yes, I do.

Q In your description of the function of the slots and the projections was it your intention to omit this element, the function which limits the longitudinal motion of the keys?

A I only answered those questions which I was asked. I had no intention to limit any of my answers.

Q Do you not agree that the function of that projection fitting into a slot is to limit the longitudinal motion of the key?

A I repeat, it certainly does. I agree with you.

Q Do you not agree that when it is just put on a pin, the way it is in Jolly Jingle Tone, or in the others, that the keys can simply slide up and down the rod?

MR. SUTTON: I object. In fact, the keys, as Mr. Russell attempted, do not slide up and down the rod. The features Mr. Ellman is being asked about are not the claimed features that I directed my direct examination of Mr. Ellman to.

MR. RUSSELL: If your Honor please, I object to that statement as containing testimony which is not supported by the record.

THE COURT: I am going to overrule the objection. I point out, Mr. Russell, you keep using the term up and down. They do not slide up and down the rod, because the rod is horizontal.

MR. RUSSELL: It is the transverse --

THE COURT: They slide lengthwise of the rod is the point you are trying to make. He says they don't slide

lengthwise of the rod. Maybe you want to pursue that a little further with the witness.

Q Mr. Ellman, I have taken a couple of the keys out of the Big mouth Singers, and I ask you if you do not agree that the keys can ride up and down?

THE COURT: You mean lengthwise, I assume, Mr. Russell?

MR. RUSSELL: Yes, sir, I am very sorry.

Q The limiting of the motion of the keys lengthwise of the rod has nothing to do with projections going into recesses on the bottoms of the keys?

A You had two questions, I believe.

Q I had one at that point.

A Again, I will agree that these keys can slide up and down on the rod.

THE COURT: You mean lengthwise.

THE WITNESS: Yes, sir.

Q To the extent that they are limited, there is a small molded item which supports the rod.

A Otherwise they can slide longitudinally along the rod, yes.

Q Mr. Ellman, I call your attention to page 29 and 30 of the file wrapper, which pages represent the arguments of Mr. Musser's patent attorney when he was

obtaining this patent, and the sentence at the bottom which says specifically the keys can be assembled with the tone bars on them with sub-assembly procedures, and then they can be merely dropped into place as shown in Figure 3 of the drawing.

Do you understand what those words mean about being merely dropped into place?

A Yes, I do.

Q Am I demonstrating now that the key goes into the machine and then that the slot is merely dropped onto the projection?

A Yes, that is right.

Q Do you know how the Big Mouth Singers, or how the Melody Bell-O-Phone are assembled?

A Sure.

Q How is it done?

A The keys are snapped into place.

Q You are sure of that?

A As sure as I have snapped them in 100 different times.

Q Can they be merely dropped into place?

A No.

Q In relation to what holds the keys in the Jolly Jingle Tone from sliding longitudinally of the shaft, are

there any projections which fit into the bottoms of the keys of the Jolly Jingle Toner?

A No. Unless I didn't understand your question. You said which would limit longitudinal movement?

Q Yes.

A No.

Q Are you familiar, Mr. Lerner, with the purpose of what is called this key support ledge?

A Yes, I am.

Q What is the purpose?

A To act as a stopping point.

Q I notice in the patent in column one, the inventor has stated, lines 46, this later object I have of the invention is quite important inasmuch as children inherently try to imitate parents and like to play with toys which bear at least a superficial resemblance in appearance and performance to apparatus or equipment which their parents use.

Isn't it a fact that that key support ledge protrudes from the front of the instrument for the purpose of giving a superficial appearance of a piano?

A Yes.

Q And that that is an important element in that instrument from the point of view of its intended use?

A Not intended as its mechanical function, but simply as another design of which you may make hundreds of variations of the design.

Q But it was important to make it protrude like that in order to have that appearance?

A To make it to look like a piano for design purposes, yes, that was important.

Q I am now referring to exhibit 6 D, and you will notice, Mr. Ellman, that when you push the key down to come up against the ledge, I believe you said shear, that it sticks, didn't you?

A I never said it sticks.

Q I am showing you that it does stick here on this example.

A That is only a model in which it sticks. It is not meant to stick. It only acts as a stop.

Q Isn't it a fact that when you take something like that and you wedge it in shear that it can stick?

A When you use some of the materials like this, yes, it will stick. But when you use polyethylene or polystyrene they will not stick.

Q Aren't the materials there soft?

A No, those are high impact styrene.

Q Mr. Ellman, in reassembling the Bell Organ, and

I hope I am doing this properly. Do you want to assist me or supervise me?

I have put the front element partly down and I would like to now point along the tops of the keys and ask the witness if he does not agree that I am now pointing to what is called the elongated slot in the front of the housing?

A Yes, sir.

Q Elongated slot in the front of the housing.

A Right.

Q I have pulled the element up simply to show the exaggeration of the slot.

A Yes.

Q On the other hand, if that element is up those keys come off, don't they? They come off their projections. So isn't it a fact, Mr. Ellman, that it is necessary for me to put this slot into its closed position in order to hold the keys down?

A Yes, it is.

Q And that that is an important function of the upper edge of the slot?

A Yes, it is.

MR. RUSSELL: Your Honor, may I confer with my brethren?

THE COURT: Yes.

Let's take our afternoon break now, ten minutes.

(The jury left the courtroom.)

(Recess.)

(In open court. Jury present.)

Q Mr. Ellman, are you aware of the fact that the Melody Bell-O-Phone was first brought on the market at the toy show in February of 1970?

A I am now aware of it, yes.

Q You are now aware of it?

A Yes.

Q Although you follow the industry closely you didn't happen to pick that one up at the time, is that correct?

A I believe I already advised you, counsellor, that we follow the industry at the toy shows to a very limited degree, mostly limited to those companies who are exhibiting our items. That was done at the deposition.

Q Not for musical toys?

A I beg your pardon?

Q You weren't particularly interested in musical toys then, is that it?

A I wasn't particularly interested in musical toys.

Q In fact, you had no experience whatsoever in

musical toys, didn't you?

A Prior to 1970, December when we conceived this, I had limited experience in musical toys.

Q Any experience?

A Limited, I say.

Q What experience was that?

A I may have come up with dozens of items that I sketched and put into my archives as possibilities of toys, so I was always interested in every conceivable type of toy and game, but I didn't bring something to the point where it was specifically thought it was unusual or different enough to make a model.

Q When did you make the sketches that you are talking about of previous musical instruments?

A Over the last twenty years.

Q Any of them toy pianos?

A No.

Q Did the sketches that you made include structural details such as keys mounted on bars and so forth, striker elements?

A Yes, on the one item.

Q Not the Jolly Jingles, I am talking about the other ones,

A They may have been horns, other kinds of music.

Q Was the Jolly Jingle Tone the first one that had keys and strikers and so forth?

A Yes.

Q And you didn't see the Melody Bell-O-Phone in that whole period of time up to December of 1970 when you state --

A I didn't say that. I said that I was later on made aware that you introduced the item in 1970, I believe.

Q I understand your previous testimony was that it wasn't until 1972 that Ideal came around and showed these devices and said that was the reason they weren't going to sell your Jolly Jingle.

A That is right, that is the first time I was aware of another item similiar to mine. That is what I am saying.

Q You and Mr. Lerner developed Jolly Jingle Tone all on your own, didn't you?

A Absolutely.

Q No reference to anything else?

A No reference to anything else.

Q Did you make or did you design and tell him how to make a rotating tone bar, or a rotating striker bar?

A For us to go through that specific order of how we develop items is a very difficult thing. We are

associates. Some times we take elements A and B and C and finally put them all together into one element. I can't give you the exact order or history. We are also working on perhaps ten or twelve other items at perhaps the same time. I can say that one of the items that I recall that had some bearing on this was that simple little ringing bell that you find on a bicycle.

Q That is the same method of making noise?

A The same method of the washers going around and making noise, yes.

Q Is it your testimony that it is just by coincidence that this long rotating tone bar came into your mind, long rotating striker bar came into your mind, striking a tone bar that is pivoted on a key that comes up and hits that element?

A Unhappily, yes.

Q All just out of the blue to you two fellows who never built an instrument of this sort before?

A To we two professional inventors, yes.

Q You testified though, about an elongated slot in the front side of the housing. Do you consider that these little vertical slots comprise an elongated slot in the Jolly Jingle Tone?

A No, they are not an elongated slot.

Q But the method for providing separate slots for keys in the two accused structures are an elongated --

A No, I didn't say that. I said I thought the Big Mouth Singers was an elongated slot, but the Melody Bell-O-Phone was not an elongated slot.

THE COURT: You think the Big Mouth Singers has an elongated slot?

THE WITNESS: That is what I said before when Mr. Sutton questioned me.

THE COURT: I didn't understand that. Each one of these is an elongated slot?

THE WITNESS: I said in combination they comprised the same function as the elongated slot, that is what I said.

THE COURT: All right.

Q I would like to pick that up. Do those slots in the Big Mouth keep the keys from flying up off of the pivot rod?

A I am not sure.

Q Isn't it a fact that the keys on the pivot rod in the Big Mouth are on there without falling whatsoever?

A You put a snapping device on instead of dropping it down, right.

Q Do you consider that the Jolly Jingle Tone --

and let's put it back together again.

It has a key support ledge attached to the front side of the housing so as to project generally parallel of the nature of Exhibit 3?

A Yes, I do.

Q Where is that?

A Right here, if I may point out to you and to the jury, the top part of this red running right across underneath there is a ledge. It runs right across and it acts as a stop, the key support ledge.

Q Do you consider that it has projections which go up into recesses in the bottoms?

A This has a rod just like your two items.

Q What limits the longitudinal motion of the keys here?

A You mean sliding back and forth?

Q In the Jolly Jingle Tone, the longitudinal motion along the rod.

A These little slots coming out of here. That is just another way of doing it.

Q The slots in the housing limit the longitudinal motion?

A That is right.

Q How is the longitudinal motion limited in the

accused structures?

A As far as I can tell, it is from the slots in the housing.

Q Please approach the devices.

A Yes.

Q I will show you that the keys come into abutment with each other when they are in place.

A That is correct.

Q And that that is the thing which limits their longitudinal motion.

A Wasn't that the same thing in the Bell Organ?

Q In the Bell Organ, if I may, and subject to your approval, there is a projection which fits up into a slot, the sides of which limit the motion.

A The keys are also an abutment.

Q We are going to go through that one all over again.

A If I may, --

Q Did you say the keys were in abutment?

A I was answering something. If I may, the differentiations here also limit the motion of the keys, whether you have those abutments or not.

Q Coming to the Bell Organ, do you not agree that the movement longitudinally of the housing is limited by

the projections and the recesses in the bottoms of the keys, and the keys are not in abutment?

A No, I disagree. I also see them in abutment to each other.

Q Where?

A They are approximately 1/32nd of an inch apart.

Q That is not an abutment then.

A You mean absolutely rubbing and touching?

Q Yes.

A Then I stand corrected.

THE COURT: You said before according to my understanding that the projections which extend upwardly from the lower side of the elongated slot fit into the underside of the keys, and prevent movement of the keys longitudinally of the opening, and longitudinally of the rod on which they are pivotally mounted. Is that or is that not correct?

THE WITNESS: That is correct.

THE COURT: So the keys don't come into contact with each other at all.

THE WITNESS: If 1/32nd of an inch is called not contact it is not in contact, I agree with that.

THE COURT: It is not called contact in my lexicon, how about yours?

THE WITNESS: You are right, it is not.

MR. RUSSELL: I feel constrained to correct a statement you made. The way you stated it, your Honor, it looked as if you felt there was a rod in the Bell Organ. There is no rod in the Bell Organ, just the projections.

THE COURT: I am sorry, longitudinally, all right.

Q At the close of your testimony in chief you were asked whether the Bell Organ looked the same as the accused devices and was the same color, and you said no, they didn't look the same, they were not the same color. Then you were asked did they function in the same way to produce sound, and you said yes.

I wanted to ask you, if there is a device which functions in the same way to produce sound as this Musser device and the only difference is that the tone bars are not directly connected to the keys, in other words, there is a tone bar here which is not Exhibit D has it, but which is pivotally connected, linked for instance, and that device makes sound in the same way, is that your opinion that it is going to be the same thing as the Musser device?

A May I ask, counsellor, if you are referring to an item that weighs hundreds of pounds which has a series of linkages, and which is very complicated for me to render

an opinion, versus an item made for mass production and simplified to be a toy and have the ingenuity to be designed as a toy?

Q Do you contend that if there was a device made exactly the same way in terms of the moving parts and so forth as the Musser device, instead of weighing two pounds and it weighed two hundred, that that would be a patentable difference -- strike that. That that would be an important structural difference?

A That is not what I said. I said this versus a device which had a series of complicated linkages, and which was not made for mass production, there conceivably could be a difference for patent.

Q Do you mean to say that if this element I am pointing to on Exhibit D instead of just having one linkage had two linkages or three linkages, that that would be a structural difference that would not be in your terms functioning in the same way to accomplish the same result?

A I am not a patent attorney. I could not answer that question.

Q Are you aware that Dr. Musser, the inventor of the patent in suit, a long time before this issue was aware of a prior construction, except for the fact that it weighed 200 pounds and had certain complexities in it,

made sound in the very same way and had a tone arm that was moved into a striking element just like on Exhibit D, with an element to limit the motion of the key so that it would not go too far and make a proper tone, were you aware of that?

MR. SUTTON: I must object only in that it is a characterization of what must be in the transcript, and I ask that Dr. Musser's statement be read as opposed to a characterization.

THE COURT: I sustain the objection. We are getting now over into the area of validity, it seems to me, and not limiting ourselves to the question of infringement, which is what the first part of this trial is to be directed.

MR. RUSSELL: I stand corrected except to the extent that the knowledge of this prior device could cause the jury to narrow such range of equivalence as they might be willing to accord to that.

THE COURT: If you want to go into that prior device as a piece of prior art, you may do so, but your question was directed to what Dr. Musser knew about the prior device, which is quite a different question.

MR. RUSSELL: I understand. This witness has said that he himself is not aware of such things, and I was curious that he had interviewed Dr. Musser when they bought

this patent and I wanted to know whether at the time he was aware that that prior device -- that Dr. Musser had told him about that prior device.

THE COURT: What conceivable relevance does that have to the issue of infringement, sir?

MR. RUSSELL: I see your point, your Honor.

No further questions.

THE COURT: Any redirect?

MR. SUTTON: One question, your Honor.

REDIRECT EXAMINATION

BY MR. SUTTON:

Q Mr. Ellman, Mr. Russell showed you Plaintiffs' Exhibit 4, with two or more keys removed. I just removed the two keys and you were able to see, were you not, that within limits these keys were able to slide lengthwise along the rod which pivotally supports them, is that correct?

A Yes.

Q In fact, when the consumer buys this item are there keys missing so that they can so slide or are these keys restricted to their locations by other structural means?

A They are restricted to their locations by other structural means.

Q If this restriction to this location is not a

result of a specific projection which sits within the recess, is there another structural element or combination of elements that serves the same purpose in substantially the same way?

A Yes, there certainly is.

MR. SUTTON: I have no further questions.

MR. RUSSELL: Nothing.

THE COURT: Thank you.

(Witness excused.)

MR. SUTTON: May we approach the bench?

(At the side bar.)

MR. SUTTON: I don't want to make a big deal out of this case. I am prepared to rest on the equivalency trial with the testimony of Ellman. I had another expert who is in Tokyo, but I don't feel he would do much more for the case, and I am prepared to rest our principal case on the equivalency trial.

THE COURT: Why don't you simply say rest? Why did you need a side bar conference for that?

MR. SUTTON: I had informed the Court and counsel that I had another expert.

THE COURT: Don't worry about that.

(In open court.)

MR. SUTTON: Plaintiff rests their case on the

issue of equivalency on this first trial in this matter.

THE COURT: All right. Mr. Russell.

MR. RUSSELL: Mr. Wuertemburg, please.

C H A R L E S W. W U E R T E M B U R G , called as a witness by the defendants, being first duly sworn, testified as follows:

DIRECT EXAMINATION

BY MR. RUSSELL

Q Would you state your occupation, please.

A Director of Product Development at Child Guidance Products.

Q Would you briefly cover your educational background?

A I graduated from Los Angeles State College in 1960 with a B.S. degree.

Q What were you studying in the course of your B.S. degree?

A Engineering. Mechanical engineering.

Q In the course of that did you have an opportunity to study engineering drawings and become familiar with engineering terms and so forth?

A Yes, while I was going to school I was also working as a design draftsman.

Q What do design draftsmen do?

A Make the kind of drawings that you have up on the board rather than patent drawings, we do detailed drawings and work on component parts of various products.

Q What did you do after graduating? Give a brief rundown of your jobs and the type of work you have been in.

A For the last fifteen years I have been associated with the toy manufacturing business. After graduating and while I was still going to school I was employed by the Mattell Company for five years. After leaving Mattell I went with the Wham-O Toy Company for two years.

Q May I ask what are some famous toys Mattell makes?

A They made the Talking Dolls, the Charming Chattie, Cathy Chattie, Talking Telephones, as well as miscellaneous boys' toys, rifles and so forth. Then I was at the Wham-O Toy Company which is known for its Hula Hoops and Frisbees. I was there for two years. I was one year with the Revell Toy Company, which is a kit manufacturer.

Q What kind of kits do they make?

A They make ostensibly model airplanes and cars. I was hired to develop a craft line for adults.

Q Small motors and that kind of thing with working parts?

A No, the craft line I was working with was mainly sewn goods, a woman would make a plaque for the wall, for instance. After leaving the Revell Company I joined the Eldon Company, which made electrical toys in the main, that is, slot car race sets, battery driven child ride-on toys. I was there for two, three years, and then I went to the Topper Corporation on this coast and they were involved with both boys and girls products. They had the Johnny Lightning series of toys which included cars.

Q Did they have any musical instruments?

A Yes, they had musical instruments at Topper. Musical toys. They weren't specifically instrument shaped. But music boxes of a sort.

Q Tone bars?

A Vibrating wreaths, similar to what is in small powder boxes and so forth, that type of movement.

Q After Topper?

A I went to an East Coast Division of Mattell, which is called Standard Plastics. Then from Standard Plastics to my present company at Child Guidance.

Q What is your capacity at Child Guidance?

A Director of Product Development.

MR. RUSSELL: If your Honor please, I would like to offer in evidence defendants' Exhibit A, which is

the file wrapper and contents of the patent in suit, including the prosecution histories of both the apparent application and the application at issue that is the patent, and Exhibit B, which is our prior art book which has been previously submitted in accordance with Title 35 USC 282.

MR. SUTTON: I have no objection to the prior history, I just want to be sure that I have copies of the patents in suit.

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(Defendant Exhibit A received in evidence.)

MR. SUTTON: Subject to my reviewing these to make sure we have copies, I have no objection to these being admitted.

***

(Defendant Exhibit B received in evidence.)

MR. RUSSELL: If your Honor please, I have here six copies of the book, and in order for the jurors to know which tab the witness is referring to and see a picture of it, it is my proposal to hand up to the jury a copy of this. I do not have -- perhaps some of the jurors could oblige by looking over one book, two of them each.

THE COURT: All right.

Do you have a copy for the Court?

MR. RUSSELL: I thought I had given the Court

a copy.

THE COURT: You may hand copies of Exhibit B to each member of the jury.

MR. RUSSELL: I might also note for the record that the witness likewise has a copy of this book, which we have gone over in the past.

I would like to ask the witness if he is familiar with this book, Exhibit B?

THE WITNESS: Yes, I do.

Q Have you studied the patents in it?

A Yes, I have studied it and I have made some notes.

Q Would you refer briefly to tabs and not to slow things down, state for me whether or not you are familiar in the prior art with toy piano constructions employing a housing having an elongated slot in the front face to receive keys?

A Yes, sir. There are quite a few in here. Briefly they are Tab 2 --

Q Tab 2, where would you see the elongated slot, for instance, in Figure 1?

A Figure 1 shows the key protruding through the slot, key F.

Q And the slot is just below that decorative

portion?

A Just below and to the left, that is correct.

Q Your next tab?

A Tab No. 4. That slot is formed in Figure 1, approximately where the letter F is pointing.

Q The next tab?

A Tab No. 5 -- I beg your pardon. Please skip tab No. 5. We have a clear one on tab No. 7. Tab No. 7 shows a slot at approximately Figure 2 with a number 9 pointing.

Q Next?

A Tab No. 8, you will see a slot in Figure No. 2 at about where the B 31 is pointing.

Tab No. 9, on Figure 2 at approximately where 32 is pointing.

Q I think we are beating a dead horse. Would you look at No. 19, please?

A Tab No. 19, ABB 1 shows such a slot. It doesn't have a letter or number pointing to it, but the key G runs beneath that slot.

Q I have a blown up view of the drawing of tab 19. You were saying what?

A The key G runs beneath that slot, through that slot at that point where your pencil is now.

Q This would be the upper part of the slot?

A Correct.

Q Do you see in the prior art keys mounted to rotate on a horizontal pin?

A Keys rotating on a horizontal pin or rod?

Q Or rod, yes.

A If you look at tab No. 1, Figure 1, both in figure 1 and 2 indicates a rod or pin at the pivot point of the keys.

Q Is that that dotted line in Figure 2?

A The dotted line in Figure 2 just shows you it is a continuous bar rather than a short pin.

Q How about tab 4?

A Tab 4 in Figure 1 shows the end view of the pin and figure 2 shows the pin in its full length as it goes through each key.

Q How about tab 8?

A Tab 8, yes. Tab 8 shows in Figure 2 pin number 25, which is such a pin or rod.

Tab 11, if you wish me to go on, tab 11 in Figure 2 shows pin 11.

Q How about 12?

A 12 also -- on number 12 it isn't pointed out, but on Figure 2 and Figure 3 the key 2 comes through the

wall and is joined with a rod indicated by the dot with a circle.

Q How about 18?

A 18 also. In this case on Figure 1 and 2, the pin is indicated by number 12.

Q How about in 20?

A In Figure 20 -- no, sir, that is not.

Q How about the figure 7 in tab 20?

A Figure 7?

Q Tab 20.

A Yes. There are four pages of figures here with all types of pivots. On Figure 4 and Figure 7 both indicate a pin with a number 2 that the key pivot is on.

THE COURT: Also Figure 10.

THE WITNESS: Yes.

Q How about keys mounted on projections fitting up into slots, with the projection and the slot cooperating to limit motion longitudinally of the instrument?

A Yes, sir, on tab No. 9 it clearly shows in Figure 8, actually it is a combination of Figure 8 and Figure 7 which shows the key about to be placed on one of these projections.

Q Is that the key --

A Key 67 is being placed on projection 66.

Q And is fitting into -- what is the number of the slot?

A The number of the slot is 68.

Q Limits the longitudinal motion and it limits motion in all directions?

A Yes, and it is also capable of serving as a fulcrum. 10 I believe is the next one.

THE COURT: It doesn't limit movement in the upward direction.

THE WITNESS: Only in one plane.

Q What limits the motion in the upward direction in tab 9?

A On tab 9 the key is fitted through the wall 21 and forms a slot. That prevents the key from moving upward.

Q The upper edge of the slot?

A Yes, sir.

THE COURT: Shown by the numeral 32 in Figure 2.

THE WITNESS: Yes, I didn't want to get too specific, 32 is actually pointing to a felt dampener but, yes, that is the location of the upper edge of the slot.

Q Move on to the next one.

A Tab 10, my particular illustration is a little vague, but in reading the text it does show that there are projections rising from the plate 60.

Q Fit into --

A Fit into key K. We do have clear tabs as we go back.

The next tab is tab 15.

Q My question was limiting motion longitudinally.

A Yes, if you look after going into tab 15, which I almost passed over, on Figure 7 it does show -- it is either 5 or 7, excuse me -- that there can be projections or a single wall so it does cover both in this particular patent.

Q That would be the difference between Figure 6 and Figure 7 in tab 15?

A Yes.

Q Your next tab, sir?

A Tab 16, and that would be Figure 3 and Figure 4. Figure 4 is a section taken right behind or right in front of the fingers and if you look at Figure 4 you can see that there are individual projections, projections numbered 30 in Figure 4, that the key is pivoting on and acts as a limiter inside to side movement.

Q How about 19?

A 19, yes. In this case, relying on the text as well as the picture, there are noted projections, in this case pins that rise into a hole in the key.

Q Are you talking about the pins to which I am referring?

A I am talking about the key pin which is the upper set of pins referring only to the keys.

Q These up here?

A Yes, the key is pivoting on that pin and is limited in movement by it, side to side movement.

Q Longitudinally of the housing?

A Yes.

Q Also in the direction out, in any direction, is that correct?

A Correct.

Finally, I did find a use in tab 20.

Q Which figure?

A Just a moment please. If you look at Figure 16 you will see pin 47 that has a conical shape top to it, resting in a similarly shaped slot. In this case that projection allows the pin to rotate, but the other apparatus keeps it in place.

THE COURT: Will you look again at tab 19.

THE WITNESS: Yes, sir.

THE COURT: I think you said that those vertical broken lines were pins according to the text.

THE WITNESS: No, sir, I said I had to rely

both on the text and the picture.

THE COURT: I don't see anything about those broken lines in the text.

THE WITNESS: The only thing that is spelled out in the text -- I was referring to further actually those areas being pointed at in the letter where the text clarifies.

THE COURT: The text does not say what those vertical broken lines are.

THE WITNESS: No.

THE COURT: What gives you the impression they are pins?

THE WITNESS: In order for it -- having no more in front of me than just the blown up picture, for instance, it would have to go through or into the key, that is a universal code for a hidden line is a broken line. I see the line is solid as it either exits the key or goes into it, and then it is broken. So if it were proper drafting procedure made that shows there was an internal part into the key as a pin.

Q Do I understand that the element that I have my fingers covering pivots from my index finger down?

A Not nearly as far as you bring your fingers down. You can see a gap in front of the little rectangle,

and that is as far as the key can go.

Q And would come down against the element that I am pointing at now?

A Yes, it would rest against that.

Q And it would then push against the element which I assume is L on both sides.

A If we keep it in the same perspective, the key that is shown closest or clearest is actually pushing down or pivoting the tone arm to the right, to the front.

Q Am I pointing at that one now?

A Come back one.

Q This one here?

A Yes, that activates the forwardmost tone bar eventually.

Q The one I am now pointing at?

A Yes.

Q And the other key G?

A Activates the rear one, the one furthest in the back.

Q The key being depressed, key G being depressed against the black object which I assume is the stop?

A Yes, sir.

Q Then pivots the tone bar to the position shown on the left at which it would be in playing position, is

that correct?

A That is right. That is what this shows, one in playing position and one not in playing position.

Q What keeps the key G, or the other one that is unlabeled from coming off of the pin to which you are referring?

A I went through this on the last question, and that was the opening of the front of the piano, the horizontal opening.

Q Keeps the key from coming up?

A The top edge is formed by the horizontal part of the housing, and that traps the key in place.

Q What about some patents in here which show toy pianos with the key support ledge attached and protruding from the front of the device to make it look like a toy piano? Would you point to some of those?

A Sir, I was more interested in your wording which is a little off -- I was looking for a positive key stop placed in the front of the piano regardless of its esthetics. It may not help the appearance, but it is a definite stop.

Q Let's have the point to which you just addressed yourself.

A Look at tab 2, Figure 1, there is a stop for

the key to rest on. There is no arrow pointing at it, but it is just above and slightly to the left of the letter Figure 4, so it is right underneath key 4.

THE COURT: No, I think you called the wrong number. Look at Figure 1 and look under numeral F.

THE WITNESS: I said 2 and pulled up 3. Figure 1 does not do it. Tab 2, yes.

The key F is shown directly above the stop which is unlettered or unnumbered. That limits the throw of the key.

Q Now you can go to 3.

A Now we go to 3, and again in the front of the device is a similar pad that limits the throw of the key.

Q Now you can go to 3.

A Now we go to 3, and again in the front of the device is a similar pad that limits the throw of the key. In this case it is key number 4.

Q Move on.

A Tab No. 4, Figure 1 shows a pad B that is limiting the travel on the down stroke.

Q How about 7?

A Yes, 7. On Figure 2, 7 shows key No. 6 to be poised above another unmarked, unnamed pad.

Q This incidentally looks like a piano, doesn't it?

A It does look like a piano, yes, sir.

Q How about No. 9?

A No. 9, yes. If you refer to Figure 2 on tab 9 there is a support bar numbered 24 that is for limiting the movement of the key.

The next tab would be tab number 10. I prefer to go past 10. There are some clearer ones ahead. Tab number 15, please. Tab number 15 again shows an item 56 in Figure 3 and the lower portion of it acts as a stop.

Tab number 16 --

THE COURT: You don't mean the lower portion of it?

THE WITNESS: Number 56 is actually a series of fingers that raise out --

THE COURT: But it is the upper end of those fingers that engage the underside of the keys 12.

THE WITNESS: I assumed that it was the lower side, sir, only because it would be easier --

THE COURT: If you look at Figure 3, it shows in broken lines the depressed position of the keys 12, doesn't it?

THE WITNESS: It does.

THE COURT: They don't engage the lower end of the projections, but the upper end?

THE WITNESS: That is right.

Tab 19, that is the one with the little H [illegible] below it.

Q To which I am pointing now?

A Yes. The one you are pointing to now for the other key.

Then Number 20, again this patent on 20 has so many different types of things. For example, Figure 7 there shows underneath the Number 5 a block that could be used, Figure 7 underneath the key under the letter 5 could be used as a stop. In Figure 21, the bottom of the page shows a key number 1 which is acting as sort of a symbolized pivot point, but also approaching a symbolized stop in the form of that cone, and so on.

Q So much, Mr. Wuertemburg, for individual items of construction. I would like to now focus your attention in the prior art on combinations that were also known.

I ask you: Are you aware in the prior art of a device in which there is a bar that carries rotating triggers on it that has elements that look kind of like washers that would be rotating around, driven, and then there be a bar with a resiliently mounted tone bar on it, and through a linkage a key would be depressed so that it would push the tone bar into a special position where those

rotating elements would hit the keys and just ring them, and this device would have keys that were pivoted on projections, and that would pass through an elongated slot in the front of the housing and that the keys would be not directly connected to the tone bars, but acting through a linkage on the tone bar, are you aware of such a device in the prior art?

A Yes, sir.

Q Which one is that?

A That is tab number 19.

Q Is that the one here?

A That is correct.

MR. RUSSELL: This is marked Exhibit C 3, your Honor, and perhaps I will offer the C 3 for identification at this moment. C 2 is the photo enlargement of the claim with various colors underlined, and C 1 being a much enlarged view of the drawing of the patent in suit.

I offer them in evidence.

(Defendant Exhibits C 1, C 2 and C 3 received in evidence.)

Q Your answer was with respect to tab 20 in the book?

A They are all embodied in this one patent.

THE COURT: Tab 19?

THE WITNESS: Yes, tab 19.

Q Tab 19 in the book and Exhibit C 3, I am sorry, your Honor.

With respect to tab 19, are you aware of the date of that patent, sir?

A 1931.

MR. RUSSELL: Will counsel stipulate that all of these are patents prior to the Musser patent, standing as prior art? I don't want to go through all the dates.

MR. SUTTON: A lot of them have been cited in the Musser patent. I will stipulate unless I find one that is not the case. Yes, all of these dates are prior art.

MR. RUSSELL: Could I have a couple of seconds, your Honor?

THE COURT: All right.

MR. RUSSELL: If your Honor please, I have a rather extensive series of questions now with respect to the manner of construction of the accused device, the matter of their assembly and the nature of how the keys function and so forth. It will take about a half hour, perhaps maybe more. I was wondering, do you want me to embark on that now and go as far as I can?

THE COURT: What is the relevance to the issue

of equivalence of the way the accused devices are manufactured? We are concerned here with how they work and not the manufacture.

MR. RUSSELL: In one point, your Honor, the Musser in prosecution of the patent said to the patent office, one of the great advantages of the upstanding projections and the recesses was that during manufacture they could simply be dropped in place.

THE COURT: If that is your point I think you ought to go ahead, because I don't think that should take a half hour.

MR. RUSSELL: That is not the only thing. I am going to go into the construction as well.

THE COURT: Let's go ahead for another fifteen minutes.

MR. RUSSELL: Yes, sir, your Honor.

Q With respect to the Big Mouth, Exhibit 4, and the Melody, Exhibit 5, will you state please whether or not the Big Mouth has a housing in the front side -- strike that.

I want to start further back and ask you in accordance with the patent in suit what is the purpose of the elongated slot in the front side of the housing?

A With which toy?

Q The Bell Organ, the patent in suit, the Musser

patent.

A With the Musser patent the slot does two main uses. One, it prevents the keys from disengaging while the toy is in play. It forms a top part of the key support. The other, it simply allows the keys to come from the inside of the toy to the outside of the toy to be pressed.

Q Will you state for the jury whether or not Big Mouth, Exhibit 4, has a slot, an elongated slot in the front side of the housing which serves the same purpose and in substantially the same way to achieve the same result as the slot in the Musser patent?

A Definitely not, sir.

Q What is the difference in the function?

A The slot does not prevent the keys from coming out in that exhibit.

Q What prevents the keys from coming out?

A They are fastened to a rod or a bar, connected in some manner. That bar and the fastening thereto keeps it from falling out.

Q In relation to the second element -- I will go to the third element marked in yellow. A plurality of projections capable of serving as fulcrums mounted on said housing adjacent to said slot so as to project upwards from the lower edge thereof, combining that with the green, a

recess located in the bottom of the key, each said recesses receiving one of said projections. I would like you to state for the jury what is the purpose of those two elements that I have recited in combination.

A The two of them together form the pivot point that the key must work around. The finger being half of the pivot point and the key recess being the second half of the pivot point.

Q What do they accomplish in combination?

A They act as a fulcrum or a pivotal point, and they also keep the keys from -- they hold the keys in place in a lateral direction.

Q Do you find anything in the Big Mouth, Exhibit 4, which serves the same function in substantially the same way, or which does the same work in substantially the same way to accomplish substantially the same result?

A Yes, the same result is performed, but in a different manner.

Q How is it done in the Big Mouth?

A It is more like a real hinge, that is, there is a hinge pin that goes through a key.

Q What is it that limits the motion longitudinally of the equipment?

A Extra material was molded onto the outside of

the keys so that there would be greater width in most areas.

Q Would you point to the material.

A The two wings or ears molded to the outside that hold the keys apart so the frictional component is at the small areas and they limit the side-to-side movement in the assembly.

Q May I take two keys and put them together like that, and I will illustrate it.

A Yes.

Q Did you hear Mr. Ellman testify that it was the sides of the slots in the housing which limited the motion longitudinally of the slot?

A Yes, I heard.

Q Is it true?

A No, it is not true. The slots are a cosmetic device to keep the gap from being apparent.

Q Or keep fingers from falling into the gap?

A Also keep fingers from falling into it. We are very sensitive about pinching actions on small toys.

Q How about the blue and the black combined, key support ledge attached to the front side of the housing so as to project generally parallel to said slot, and said keys being capable of being engaged on the outside of said housing so as to be pushed into engagement with said key

support ledge so as to rotate side keys without key projections to a playing position.

First, will you state whether in the Big Mouth Exhibit 4 there is a key support ledge which serves this function of limiting the key in a playing position?

A There is no key support ledge as stated there.

Q What limits the motion of the tone bar in the playing position?

A With this design, with the rotating washers, the key must be held very close or else you get a very flat note, or you get no note at all. In the case of the Big Mouth Singers we put the key support right over the tone bars, in this case it is the fork rod that its length, as it is pushed up by the tone bar, is limited by the travel of the apparent mouth opening in the top of the toy. So we have in fact a number of key supports that are movable and located directly over each tone bar.

Q Located over the tone bar and as the tone bar rises it pushes the little head up to the place where the mouth opens and that is as far as it can go, is that it? At that point it is in playing position?

A That is correct. And no amount of pushing or distortion of the key in front will allow that tone bar to come up any further.

Q Is there any advantage in putting it in the back rather than in the front as defined in Exhibit C 2?

A Yes. In these particular cases, it may not always be but in these cases there is an advantage in that the tolerances of plastic should always be designed to be as loose as possible. The part should be made so that they are not critical if at all possible, so by putting the limiting member close to the part that you are actually limiting is a saving in technological -- I am running out of words.

THE COURT: You got on the wrong track. It isn't a saving in anything, it gives you more of a stopping point.

THE WITNESS: I almost said tooling dollars.

THE COURT: In adding an extra stop you don't save anything in tooling dollars.

THE WITNESS: No. It is reducing the tolerance needed.

Q You get a more accurate positioning?

A Yes.

Q Did you hear Mr. Ellman say that the limit in the Big Mouth, Exhibit 4, was performed by the front edge of the opening in the housing?

A Yes.

Q Is that true?

A No.

Q What is your answer to whether or not the Big Mouth incorporates the blue and the black to accomplish or to do the same work in substantially the same way to accomplish the same result?

A We accomplish the same result. We don't do it in the same way at all.

Q We have been talking about Big Mouth, Exhibit 4. I have to go through the same series with respect to Exhibit 5, which is the other accused equipment.

A Would you tell me which is Exhibit 5? I understand we have two.

Q We do have two. I am going to have to refer to them one right after the other.

Have we agreed that the two Melody Bell-O-Phones will be Exhibit 5 and 5 A?

MR. SUTTON: Yes, Exhibit 5 A is the one with the metalic rod in the back.

Q Would you like to step down and see the difference between Exhibits 5 and 5 A? 5 is the one which has the springs in the front and no bar in the back. 5 A is the one that has no springs and the bar in the back.

A Yes.

Q Will you state whether or not in Exhibit 5 there is an elongated slot in the front side -- a housing having a front side formed with an elongated slot therein?

A No, there is not.

Q Is there anything in the Melody Bell-O-Phone, recalling your testimony as to the function of that slot in the patent in suit, which performs the same function as the slot in the patent in suit in substantially the same way to accomplish the same result?

A No, it is not. In this case it is that there is no one edge in those individual slots that retain the keys. As a matter of fact, the keys are retained on three edges. There is just no similarity. The keys in this particular case must not pivot, they must move up and down for this toy to work, not to work, for this toy to perform as designed.

Q What about there being projections on the lower edge of an elongated slot?

A We don't have an elongated slot, we don't have a lower edge. In any case, we don't have any projections that are acting as fulcrums in either one of those.

Q Meaning either 5 or 5 A?

A Correct.

Q Did your testimony about the slot apply to 5 A

as well as to 5?

A Yes, sir.

Q Will you perhaps explain functionally what limits motion of the keys in 5 and 5 A --

A Well, in 5 A the bar is added to the back of the device to prevent the keys from going beyond their design stroke.

Q In 5 A?

A Yes, that is the purpose of the metal bar on the back side.

Q What limits the motion of the keys -- not the keys -- these are tone bars in this instance?

A They are tone bars and not keys.

Q What limits the tone bar in playing position in 5?

A Frankly, this is the first time I have seen this exhibit. In all of the others there was not this particular combination with the tone bar removed. I possibly could tell you if I take another look at it. Right now I believe that there are projections underneath each of the tone bars that stops the tone bar from moving beyond its designed travel.

MR. SUTTON: Excuse me, your Honor, and Mr. Russell, there is reference by this witness to a tone bar,

and throughout the testimony I have assumed that the tone bar is the item that produces a tone.

THE COURT: I think he is using it in the same way, isn't it?

MR. RUSSELL: In that last answer he did get confused with the word tone bar and the piece supporting it.

MR. SUTTON There is a plastic item and a metalic item supported with rubber items.

Q Perhaps the witness can step down and take a look at it and restate his answer.

A The limit of the tone bar is because the tone bar carrier, the plastic bar under the tone bar has a small stop under each one.

Q An upwardly projecting small stop?

A Yes.

Q In the item you are holding in your hand, Exhibit 5, do you see a key support ledge which extends in front of the device to make it look like a piano?

A No, sir, there is nothing. Since the key isn't here there is nothing to show that the key is stopped by anything. My point is there is no key here, there is no key support ledge.

MR. SUTTON: If I may, your Honor, the reference to a piano, there is no reference to a piano in the claim,

and I tried to avoid objecting in the past, but less the jury misunderstand, I think some statement should be made about reference to it or about the relevance of either of these devices, assuming the shape of a piano and the claim in suit being referred to makes no mention of the piano.

THE COURT: He has made the point that one of the functions of the key support ledge is to enhance the resemblance to a piano. You can argue to the jury that that is not one of the functions contemplated by the patent claims.

MR. SUTTON: Thank you, your Honor.

Q With respect to assembling the keys, and calling to the witness's attention a statement in the file wrapper at page 30, 29 and 30 that the keys can be assembled with tone bars on them and then they can be merely dropped in to place, will you state for the Court whether the keys, the tone bars or the keys in any of these three accused devices can be merely dropped into place during assembly?

A You are asking me about the tone bar carrier in this case?

Q Yes?

A In 5 or 5 A, neither one of them can be simply dropped in place and with respect to 5 A it can't even be forced into place.

Q You have noticed that we can snap them on and off. Do you know whether or not that is done in assembly?

A If I may, I can only say that I have never seen this unit made but I have seen in the Orient similar units made, and I can only tell you how the similar unit was assembled.

Q Go ahead.

MR. SUTTON: I object to testimony about a unit not involved in this lawsuit, your Honor.

THE COURT: Have you ever seen any of these units assembled?

THE WITNESS: No, sir, everything in the case here was manufactured in Japan.

THE COURT: I am going to sustain the objection then.

MR. RUSSELL: Very well, your Honor, no further questions.

THE COURT: Are you going to have any cross?

MR. SUTTON: Yes, I am, your Honor.

THE COURT: We will take our evening recess now, and come back at ten o'clock in the morning. Please be on time so that we can start promptly. In the meantime, don't discuss the case with your fellow jurors or anyone else. Have a good evening.

(The jury left the courtroom.)

THE COURT: Are you going to have any other witnesses, Mr. Russell?

MR. RUSSELL: Yes, sir, I have a relatively short series of questions for Dr. Kern.

(Trial adjourned to December 16, 1975, at 10:00 a.m.)

GEORGE LERNER, et ano.

vs. 73 Civ. 2006

CHILD GUIDANCE PRODUCTS, INC., et ano.

December 16, 1975
10:00 a.m.

(In open court. Jury present.)

C H A R L E S W. W U E R T E M B U R G , resumed.

THE COURT: I guess we have the last witness. We completed his direct and are ready for his cross.

MR. SUTTON: My opposing counsel has a request.

MR. RUSSELL: In reviewing my notes last night I noticed that I had failed to cover several important points with Mr. Wuertemburg.

THE COURT: I never saw it to fail, so go ahead.

DIRECT EXAMINATION

CONTINUED BY MR. RUSSELL:

Q Mr. Wuertemburg, on the subject of the limitation of the keys in the striking position, I would like you to produce the device which you brought with you.

MR. RUSSELL: Would you mark this please.

(Defendant Exhibit D marked for identification.)

Q Would you explain to the ladies and gentlemen of the jury in holding it up, what this exhibit is and what it shows?

A In the question of whether the keys are limited by the front, the back or some other intermediate area, I took this standard unit out of our stock and I cut away in some cases the front, in some cases I pulled out the forked rod that released the head altogether, and in some cases I did both.

Q For the record, please would you state which item it is?

A Big Mouth Singers.

In hearing the difference in the tone is what I was looking for. In the first key I took both the forward and back areas free. There is no restriction on the key to stop the motor. On the second one, second and third actually to make sure there wasn't a fluke, I removed the front portions only.

Q Can you state whether or not that is the normal way it should play?

A Yes, it is. We have keys here -- one key here that is not changed at all. So it is the volume and the speed of the motor showing that it is not a stall. The next to the end keys I removed the forked area from actually

three keys leaving intact the front of the unit, but removing only the three forks in the back.

Q What happens then?

A Then the motor stalls and it shows that the key is not restricted as it moves in to the striker arm.

MR. RUSSELL: I marked Defendant Exhibit D with a magic marker.

I would like to move that Defendant Exhibit D be offered in evidence.

MR. SUTTON: I oppose the offer of this exhibit in evidence. I oppose it and will show why during my cross, your Honor.

THE COURT: I will permit you to defer your objection until you have had an opportunity to cross. Or if you want voir dire on the exhibit at this point, you may have it.

MR. SUTTON: I actually prefer to let Mr. Russell complete his questioning.

THE COURT: I thought he had completed it.

MR. RUSSELL: I have some other things, your Honor.

THE COURT: Go ahead.

Q With respect to the Bienengraber patent which is tab 19 in Exhibit B, a drawing of which we have on the

board as Defendant Exhibit C 3, and Mr. Ellman's testimony about its being complex, will you state for the ladies and gentlemen of the jury the nature of the striker element that I am pointing to in the Bienengraber patent and compare it in complexity to the Musser patent, the patent in suit?

A It is basically the same.

Q No more complex or less complex?

A No more complex.

Q In relation to the tone bar which I am pointing to now, one on each side of the striker, but taking one alone, is that more complex or less complex than the tone bar in the patent in suit?

MR. SUTTON: If I may, I only object to the form of the question in that Mr. Ellman's testimony, as I understand it, talked about a complexity of a linkage between pressing the keys and producing the sound, not that each element was complex.

THE COURT: I will give him a moment to come to it. Overruled.

A The tone bar is not a complex system.

THE COURT: That wasn't the question, the question is whether it is more complex from the corresponding element in Musser.

THE WITNESS: The tone bar itself in the

Bienengraber patent is not any more complex than the patent in the case.

THE COURT: Slightly more so. It has a crank arm on it.

THE WITNESS: It depends if we stop the questioning at that part or if we talk about the linkages --

THE COURT: I am talking about the crank part which is the integral part of it.

Q Does adding a crank arm make it any more complex?

A No, sir, it is still part of the same piece of material and it is one piece with a chime attached to it being, in my estimation, a similar complexity.

Q Would you refer to the complexity of the item which was just referred to as a linkage, including, as I understand it, the keys that are pressed and further elements which would actuate the tone bar,and would you address yourself to the complexity of that in relation to the complexity of Musser, the patent in suit?

A It is more complex, more pieces involved.

Q Is this a serious complexity in your experience in the toy field?

A No, sir, it is fairly standard linkage arrangement.

Q Are you familiar in the toy field with linkage arrangements?

A Quite familiar, yes.

Q In terms of the housing in the slot through which the keys pass, will you comment on the complexity of that? That is in relation to the complexity of Musser.

A The upper housing with the slot is approximately the same complexity as the Musser patent.

Q Now will you address yourself to your general opinion as to the overall complexity of the two devices, Bienengraber versus the patent in suit.

A The Bienengraber patent item is more complex in that it has more separate pieces to achieve the same result. However, the complexity difference is very small in scope. Again more pieces but nothing unusual in their combination.

Q You heard mention the other day, as I mentioned to Mr. Ellman that there had been a statement that the Bienengraber weighed 200 pounds and we know that the Bell Organ only weighs a couple of pounds. In your experience, I would like you to comment from your experience with respect to importance of such a difference in weight, 200 pounds versus 2 pounds.

A The toys I have worked on, I worked from everything from toy steam engine, toy locomotives, gasoline

driven airplanes, etcetera, and the difference in weight from a prototype to a toy is usual, it is usually scaled down.

Q Is there, in your opinion, any significant difference in the method of operation of Bienengraber versus the Musser patented device?

A No, sir.

MR. RUSSELL: I would like to turn to the claim, your Honor.

We have in Defendant Exhibit C 2, claim 1. But we did not put before the witness claim 7, which is also accused of infringement. Your Honor, there is a difference between claim one and claim 7, and in an effort to keep it short I wanted to just talk about the difference. I have underlined on a copy of the patent that difference. I would like to ask my brother if he will agree that that is the sole difference between the two claims.

MR. SUTTON: No, it is not. I believe claim 1 talks about a key support ledge. This recites a ledge. I would be more than happy to let you proceed with the language of claim 7 as is.

THE COURT: Well, claim 7 in line 3 refers to a ledge whereas claim 1 at line 3 speaks of a key support ledge. However, claim 7 in the last line of column 5 refers

to said key support ledge. There is no antecedent in claim 7 for the words key support in the last line of column 5. I think it is only fair to read them by implication into line 3 of column 7, so that it becomes identical with claim 1 in that respect. Do counsel disagree?

MR. SUTTON: I will stipulate to that.

MR. RUSSELL: I agree.

Otherwise the underlined portion is --

MR. SUTTON: I will take your word for it.

MR. RUSSELL: Thank you.

With this in mind I will read the underlined portion which is different from claim 1. In claim 1, a tone bar resiliently attached to each of said keys. In claim 7 the following wording appears, means extending upwardly -- I will point as I go and if you object to my pointing --

THE COURT: Let me suggest this, gentlemen, less we complicate this to a point where it not only becomes difficult for the jury to understand it but to a point where it really isn't significant. In the respect in which claim 7 differs from claim 1, there is no real dispute. The defendants' accused devices have the elements called for in those portions of claim 7 which are different from claim 1, that is they have means extending upwards from each of the keys within the housing, resilient means located above each

of the keys with respect to said means projecting upwards from the keys and the tone bars are closely held against the lateral movement by means projecting upwards from each of said keys. So why don't we simply agree that claim 1 is representative of both claims 1 and 7 for purposes of this case.

MR. RUSSELL: I am happy to agree to that.

THE COURT: We can forget the differences between claim 1 and 7 and stand or fall on claim 1.

MR. RUSSELL: Your Honor, I am sorry to be picking a small point, but is there two points? One is whether there is an infringement, and the second point is whether the prior -- how close the prior art is to the claim for the jury to be able to determine the scope of equivalence. If you want to take it both claims, claim 1 to represent both claims for that purpose too, I am quite happy.

THE COURT: That is what I understand we were doing.

MR. RUSSELL: Okay. I won't go into claim 7.

THE COURT: All right.

MR. RUSSELL: I did want to ask the witness now with respect to claim 1, the Bienengraber patent, with respect to whether or not Bienengraber discloses every

element, not just the ones underlined in red, blue, yellow, green and black -- first I will ask you have you studied the claims for the purpose of determining whether it -- whether Bienengraber discloses all the elements in that claim?

A Yes.

Q Does it disclose all those elements?

A Yes, it does.

Q Does it disclose a tone bar resiliently attached to each of said keys? This would be a tone bar and I take it the key is the thing that is pressed.

MR. SUTTON: I object. I would like the witness who already testified that another element than that just pointed to by counsel represented a key that was to be depressed by the player, and I don't mean to take questioning away from opposing counsel, but I would like the witness to show that they are the same and not opposing counsel to lead.

MR. RUSSELL: That is a good point. Please step down and show the jury, if you will, what is the key and what is the tone bar and where it is resiliently mounted and connected.

A The key is specified with the letter G. What I have questioned in mind is whether the member H is rigidly

or loosely attached to B.I. If it was rigidly attached, and this is all one unit, I have taken the position that G and H are really the same piece, rigidly attached and loosely attached or touching this bar. The resilient attachments are the circles M that allow the vibrations of the tone bar to be free and the tone bar carrier.

Q In this device of Bienengraber is the tone bar resiliently attached to each of said keys, now that we have identified which is the key and which is the tone bar?

A I answered a little too quickly. It is not resiliently attached to the key. It is resiliently attached in the system.

Q Have you checked all of the other components of claim 1?

A Yes, I have.

Q And are they or are they not in Bienengraber?

A Yes, they are.

MR. RUSSELL: No further questions, your Honor.

THE COURT: All right, Mr. Sutton.

CROSS EXAMINATION

BY MR. SUTTON:

Q Mr. Wuertemburg, you testified on your direct examination that you are presently the Director of Product Development for Child Guidance Company, which I understand

presently is a division of the defendant Questor Corporation?

A Correct.

Q Can you tell us what your responsibilities are as the Director of this organization or the Director of the Product Development section of this organization?

A I am responsible for the development of the toy products in the Child Guidance division from concept through to release to the manufacturing department.

Q How long have you been in this position as Director?

A Approximately one year.

Q How long have you been with Child Guidance in toto?

A About one and a half years.

Q Were you at the company -- I think it is obvious you were not with the company Child Guidance when it came out into the market place with its Big Mouth Singers item, Exhibit 4, its Melody Bell-O-Tone items, both Exhibit 5 and 5 A without the springs, and the Schroeder's Piano item previously referred to, is that correct?

A No, it is not.

Q You were with the company?

A When the Schroeder Pieno came out, not the others.

Q Fine.

The Schroeder's Piano is not an accuese device in this lawsuit. The two accused devices represented by Big Mouth Singers and the two structures of Melody Bell-O-Phone are what I will direct my questions to now.

Are you salaried on the payroll of Child Guidance Products?

A Yes, I am.

Q Can you tell us whether you have participated in the design of toy musical instruments in the past?

A Yes, I have.

Q Can you tell us how many you personally designed or invented?

A I have not invented any musical toys. I have only worked on the design development of musical toys.

Q About how many have you worked -- when you say you worked on the design and development, I take it you were part of a team?

A Yes, the product usually came in in a preliminary stage, and I was involved in getting the cost and the manufacture built in the line.

Q When you say a preliminary stage, that preliminary stage could have been in the form of a prototype or drawings, is that correct?

Q A prototype of the type evidenced by the Jolly Jingle Tone that the plaintiffs claim to have invented?

A Yes.

Q Not the specific item, of course.

A Yes.

Q And then you would take the prototype and either alone or in concert with others would come up with a production prototype or drawings which would be the basis of the finished item, is that correct?

A Right.

Q Have you ever obtained or have any of the toy musical instruments that you have either worked with others on or developed yourself produced a carillon sound of the type I just played on the Big Mouth Singers item?

A A sound, yes, a carillon sound, yes.

Q A carillon sound?

A A carillon sound.

Q Can you tell us which item that was, other than of course the Schroeder's Piano that you just referred to previously?

A At Mattell I worked on three musical units, none of which turned out to be marketable, utilizing carillon sound. None of them used tone bars or rotating member to strike them.

Q My question concerns items that have reached the market place, that have been marketed and been available to the consumer to buy. Has your background included any design or development or invention either alone or with others of a toy musical instrument that produces a carillon sound of the type I am playing on the Big Mouth Singers?

A No, it has not. Excuse me, talking about in my whole experience? I worked on the Schroeder's Piano.

Q Yes, I understand that.

Have you ever obtained during your design experience one or more patents in your own name?

A Yes.

Q About how many?

A One.

Q Was that concerned with a toy musical instrument?

A No, it was not.

Q Then you are at least somewhat familiar with the procedures that you went through in order to obtain the patent. That was handled by a patent attorney, I take it.

A Correct.

Q You understand that the patent includes drawings, includes a descriptive body of material and it includes one or more claims?

A Yes.

Q Did you prior to joining Child Guidance have in any way any affiliation with the company under which you would have or have participated in the design or development of the accused devices, the Big Mouth Singers item and the Melody Bell-O-Phone items?

A No.

Q So that your first contact -- did you ever see these items prior to joining the company a year and a half ago?

A Yes.

Q Can you tell us where you saw those, on the market place?

A As a consumer.

Q Did you actually purchase one?

A Yes, a Melody Bell-O-Phone.

Q Have you purchased the Big Mouth Singers also?

A No, I have not.

Q Do you know of your own personal knowledge who invented or designed the Big Mouth Singers? The item marketed by the defendant?

A Mechanical or esthetic design?

Q Not esthetic, the mechanical means covered by the patent which produced the carillon sound, the mechanism you have heard us talking about here. Not the heads or the

design.

A I understand. The design was developed by Oriental Manufacturing Company.

Q How do you know that?

A Because in my relationship with the company and how the product was brought to us first in the form that developed into the Melody telephone.

Q Did this happen while you were at the company, or are you talking about what somebody told you?

A When I was developing the Schroeder Piano I had to go into the background of who was manufacturing the Schroeder Piano, who developed the product and so forth.

Q Who was the individual or individuals, the persons responsible for the design of the Big Mouth Singers?

A The persons themselves I don't know. I only know the Oriental trading group that works with several Oriental toy companies.

Q Where are these accused items manufactured?

A They had been manufactured in Japan.

Q Do you know of your own personal knowledge whether these specific designs, the designs -- and I am talking about the mechanism that produced the carillon sound -- of the accused devices, whether they were derived from any other designs or created independently, do you

have any personal knowledge?

A No, I don't.

Q I direct your attention now to the different structures that comprise Plaintiffs' Exhibit 5 in the Melody Bell-O-Phone and 5 A, and we put different exhibit designations on them because in 5 A you will recall there is a bar, a metalic bar where that is not present in Exhibit 5. Exhibit 5 has a plurality of springs.

Do you know who is responsible for the design or placement of this bar on this item, Exhibit 5 A?

A Not to my own personal knowledge.

Q Was this done prior to your joining Child Guidance a year and a half ago?

A Yes, it was.

Q In fact, have you ever seen this item with the springs before?

A Yes, I have.

Q When was the first time you saw this item?

A Shortly after joining the company.

Q Can you tell us whether you saw this item with the springs at the company itself?

A Yes, I did.

Q Can you tell us as the head of research and development or product development why your company changed

its design from the device originally accused of infringing to the design now accused of infringing with the bar?

A No, sir, and I can't even tell you which came out first. I have tried to find the background, the paper work. These units are not dated and at times we hold in the warehouse for more than a year older designs. I do not know why it was done nor the sequence it was done in.

Q Is the current model being manufactured that with the bar on it?

A We are no longer manufacturing, and we haven't been for a year.

Q Is it being manufactured for you?

A No, it is not.

THE COURT: The one with the bar is not being manufactured?

THE WITNESS: Neither is.

Q Can you tell us approximately when -- approximately the month or part of the year you no longer sold these?

A It was about the middle half of last year.

Q Are you still selling Big Mouth Singers?

A No, at this time we are not selling Big Mouth Singers.

Q Can you tell us when you stopped marketing or

selling Big Mouth Singers?

A The beginning of -- the end of 1974.

Q Do you know whether your company's ceasing of its marketing of either the Big Mouth Singers item, which is Plaintiffs' Exhibit 4, or either of the Melody Bell-O-Phones which are Plaintiffs' Exhibits 5 and 5A, had anything at all to do with this litigation?

A I know exactly why they didn't market it, and it wasn't because of the litigation.

Q Can you tell us the reason?

A Yes, the price of the units has become no longer competitive so that as we would have to pass on the increased price under the market place, our toys no longer were marketable.

Q Other than the Big Mouth Singers and the Melody Bell-O-Phone, is there an item that is now being marketed by Child Guidance that produces a carillon sound?

A There is.

Q Is that the Schroeder's Piano?

A Yes.

Q Can you tell us whether the mechanism or the concept of producing the carillon sound within the Schroeder's Piano is substantially the same as that that was used with Big Mouth Singers that you stopped marketing at the

beginning of the year?

A It is.

Q Is it fair to say that these items, the Melody Bell-O-Phone, the Big Mouth Singe: the Schroeder's Piano, represent a line of a concept?

A A line of musical items, yes.

Q A line of items that produce carillon sounds?

A Yes, the three would make up a line.

Q I would like to show you the box that the Big Mouth Singers came in and I call your attention to the fact that it says "Beautiful Carillon-like Music." Do you see that?

A Yes.

Q I show you the box that the Melody Bell-O-Phone came in, and do you see where it says "With Carillon Sound?"

A Yes.

Q How would you describe carillon sound? Is it fair to say that is a continuous ringing or a continuous tone caused by a repetitive striking of a tone bar?

A That is a good description.

Q Have you ever seen any other toy musical instruments, and I am specifically talking about toys, which provided a carillon sound of the type of the Big Mouth Singers, the Melody Bell-O-Phone items and, as you have

seen in this trial, the Bell Organ?

A Yes, I have.

Q Can you give us the names of those items, please?

A One was a unit that Questor no longer produces, which is called the Musical Railroad.

Q Musical Railroad?

A Yes.

Q Was that a toy musical instrument?

A Musical toy. As the train ran on the tracks it struck bars, tone bars.

Q Were there keys involved that were pressed by the user?

A No keys, only the repetitive sound making.

Q I would like to limit my questions, so we can get on, to toy musical instruments that produce a carillon sound other than what you see on the table here, where the sound is produced as a result of a person or child pressing one or more keys. Have you ever seen an item other than those on the table?

A I believe we have something in the prior art similar to that.

Q Have you seen the item or only the paper?

A Only the paper.

Q Could you please point to the prior art item

that you are talking about?

A Yes, one moment please.

It would be tab number 8. Which is an electrically driven piano and a striker bar is operated by a cam.

Q Are there rotating washers in the item number 8 that you are referring to?

A No, there is a rotating cam.

Q I am talking about rotating washers. Is there a pair or more of rotating washers? When I talk about washers I am talking about these washers of the type on the Melody Bell-O-Phone or for that matter the washers on the Big Mouth Singers or the washers on the Bell Organ. Are there washers on this item 8?

A No, there are not.

Q Does that item 8, in your opinion, have all of the elements of the claim that Mr. Russell was referring to?

A No, sir, your question was of a toy that produ produces carillon sound?

Q Yes.

A This does not.

Q It does not?

A All of the elements.

Q When did you first see the patent involved in this lawsuit that is in front of you, Mr. Wuertemburg?

A I believe it was approximately June of last year.

Q About a year and a half ago?

A Roughly.

Q About the time you joined the company?

A Three, four months after I joined the company, as I was starting the development of the Schroeder Piano.

Q Who showed you that patent? How did you come to see the patent, the Musser patent that is involved in this lawsuit?

A At that time the Director of Product Development, Tom Sloan, had asked me to compare the patent to a toy that we were working on that we did not produce because of cost, that had a similar mechanism.

Q Was this prior to your selling the Schroeder's Piano?

A Yes.

Q Did you participate in any way in the development of the Schroeder's Piano?

A Yes, sir.

Q So you had knowledge of the patent at the time your company developed and marketed the Schroeder's Piano which is not being accused in this lawsuit?

A Correct.

Q Have you read the patent that is in front of you, it is on your left?

A Yes, I have read it.

Q Do you think you in a general way -- and I know you are not a patent attorney -- as a technical man, a man with an engineering degree, do you think you understand basically what the patent describes?

A Yes.

Q In fact, in referring to the book with the tabs do you not have your own personal notes to assist you in referring both to the patent and to the patent book?

A Yes, correct.

Q Do you understand that that patent is concerned with toy musical instruments?

A Yes, sir.

Q In fact, you see that the very first four words of claim 1 are "A toy musical instrument"?

A Yes.

Q If you would, would you please turn to the claims of that patent and confirm for the jury that in each and every claim of this patent, the first four words of each patent claim are "A toy musical instrument" in every case of the 12 claims?

A Yes, the four words are "A toy musical instrument."

Q I refer you to the specification, column 1, and the very first sentence that the inventor has used in this patent, could you read that very first sentence?

A "This invention relates to a new and improved toy musical instrument."

Q So we are dealing with a toy, are we not?

A Yes, sir. The patent.

Q Yes, this lawsuit is only about this patent. We are talking about a specific type of toy. We are talking about a toy that produces a specific sound, is that correct?

You hesitate.

A O-ly the type of sound or the method of obtaining the sound, not the sound itself is described.

Q We are talking about a mechanism disclosed by the patent to produce a specific type of sound, is that correct?

Yes, sir.

Q That is the carillon sound, is it not?

A The definition of the carillon sound is carried in here, yes.

Q We are talking about an item that is specifically developed to be mass produced as a toy and available to families and children, is that correct?

A I believe that is in part of this claim, yes.

Q I specifically refer you to column 1 of the specification, line 30 on down it says it must be capable of being easily and conveniently produced on a mass production basis at a cost which is not prohibitive. That would by its nature be dealing with a toy that a parent would buy a child at Christmas time, not an expensive item unless the family is wealthy?

A I can't answer that because the expenses of toys have changed so much.

Q We are dealing with an item, retail value, of ten dollars or so, is that correct?

A Yes.

Q In each case?

A Yes.

Q We are not talking about an item that costs more than one hundred dollars.

A No.

Q In fact, if you look further down column 1, line 59, it says such sound effects have not, it is thought, been satisfactorily achieved in any low cost device of the class described prior to this invention. Do you see that?

A Yes.

Q Those are the words of the patent, are they not?

A Yes.

Q Mr. Wuertemburg, I am going to ask you, without distributing this book with all these patents, with your notes and the book before you and the copy of the patent and the original patent, I am going to ask you to refer to that book that you were reading from yesterday, and I am going to ask you if you can please find for us items that are toys that produce carillon sound that we have been talking about. Would you tell us if there are any in that book? If you want to refresh your recollection, by all means.

A Let me understand what you are looking for. You are looking for a toy that produces a carillon sound?

Q That is correct. Let's limit it to that for now. Whether or not there are different types of mechanisms, how many of those items in there are toys that produce a carillon type of sound?

A Only one.

Q Is that the one we referred to previously?

A Yes, earlier to tab 8.

Q And that tab 8 you already testified did not have all the elements of claim 1, is that correct?

A That is correct.

Q Are there no other toys in this big book of prior art patents that show devices to produce a carillon

sound?

A That is correct.

Q Other than this book, do you of your own personal knowledge know of any devices or publications or items that have been on the market that you personally have seen and inspected that are toys that produce a carillon sound?

A Did you use the word on the market?

Q That is right, sold, where I could as a consumer go and buy it, have you ever seen one?

A Not to my knowledge.

Q You use the word linkage. Could you describe what you mean by linkage so we can have one understanding of the term?

A I define linkage as being a system of rods that allow movement to go from one part of a toy to another.

Q Are there not two or more such distinct elements that cooperate with one another to produce motion along a path, is that fair to say?

A Yes.

Q This is the Big Mouth Singers. I press, in working this item, this key. Is there a linkage of two or more elements required to cause movement of the tone bar?

A No, there is not.

Q In fact, isn't the tone bar supported on a portion of that white key?

A Correct.

Q So there is no linkage in here, is there?

A There is not.

Q This is another accused device. On this portion of what we call the orange piece or beige piece, is there a linkage required between the point that I am pressing with my finger and the tone bar that is carried up into contact with these washers?

A As long as the top is off, no, there is not.

Q As long as the top is off, the top is off now.

A That is what I say. But that is not the play method of the toy.

Q I understand that. If I use this item, is there any linkage between the point of contact of this item and this beige piece and the tone bar that is carried up into contact with the washers?

A No, there is not.

Q Is there a linkage in that Bienengraber patent?

A From where to where, sir?

Q From the same point. I take it in playing this instrument I press the key here, is that correct?

A Correct.

Q This is the key, is it not?

A Yes.

Q Do you know for certain that there is any physical attachment, and when I say know for certain, I am talking about the drawing or a written description or translation, and there is a translation because this is a German patent, do you know for certain from any written description or from the drawings whether there is fixed connection between this key that you just referred to and this item down here?

A I don't know what you mean by fixed connection. You mean a rigidly attached connection?

Q Yes.

A No, I do not.

Q In fact, see this key here, isn't this the tone bar over here?

A Correct.

Q Is the tone bar mounted on or carried by the key?

A It is carried by the key in the linkage system, but it is not carried directly by the key itself.

Q Let's look at the item that you market. This white element is a key?

A Correct.

Q This is the part of the key that I press.

A Yes.

Q This is a portion that carries the tone bar.

A Correct.

Q Can I call this a tone bar carrier?

A Call it a key.

Q Doesn't this portion of the key carry the tone bar?

A Yes, it does.

Q Does this portion of the beige device that is horizontal here carry the tone bar?

A Yes, it does.

Q Does this portion of the key that I played in any way carry the tone bar, forget the linkage between them?

A Forgetting the linkage between them, no, the key does not carry the tone bar.

Q Is the tone bar resiliently attached to the key or is it attached to this other element here?

THE COURT: He already said it isn't resiliently attached to the key.

MR. SUTTON: Okay, your Honor. I don't want to beat a dead horse.

Q There are a number of devices shown in the

patent book. Have you ever physically seen any of these devices work?

A I can't say for certain yes or no. I wasn't looking at them for a recognition. I was only looking at them for a method of mechanical working.

Q To your own present knowledge, can you say with certainty that you have seen any one or more of these items?

A Presently, no.

Q So that the sole basis of the functioning of these items is based on the printed matter here, not from an inspection of the items themselves if they exist?

A The printed matter,yes.

Q When you obtained your one patent do you recall the examiner in the patent office coming up with prior art in much the same manner that this Bienengraber patent is decided as prior art against the Musser patent?

A Yes.

Q In fact, if you look at that patent do you see on the last page thereof a list of all of the patents uncovered by the examiner? That is the names of the inventors, the patent numbers, the date that these patents were granted?

A Yes.

Q Do you see the last patent on the list, Germany?

A Yes.

Q Do you see the number 567657?

A Yes.

Q 567657, isn't this one and the same patent, a drawing of the patent that was cited?

A Yes.

Q Isn't it a fact that the examiner had this drawing and the patent in front of him when he allowed that patent that is now in suit?

A I don't think he did.

Q You don't think he did?

A I don't know whether he had it in front of him. I just know it is here.

Q I am going to refer you to the patent book. There are 20 patents listed there. Would you please look at the table of contents. I would like you to confirm with me now that the following items listed as prior art are in fact listed on the patent themselves, the patent itself. Item number 6, Deegan, the next one is Marks, Lore, Alvarez, Sjolinder, Floury, Zimmerman, Duncan, another Alvarez patent, Bienengraber, the one you have been referring to here, do you see that?

A Yes, sir.

Q Have you ever seen this physical structure that

is disclosed in the drawings?

A Have I seen the prototype?

Q Do you know whether this item, whether a prototype was ever made of the item shown in this drawing?

A Only by hearsay.

MR. RUSSELL: For the record, I think it should be identified as Defendant Exhibit C 3 so the record will designate that.

Q We are talking about the Bienengraber drawing, Defendant Exhibit C 3. Have you ever physically seen the working item that corresponds to the drawing which is Fugure 1 in Defendant Exhibit C 3?

A I have not.

Q Do you know how big it is?

A Only approximation.

Q How big would you say it is in terms of overall height?

A I would say the same height as an upright piano.

Q The width is approximately the same as an upright piano, weighing more than 100 pounds probably?

A Again I would have to guess yes, sir.

Q You have already testified that as regards the linkage itself this is a more complex type of arrangement development than that shown in --and I want to confirm with

you now -- the Bell Organ, the Melody Bell-O-Phone and the Big Mouth Singers, is that correct?

A It is more complex to varying degrees, yes.

Q Does this item cost more than this item?

A I have no idea.

Q When I say this, does the item shown on Defendant Exhibit C 3 cost more than Defendant Exhibit Big Mouth Singers?

A I don't know how much the item in C 3 costs.

Q Do you think it is more than ten dollars if it is more than 100 pounds, and the size of a piano?

A Again, sir, I can't answer that.

Q I will accept that.

There was conversation yesterday, testimony on your part, about dropping in of keys, the keys of the Bell Organ dropping in. Do you recall that?

A Yes, sir.

Q Do you know of your own personal knowledge or from the drawing or from the written description or translation whether the keys here are merely dropped in?

A No, I do not.

Q Your reference was, in one or more of these patents, to a throw of a key, do you recall that?

A Correct.

Q I would like you to show us -- well, how about looking at item 2, do you see that? Is there a key that is thrown from one position to the next on striking an element?

A I don't understand.

Q When you refer to throw, what were you talking about?

A About the movement of the -- the difference of the movement in the key front to back as the key is depressed.

Q Look at item 3. Do you see a key that is resting below a tone bar?

A Yes.

Q Do you see that when this device is actuated, however it is actuated, that key is thrown upwardly into contact with the tone bar and drops of its own weight?

A No, sir, the key simply pivots and the striker arm is thrown.

Q There is a throwing?

A There is a throwing, but that was not the throw I was talking about.

Q Fine. In that item 3 you don't have rotary washers or a rod or the structural arrangement that we have in the patent in suit, is that correct?

A That is correct.

Q You referred to a tone bar carrier yesterday. I have just snapped out one of the keys in the Melody Bell-O-Phone. You call this plastic item a tone bar carrier, is that correct?

A Yes, sir.

Q I am going to cover this upstanding portion of the key of the Melody Bell-O-Phone and as to the horizontal portion that is integral with that horizontal portion, and what you referred to as the tone bar carrier, do those, and when I say those, the white device of the Melody Bell-O-Phone key and what you have referred to as the tone bar carrier which is a more translucent type of plastic, do those serve the same function?

A If I take you literally, no, they don't. You have to move your hand back beyond the pivot.

Q Fair enough.

A If you want to modify that to remove the knob they serve the same purpose.

Q They both carry the tone bar?

A Yes.

Q Does the presence of the portion I pressed change in any way the functioning, the horizontal functions, we referred to?

A You mean remove it? It does not function if you

remove it. It does function if you leave it on.

Q As for the carrying capacity of carrying that tone bar resiliently, does that white element that I depress when I am playing it have anything to do with the carrying capacity?

A The carrying --

Q The carrying of the tone bar, that is really what I am referring to.

A No, it does not change the tone.

Q In the Melody Bell-O-Phone there is a separate distinct button that is used to depress, or that is depressed by the user, is that correct?

A Correct.

Q They are not integral to one another, fixed to one another?

A They are not.

Q These keys in the Melody Bell-O-Phone, or rather the Big Mouth Singers, are integral with one another?

A Correct.

Q In terms of playing the instruments whether they are integral or not by depressing the blue button of the Melody Bell O-Phone, do I get a sound?

A You do.

Q When I press the integral white portion of the

key of the Big Mouth Singers, do I get the same type of sound?

A You do.

Q The reason I asked you that is you didn't refer to it as a key. I assume you are referring to this button portion as a key, the key being the item that the finger of the using comes in to contact with when the instrument is played?

A Yes, sir, the first part of the linkage.

Q In the case of the Big Mouth Singers, the key is integral with it?

A Correct.

Q I would like to show you each of the two devices that we are accusing of infringing the patent in suit. First, I will show you the BA, 5 A model. I ask you when using the key to depress what you call the tone bar carrier a carillon sound is produced?

A Correct.

Q I ask you in the case of the Big Mouth Singers in depressing the key or the button portion of the key, is a carillon sound produced?

A It is.

Q I have to be careful not to press too much, is that correct, otherwise I stop it?

A That is correct.

Q You showed us something before, an item that after yesterday's testimony you worked on by removing portions of the fronts of the slots to show what Mr. Russell attempted to demonstrate this morning, is that correct?

A That is right.

Q I am going to take one of the Big Mouth Singers items which functions, and first I would like to call something to your attention which I find interesting, and I will ask you whether you have any knowledge concerning this. In the case of the Bell Organ, the pitch of these notes, do you hear that sound -- and in the case of the Big Mouth Singers, and I don't know if you can remember the sounds -- do you notice any similarity?

A They are both in the key of C.

Q Same pitch, are they not?

A Again, both in the key of C, yes, sir.

Q In fact, on the Melody Bell-O-Phone --

A Approximately the same key.

Q Same pitch?

A Yes.

Q Is this an item that your company is marketing and representative of the Big Mouth Singers?

A It appears to be.

Q Yesterday you testified contrary to Mr. Ellman's testimony that the front ledge, as he described it here, that limits the movement of the keys, was not intended for that purpose at all, is that correct?

A That is correct.

Q Is that something that you could have any personal knowledge of since you only joined the company a year and a half ago, and this has been on the market longer than that, or is that something that someone told you since joining the company?

A That is something I developed by looking at the product and seeing how it now works.

Q Did you know or do you know of your own personal knowledge whether the presence of that ledge there is for any one purpose or more purposes in the mind of the fellow who devised this?

A Yes, I do.

Q I thought you said you didn't know who devised it?

A I do not. We are talking esthetics now. The esthetics were developed in our company, and the fellow that devised the esthetics is still with us.

Q You talk about esthetics. Please push down the keys all the way and tell us whether you can play them.

You can't play them. So the lid is not purely for esthetics. There are one or more things in this cover that limits the movement of those keys, is that correct?

A That is correct.

Q You testified yesterday that it was the presence of this attachment or device secured to the head that does that, is that correct?

A Yes, sir.

Q I would like to show the jury, and you can confirm for me, that these items that you just referred to snap in place?

A That is correct.

Q I have just snapped this element or yoke out, so that I take it that is to hold the head in there, otherwise the head would fall out if the item is turned upside down, is that correct?

A That is one of the uses, yes, it holds the head.

Q I place the lid back on the item quickly. Do you hear me able to play every single note here? Can you hear the click of the keys against that front ledge in each case?

A I can't.

Q Maybe the jury can.

THE COURT: I am not even going to permit that

question. They can hear the click. Whether it is the click of the front ledge or the click hitting the yoke --

MR. SUTTON: The yoke is no longer in there.

THE COURT: Obviously on the one key. But whether on the other keys the click is caused by the key against the ledge or the key against the yoke is something that no one could tell from a distance of fifteen feet.

MR. RUSSELL: Besides, he has not depressed it hard enough to make it stop --

THE COURT: That is a matter for redirect.

Q If you press these keys hard enough, due to the resiliency of the plastic would they not distort in some way the housing?

A Would they not distort the key or the housing?

Q The item you were shown, they would distort the housing?

A Yes.

Q That is not how they are intended to be played normally. They may be played by some children that way, but that is not how it is designed?

A The toy is designed for normal abuse.

Q Do you see any sticking of the keys as I play your company's item?

A As you are playing it now, no.

Q Were you in court yesterday when Mr. Russell showed Mr. Ellman a sticking with regard to this exhibit?

A No, sir, I came back at that time.

Q If you press on the model hard enough, because it is cardboard here, do you see the item is sticking?

A Yes.

Q Is this the item sold or is it a model? I think the answer is obvious.

Do you see any sticking of the keys in the Bell Organ?

A As you are playing it, no.

Q Did you hear testimony about the ability of Mr. Ellman to remove the rod of the Bell Organ and place it within the Big Mouth Singers item so that the Big Mouth Singers item would be able to perform the notes of the carillon sound?

A I am not sure if I heard the testimony, or if I heard that previously.

Q You have become aware of that?

A Yes.

Q My last question is this: Whether or not you believe the cross examination or portions of the head cause the keys movement to be limited, or whether or not you believe, as Mr. Ellman testified, that the ledges here

cause that limited movement or stopping of the keys, is there a structure in the top of the housing of the Big Mouth Singers that in fact limits the movement of the keys so that you do not get the undesirable result when the housing is not present?

A There is a structure limiting the movement of the keys.

MR. SUTTON: I have no further questions.

THE COURT: We will take our morning break now, ten minutes.

(The jury left the courtroom.)

(Recess.)

(In open court. Jury present.)

REDIRECT EXAMINATION

BY MR. RUSSELL:

Q Mr. Wuertemburg, I would like to show you a model of the Big Mouth exhibit 4, which I believe is the same one that Mr. Gorn removed a single element from. Would you play that and play the second element, and see whether or not it is properly limited?

A No, sir, there is a difference, an obvious difference.

Q Mr. Wuertemburg, with respect to a question which was asked of you, I am not absolutely certain I got

the question correctly, but I believe Mr. Sutton was asking you about the Big Mouth and the manner of producing the noise in the Big Mouth and many of his questions had to do with a commercial toy, but I understand that he had one question which was not so limited, which went, did you know who invented or designed the mechanism for making the tones of the Big Mouth such as the carillon sound of the Big Mouth, and I understand your answer to be no, and I would like to ask you now phrasing the question that I did, do you know the inventor of the mechanism for making such carillon sounds?

A The Bienengraber patent shows the oldest that I have seen.

Q Does that make carillon sound with the rotating washer striking a tone bar?

A Yes, it does.

Q With respect to the possibility of the key sticking on the front edge if it comes down against the front edge, will you comment for the ladies and gentlemen of the jury what is involved in the technology of an element coming against another element and sticking in that manner?

A Since that key does not move directly forward, but moves down at an angle you have to be very careful that that angle is seven degrees or greater.

Q I am showing Exhibit 6 D, the middle one, to show what you meant by the angle, is that correct?

A Where it forms a V with the gray part the plastic will always stick if it is seven degrees or less, and will not stick if it is greater than that. That is because of the friction of the materials.

MR. SUTTON: Your Honoe, I would like to object to the question that in any way implies that this model that I have already stipulated is not to scale, and is not the same material of the devices, should be used as evidence of sticking that I already demonstrated does not happen. Why are we dealing with sticking on a working model --

THE COURT: Unless sticking happens in the accused devices I don't think the question is really relevant.

Q Is there a risk that sticking might happen unless you provided means for limiting motion elsewhere in the device?

A Yes, sir.

Q What are the tones that come off of the Big Mouth and Melody Bell O-Phone as well as the Bell Organ? What tones are we talking about on the piano?

A We are talking about a key of C, the eight notes in the key of C.

Q Would that be on Bienengraber, the notes you see there?

A Yes, some part of the Bienengraber keyboard.

Q You could expect the tone bars back of those keys to be reasonably close in their vibrating characteristic to the accused devices?

A Yes, sir.

Q So that am I correct that the difference really is that on Bienengraber you have a scale much higher, numerous scales higher and lower?

A That is the difference in the keyboard, yes, sir.

Q Mr. Wuertemburg, I understand from talking to you that you were not here in court at the start of Mr. Ellman's testimony. But on the assumption, Mr. Wuertemburg, looking now at the lowermost illustration on Exhibit D, we have an item marked in red which would be the tone bar, and it is my understanding Mr. Ellman regarded the item marked in blue as the key. He stated that the item on the right extending upwardly from the little spring, although connected integrally on the exhibit, was intended to be just pressing and not connected. Mr. Ellman called the first item that runs horizontally the key, and the little element standing upwardly as the button. Eventually he amended his testimony to include that the button and the

blue horizontal element were all to be regarded not integrally but together as the key. Accepting Mr. Ellman's statement that the horizontal portion is a part of the key, would you now return to claim one, which is Exhibit C 2, and state for the Court whether or not the element which you previously said was not in Bienengraber, tone bar resiliently attached to each of said keys, would be in Bienengraber if we were to adopt Mr. Ellman's statement that the horizontal portion which carries the tone bar is the key?

A Yes, taking that same line of thought that the Bienengraber mechanism would then carry that part of the claim.

Q I would like to call your attention to page 29 of the file wrapper, the middle of the page, and if it would be convenient I could hand counsel a copy of the page.

MR. SUTTON: I have it, thank you.

MR. RUSSELL: I would like to hand several copies to the jury, your Honor, of that page. The German patent cited by the examiner is unquestionably pertinent to the entire concept of the invention employed. However, this reference does not really anticipate the claims in this case, because of the fact that the keys employed to operate this reference structure do not carry the tone bars

employed.

MR. SUTTON: May I ask that the entire paragraph be read so that that sentence is not taken out of context. The following sentence or two is directly on point also.

MR. RUSSELL: In effect, a rather involved system of linkages, etcetera, is required to move the tone bars in this reference against the small rings in the center of it used to actuate these tone bars. Such a linkage is obviously complicated. Further, it necessitates a comparatively large structure of an involved category. Structure of the reference is not considered to be a simple structure that can easily be turned out in a mass production in a modern toy factory.

THE COURT: Yes, ma'am?

JUROR 2: May I ask where this is from?

THE COURT: That is a very good question.

MR. RUSSELL: When you apply for a patent you correspond with the Patent Office and the Examiner is apt to say that he does not accept your claims, writes you a letter and rejects them, and then you write back, or your attorney writes back to the Examiner telling him why he is wrong. In this case certain claims were rejected and the Examiner or the attorney filed this paper which you are reading, only a page of it. The exhibit is here and there

is no intention of hiding the entire paper. It is just a matter of the entire detail.

THE COURT: What page of the file history?

MR. RUSSELL: 29.

MR. SUTTON: Your Honor, I don't think my opposing counsel has gone quite far enough. I think we should specifically state that the German patent that was just referred to and read to the jury refers to the Exhibit C 3 that is up on the blackgoard, or that is a drawing of that patent, so that the Examiner had this patent in front of him when he allowed this.

MR. RUSSELL: The point is that the attorney was arguing that the principal distinction was that the tone bar was not mounted directly on the key.

Q Mr. Wuertemburg, if you would take Mr. Ellman's statement that the tone bar element in blue and the tab which is not connected to it can be together regarded as the key, would the statement which Mr. Musser's attorney made be accurate?

A Yes, sir.

Q The statement I meant was this reference does not really anticipate the claims because of the fact that the keys employed to operate this structure do not carry the tone bars.

A If the tone bar -- if the key is defined as the part that carries the tone bar, as you just explained --

Q Together with the button element.

A Correct. Then the statement is not accurate.

Q If you wanted to assemble the Bienengraber device and you had the upper cover off, you were asked about whether or not the keys could be dropped into place. You were not asked whether you could do it with the cover off. I am now asking you if when you take the cover off can you drop the keys in place?

A No, sir, not according to the drawing.

Q How would you put them on?

A The cover would have to be removed and they would have to be dropped over the receiving pins.

Q You didn't understand my question. I am saying with the cover off, could you drop the keys into place?

A Yes, the cover would have to be off or the front part of the piano would have to be off.

Q With respect to the fact that Bienengraber patent includes the drawing and the specification claims just like the normal patent, except it is German, I would like to ask you as a man skilled in the art whether or not you can determine the Bienengraber structure with or without looking at the written part of his patent?

A Yes, this drawing is clear enough that I would not have to read a description of the patent.

Q Is that so about a man of ordinary skill in the art of reading drawings and understanding mechanical structures?

A Yes, it is nothing unusual.

MR. RUSSELL: No further questions.

RECROSS EXAMINATION

BY MR. SUTTON:

Q Relevant to the question you just answered, without regarding the written description at all, can you tell me from this drawing how you come to know that the key of C is involved in this instrument?

A Yes, sir, in that my knowledge of -- my layman's knowledge of music --

Q I don't mean to interrupt you. I am talking about information derived from this drawing. Is there anything in the drawing which in any way indicates that the Bienengraber device was in any specific key?

A No. What I had said was the key of C is included in this device. You cannot exclude the key of C and still be able to play music.

Q If you have at least one octave you are going to have at least one C in that octave, is that correct?

A That is correct.

Q However, even though you have one key of C in that octave, if you play five consecutive notes on those keys will they necessarily be in the same major or minor key?

A Now you are going beyond my scope of music.

Q Then I won't pursue that.

You were shown this device. You demonstrated for the jury that if you pressed down on one of the items without a head that you would get some sort of a difference in sound. I still heard a sound, but my question is could you please duplicate that for us now?

A This sound versus this sound.

Q If you press these keys hard enough will you get that same difference?

A I do not believe so. It really depends on toy to toy.

Q If I put this item which is another example, press the purple which is the seventh one, or the yellow, you get a very different sound as you press the difference in weight because you are distorting the mechanism, is that correct?

A A difference in sound?

Q Yes.

MR. RUSSELL: The cover is not secure.

Q The point is if you press hard enough, because these are plastic parts you will distort the piece?

A Not in all cases. If the fork is properly assembled the distortion is from the pivot point forward, not the pivot point back to where the tone bar is carried.

Q That is correct.

My last question concerns this: You were referred to a page 29. Did you have that before you?

A Yes.

Q Then you were referred to testimony of Mr. Ellman which you were not present at here. I would like to take this portion of the model that Mr. Russell referred to, 6 D, and what he said was that Mr. Ellman considered the combination of this button which is in the button that goes in the Melody Bell-O-Phone, and this horizontal portion as equivalent to, or a key, much the same way as the integral structure which I questioned you about on the Big Mouth Singers.

Is the tone bar in the Melody Bell O-Phone carried by that horizontal portion?

A It is.

Q It is.

Now you were referred then to the Bienengraber. I show you the portion here which you previously said was

a key, even assuming this rigid connection that you said could exist but you weren't able to know for sure, do you see the tone bar that is located up here on another member located on this horizontal member? It is not located on the horizontal member, is it?

A No, sir.

MR. SUTTON: That is all my questioning.

THE COURT: All right.

Thank you.

(Witness excused.)

THE COURT: Call your next witness, Mr. Russell.

MR. RUSSELL: If your Honor please, we have the stipulation of facts. Would it be appropriate for me to read into the record the stipulation of facts?

THE COURT: Yes, you may do so if you wish.

MR. RUSSELL: I would rather just read certain portions of it to save time.

THE COURT: All right.

MR. RUSSELL: Stipulation number 9 --

THE COURT: I thought we had withdrawn that one in view of the fact that you decided to put in specific evidence of the prior art.

MR. RUSSELL: Counsel and I have agreed to the second sentence of stipulation 9.

MR. SUTTON: Not if there is --

MR. RUSSELL: You signed it.

MR. SUTTON: I have no objection.

THE COURT: The second sentence may be read.

MR. RUSSELL: Stipulated between parties the subject matter is simple and the terms used in the patents, including the patent in suit, are readily understandable to the layman. Plaintiff has alleged that defendants' Big Mouth Singers, Melody Bell O-Phone infringe U. S. patent number 2873639. Number 11, none of the two independent claims, one and seven, of the patent is literally readable on any of the two accused devices.

THE COURT: There are three in the sense that we have two models of the Melody Bell O-Phone.

MR. RUSSELL: Leave it as three, right you are.

Your Honor, with respect to putting into the record certain portions of the depositions, would it be appropriate for me to read the portions I wish to put in the record?

THE COURT: You may do so if you wish.

If the portions are going to be extensive, it might be best to have someone on the witness stand play the part of the witness and read the answers. If they are not going to be extensive you needn't bother.

MR. RUSSELL: They are not very extensive, your Honor.

THE COURT: Make clear who is speaking. Read question and answer each time so the jury won't get confused.

MR. RUSSELL: This is the deposition of one of the plaintiffs, Mr. George Lerner, who is the other geneleman who has developed the Jolly Jingle Tone and is a plaintiff in this case.

THE COURT: I might explain to the jury that a deposition is out of court testimony taken before a court reporter who records the questions and the answers in much the same way as the court reporter here is taking down the questions and answers. The witness is sworn just as the witness in court is sworn, and the testimony taken by way of deposition has exactly the same force and effect as testimony taken in court.

MR. RUSSELL: If I might say it, Mr. Lerner is seated here in the court at the table.

THE COURT: I am sorry you said that. Is this his deposition?

MR. RUSSELL: Yes, your Honor.

THE COURT: Is there any objection?

MR. SUTTON: I do object.

MR. RUSSELL: Am I not permitted to use the deposition of a party for any purpose?

THE COURT: A deposition of a party taken by the opposing party -- this is Mr. Lerner, taken by you?

MR. RUSSELL: Yes.

THE COURT: You may do so, if it is a deposition of an opposing party.

MR. RUSSELL: I asked Mr. Lerner,

"Question: Who had the idea for a musical toy?

"Answer: Mr. Ellman.

"Question: Mr. Ellman?

"Answer: Primarily, yes.

"Question: And what was his idea, can you state it?

"Answer: Well, we had never been in the musical field. We decided to come up with a musical toy and it was evolved between the two of us.

"Question: Had you ever seen any musical toys before, taken them apart?

"Answer: No."

Page 19, line 4.

"Question: Did you ever see musical instruments that have rotating tone bars?

"Answer: No, I have seen musical instruments,

but I don't know how they operate such as pianos, organs and so on and so forth.

"Question: Continuous ringing bells?

"Answer: I never knew how they operated, I never concerned myself with it."

With respect to Mr. Ellman's deposition at page 66 -- we have page 65 in the record already, pardon me. I previously quoted from the record where Mr. Ellman had stated,

"Answer: I am not mechanically equipped to define anything here.

"Question: Are you equipped to state whether features of a toy are important in the toy industry?

"Answer: I am equipped to say whether a toy is a finished -- as a finished item is unique or not unique.

"Question: What does uniqueness have to do -- is it not the important question of whether it is going to sell?

"Answer: No, I leave definitions to my attorneys.

"Question: No, but what you are trying to do for a customer, a company like Ideal, is tell them what is a procedure for sales for the selling of a toy?

"Answer: That is the unique feature, right,

of the play value or whether I feel that outwardly it is different from something else.

"Question: Well, if something is different is that always good?

"Answer: From my end of it as an inventor, I can only bring something different, otherwise they won't buy it from me."

I asked the witness a further question with respect to the ledge at page 70, line 2.

"Question: And that it is important that that little ledge stands out to resemble a piano from the point of view of design?

"Answer: I cannot go along with whether it is important or not important, because there are a number of ways something could be designed. I think it is the tone that is produced is important here."

Page 72.

"Question: Can you tell me, Mr. Ellman, whether it is important from the point of view of design or mechanics to have an elongated slot in the front of the housing?

"Answer: Counsellor, I do not know what you mean by an elongated slot. I am not familiar with reading engineering drawings and I really cannot read these figures

at all."

MR. SUTTON: Would Mr. Russell please continue after my objection concerning that elongated slot at line 23, and on to the next page, still on page 72. Line 23. You are asking Mr. Ellman about the elongated slot.

MR. RUSSELL: You want me to leave out your objection?

MR. SUTTON: Yes, please, just the next question and answer.

MR. RUSSELL: "Question: Are you aware looking at Exhibit C 4 that the keys are entering the housing through an elongated slot?

"Answer: Counsellor, you will have to tell me what you mean by an elongated slot."

MR. SUTTON: Thank you.

MR. RUSSELL: Page 76, I asked the witness the following question.

"Question: And noe that I call your attention to Exhibit C 6 and to the items which are designated as the upward projection underneath the key and then the hollow of the key, having seen that now, do you have an opinion as to whether it is important?

"Answer: No, I have no opinion."

One sentence in the Musser deposition, page 116,

and in this instance Mr. Bahr was questioning Dr. Musser, and he asked Dr. Musser,

"Question: Is the item disclosed within Exhibit H a toy?", and Exhibit H for the jury is the Bienengraber patent.

"Answer: Oh, no, indeed no, no, no. It is a massive big thing, it weighs a couple of hundred pounds. I saw one in Neuremburg."

In the file wrapper I wanted to read from page 42 a further statement similar to the one that I already showed the jury in the middle of the page referring to claims 20 and 23, which incidentally are not before you, but will be subsequently.

JUROR 3: Whose statement?

MR. RUSSELL: This now is the attorney for Mr. Musser who is the patentee.

"The new claims 20 and 23 added above are considered to be generic to all aspects of the present invention."

THE COURT: What page are you reading from?

MR. RUSSELL: 42, your Honor.

THE COURT: Go ahead.

MR. RUSSELL: "They are not considered to be anticipated by the German patent of record for several

reasons. In the German patent the key structures employed are completely separate and apart from the sound generating elements utilized. The keys in these sound generating e elements are connected by a series of linkages, etcetera. This is a comparatively complex structure, as opposed to the very simple type of key structure carrying sound generating elements as defined in claims 20 and 23."

The other portion of the file wrapper that I wanted to read to the jury, your Honor, is at page 80, the last 9 lines, where again the attorney for Mr. Musser, the patentee, is stating to the patent examiner his argument to convince him to allow certain claims.

"It can hardly be questioned that the fact situation here is at least analogous to the fact situation in this application." and he has just quoted a case he was talking about. "The number of references of record here clearly show that the art of musical toy instruments is not exactly a pioneer field. In holding that the examiner should allow patent protection on even comparatively minor improvements in a crowded art, the Court of Customs in patent fields stated as follows:" And then it quotes from a case.

MR. SUTTON: I would like the Court to have that quote from the case.

THE COURT: You may read it, please.

MR. RUSSELL: "The building art is one of the oldest known to man. It can aptly be described as crowded. It will be observed from the limitation of the claims that applicant seeks a patent on only a narrow improvement. Progress is as important, however, in crowded arts as well as in those in pioneer stage, and such progress is usually made in small increments."

I call Dr. Kern, your Honor.

F R E D R O B E R T K E R N , called as a witness by the defendants, being first duly sworn, testified as follows:

JUROR 3: Your Honor, while he is doing that, could you tell us what a file wrapper is please?

THE COURT: Yes, good question. A file wrapper is simply the file history of the application, in this case the application for the patent in suit. The word "wrapper" is misleading. It originates from the fact that these papers are in a folder in the patent office called the file wrapper. So when we speak about the file wrapper of a patent application, we are talking actually about the papers on file in the patent office in connection with that application. They include the original application, all of the official actions from the patent office, either

rejecting or allowing the claims and explaining why, and all of the amendments and arguments that were made by the applicant's attorney in order to get the application allowed. In each case the papers that have been read from the file wrapper were remarks made by the applicant's attorney to the patent office in order to persuade them to allow the claims of the patent, and to issue the patent containing those claims.

DIRECT EXAMINATION

BY MR. RUSSELL:

Q First, I would like you to state your occupation and introduce yourself to the jury in terms of your occupation and your education.

A I am presently consultant with the firm of Ball, Branick & Newman, in Cambridge, Massachusetts. Before going to work for that company I attended the Massachusetts Institute of Technology and studied mechanical engineering, and received the degrees of Batchelors, Masters and Doctor of Science in Philosophy. During the time I was at MIT I studied courses such as kinetics and statics and dynamics of structures, design and manufacture of mechanical structures and machines, and studied materials such as plastics and metals to understand how they interact with each other. After graduating from school I worked for the

firm of General Oceanology which is a subsidiary of Ball, Branick & Newman, for a while, and there designed instrumentation and systems for packaging the instrumentations at Ball, Branick & Newman, which I joined about seven months later as the General Oceanology firm was winding down its operations. I have been a consultant in mechanical design. I have designed products for use by children. I have done structural analysis of various types of structures, studied vibration and one of the areas that Ball, Branick & Newman is famous throughout the world is the field of acoustics, and I get involved in the generation of sound and the propagation of sound, and I have also been retained on several occasions as a consultant to patent attorneys to read for them what is in a patent and describe to them in a way that they can understand what is contained in the patent, and how the parts described in the patent interrelate with one another.

MR. RUSSELL: Your Honor, in an effort to keep away from repetition, we have covered with Mr. Wuertemburg the identity in the prior art of each separate element, and he came to the other end of the scale, and identified all of the elements in one reference. I wanted to cover with this witness subcombinations, your Honor.

Just two.

MR. SUTTON: May we approach the bench? The reason being I would like to raise the question about the scope of this first trial.

THE COURT: I wonder whether or not we are not getting beyond the field of equivalence when you get into the matter of subcombinations.

MR. RUSSELL: Well, your Honor, it seems that the jury should know how crowded the field is in order to determine what scope of equivalence is involved, and it seems to me you might say all the alements are separate in the prior art, but there is still the possibility of inventive subcombinations.

THE COURT: He is only going to talk about two of them. I will permit it.

Q. Directing your attention to the subject of subcombinations, Doctor, and I will hand a few of these books back to the jury, in case they wish to follow it, speaking of a subcombination of certain elements of the claim in which the key is supported by a fulcrum and a slot is acting in concert with the fulcrum, in concert with the support of the key to retain and secure the key in place, this concerted element of subcombination involving the housing with the slot and the fulcrum and the fitting into the key, the projection fitting in the key, and serving as

a fulcrum, and the slot serving to hold the key in place?

A There are several patents cited in the prior art that have a key support that includes projections of some sort to retain the keys and a slot, the upper part of which holds the keys down in place. I would like to refer first to patent in tab number 2. Here, looking at figure 1, there is a key labeled F, and above the key there is a stop in the slanted shaded area which forms the top of a slot through which the key is passing to go from the front of the structure where it can be acted upon with fingers into the back of the structure, where eventually it actuates a tone producing mechanism. Underneath the key unlabeled there is a vertical support, and that vertical support acts as the fulcrum, and again if we did not have the upper shaded portion the key would not be held firmly in position, so that it could only undergo the types of motions that are required of it in order to have the instrument operative. This is very similar to the type of mounting that is included in the patent in suit for retaining keys.

A similar type of structure is shown in tab 3, where the upper part of the slot is shown as a metal strip 5, and below it a fulcrum 3. However, here the keys are restricted from sideways motion by some small projections which can be seen moderately clearly in figure 2, labeled 6,

and these projections keep the keys from contacting each other, but they act in cooperation with the slot and a fulcrum in a manner analogous to that shown in the patent in suit.

Referring to tab number 7 in figure 2, there is a combination of a fulcrum structure 8 cooperating with the top structure indicated as 9, which helps to locate the key, again like the patent in suit, similar to it.

Tab 9, figure 2, which is on the second page, again shows the fulcrum projection coming up and the top of the slot coming down to hold the key in position, to prevent the key from being able to come out from where it is located.

In figure 10 there is again similar cooperation shown in figure 3, although the drawing is not -- the drawing that I have a copy of is not terribly clear.

THE COURT: I question, Mr. Russell, whether we haven't reached the point of diminishing return after we have gone through four or five of these, I think that suffices.

MR. RUSSELL: There is no need to add to it, your Honor. The point is well made.

Thank you.

I would like to hand up to the Court and to the

jury a good copy of the patent in suit, your Honor. We had the thing brought out from the public library where it is printed, and eventially got a good copy at last.

Q Dr. Kern, I would like to call your attention to column 2, line 15, which says if desired, however, as an aid to understanding the invention it may be briefly stated in summary form that this invention relates to toy musical instruments each of which includes a support member, a pluruality of arms movably mounted on the support member, a sound generating element mounted on these arms so as to be moved when each of the arms is moved, and means for actuating each of these sound generating elements so as to produce sound.

So far what is he describing there, what I just read?

A He is describing a device that will produce sound when keys are depressed.

Q Would that be --

A A different sound when each key is depressed.

Q Would that be the device I am pointing to in the Bienengraber, a rotating rod with arms sticking out of it and elements out at the end of the arms that would generate sound?

A That would be one way of doing it.

Q These means being mounted on the support --

THE COURT: On the support member.

Q On the support member adjacent to the arms, so that when said arms are moved the sound generating elements are moved into a location where they are actuated by these means, causing sound to be produced.

Has that been completed, the element including tone bars and striker elements?

A Yes, in this case when a key is pressed the specific tone bar will come into contact with a device that will repeatedly strike the tone bar.

Q Are you aware of a previous patent that actually claimed that structure?

A Yes, the claim in tab 19, the translation of which I believe --

Q Would you read that,please.

MR. SUTTON: If I may, your Honor, only for purposes of limiting the scope of this trial, what comes within the scope of a claim of a prior art patent as relates to the issue of equivalency in this trial is beyond me.

THE COURT: I am going to sustain the objection. We are concerned with the disclosure of Bienengraber, not the claims.

MR. SUTTON: We are not even talking about

Bienengraber, are we?

MR. RUSSELL: Yes, we are.

THE COURT: Do you want to withdraw your objection?

MR. SUTTON: I will.

THE COURT: The objection is withdrawn, you may proceed.

MR. SUTTON: I am sorry, your Honor, I would like to keep the objection.

THE COURT: All right. The objection is sustained.

Q Dr. Kern, I am going to show you claim 20 as it appeared in defendants memorandum re additional evidence to file wraper, which is in file with the Court and counsels.

The claim as presented here includes the amendments. The reason I am not calling your attention to the file wrapper is that those amendments are very difficult to read on the file wrapper itself.

THE COURT: Have you got a copy of that for me?

MR. RUSSELL: Do I, sir?

That is what I have been looking for. I had two. I seem to have mislaid my spare copy of it.

THE COURT: All right. Proceed.

Q Do you have one?

A I have the original.

MR. RUSSELL: Would it be all right if the witness stepped down and got that, your Honor?

THE COURT: Surely.

MR. RUSSELL: We haven't been able to locate that, your Honor.

THE COURT: All right. Proceed.

Q This is claim 20 from page 35 of the file wrapper following onto page 36.

Have you made a study of this claim, Dr. Kern?

A Yes, sir.

Q Have you formed an opinion, Doctor, as to its comparison with the actual allowed claims which appear as claims one and seven?

MR. SUTTON: I object. Firstly, this witness is not qualified or is not a patent attorney, and is not qualified as a patent expert. I stipulated we would not have patent experts in this trial, especially in this limited trial of infringement and, secondly, even if he were a patent attorney able to construe how those claims should read, the scope of this trial was supposed to be confined to the issues of the doctrine of equivalence as stipulated.

THE COURT: I am sure Mr. Russell is trying to get at file wrapper estoppel, but I had already indicated at our pretrial conferences that I would not permit patent experts to testify. The file wrapper is in evidence. To the extent that it creates a file wrapper estoppel it does so, and nothing this witness can say can add or detract from that defect.

I am going to sustain the objection. I will permit you to offer in evidence a copy of claim 20 containing the amendments. That poses the difficulty of reading the file wrapper in its present form in which claim 20 does not contain the amendments,which were made later.

MR. RUSSELL: As I understand,the file wrapper contains the written amendments written --

THE COURT: You can put in the clean copy of claim 20 containing the amendments.

MR. RUSSELL: Thank you, your Honor.

MR. SUTTON: No objection.

(Defendant Exhibit E received in evidence.)

MR. RUSSELL: No further questions, your Honor.

THE COURT: Any cross?

MR. SUTTON: Very brief cross, your Honor.

CROSS EXAMINATION

BY MR. SUTTON:

Q Mr. Kern, the first question is the circumstances in which you appear today. Are you on the payroll or employed by either of the defendants in addition to your activities that you have already described?

A I am working as a consultant for the law firm representing the defendants.

Q Without going into the specifics, are you receiving any sort of funds or monies in return for appearing here today?

A Only that of the normal salary I obtain from my company. Actually my services are higher via the company I work for, and I obtain the same salary over a yearly basis independent of what particular projects I work on, because indirectly I obviously get paid because I consult for various organizations.

Q To simplify things, directly or indirectly, monies are finding their way to you from either the defendants or their counsel for appearing here today?

A Yes.

Q You referred to the book of patents that has previously been referred to in this litigation, and you found certain subcombinations, as has been described.

My question is: Have you read the patent in suit prior to appearing here today?

A Yes.

Q There is the certified copy in front of you on the left, with the ribbon and seal. I refer you to column 4, line 42, and I read that one sentence there, "Those skilled in the art to which this invention pertains will realize that a large number of modifications may be made in the structure shown without departing from the essential nature of this invention," do you see that?

A Yes.

Q Do you understand from your understanding what the nature of this invention is from a reading of the patent without going into the claims? Do you understand what the patent structure consists of?

A I believe I do, yes.

Q You referred to Bienengraber. Do you understand that Bienengraber is cited in this patent in litigation?

A Yes, I do.

Q Do you understand that the examiner and the attorney of record for Dr. Musser, a Mr. O'Brien, I believe, corresponded back and forth in obtaining this patent, and referred to the Bienengraber, first the examiner cited it and then the patent attorney argued in order to obtain the

patent, do you understand that?

A Yes.

Q Do any one of the patents in this book, including Bienengraber, and all of those that I previously referred to, and I don't know if you were in the courtroom, I underlined several that have been cited already, do any of them disclose a toy musical instrument which produces a carillon sound in the same way as disclosed in the patent? I specifically refer to a toy musical instrument, the first four words of the claim before you. Do any of these patents do that?

A No, I do not see the word "toy" preceding the word "musical instrument."

Q Let's cover your answer in two parts then. Do any of them cover or disclose a toy musical instrument that does what I just said?

A No.

Q Is that your answer?

A That is the answer to the question.

Q Do you understand that the scope of a patent is defined by its claims?

A Yes.

MR. SUTTON: I have no further questions of this witness.

REDIRECT EXAMINATION

BY MR. RUSSELL:

Q Dr. Kern, Mr. Sutton has pointed out that the inventor stated at the end of his patent that a large number of modifications may be made in the structure shown without departing from the essential nature of this invention.

Would changing Bienengraber, or would changing the toy of the Musser patent to a larger instrument the size of Bienengraber be a change which would depart from the essential nature of the structure?

A It would not be in terms of the concept by which sound is produced by depressing a key.

Q Would changing the Bienengraber structure, rearranging it so that the key could directly support the tone bar be, in your opinion, such a change that would depart from the essential nature of the invention?

A After reading through the file wrapper and studying the Bienengraber patent itself, I would say that there would be no significant difference in whether or not you mounted the tone bar on the key or whether you mounted it, like Bienengraber did, so you could basically have a large number of keys fairly close to each other and a very large number of tone producing elements set behind them in a way that he has done it.

MR. RUSSELL: No further questions, your Honor.

THE COURT: Thank you, Doctor.

(Witness excused.)

THE COURT: We will take our noon break now, and come back at two o'clock at which time counsel will make their summations. I assume you have no rebuttal?

MR. SUTTON: I only would like to read into the record a portion of the Musser deposition that was referred to by Mr. Russell, and I can do that very briefly after the recess.

THE COURT: All right.

JUROR ONE: May we leave this on the seat so when we return we have it in case we need it?

THE COURT: You may if you wish. I don't know whether counsel will be referring to it again.

MR. RUSSELL: I may in the closing remarks, your Honor.

THE COURT: You may leave them on the seats.

JUROR THREE: Do you have an estimate of the length? I think several of us would like to have an estimate of the length of this trial if that is possible.

THE COURT: I wish I could give you a reliable estimate. I think anything that I can say might be used against me later on. On this first part of the trial

counsel will sum up and I will give my charge this afternoon so you will get that part of the case this afternoon, and I can't tell you how long it will take you to reach your verdict. You might reach it this afternoon or tomorrow morning. I won't keep you late tonight, I will tell you that. You won't need to worry about staying. If you haven't reached a verdict tonight by a quarter of seven, I will permit you to go home at a quarter of seven, so you can get home at a reasonable hour.

JUROR THREE: Is it likely the second part of the trial would go through Christmas?

THE COURT: I am hopeful we will finish this week. I can't give you any assurance, because that is controlled by the attorneys who are only indirectly controlled by me.

JUROR TWO: I was not clear about one point being made about some of these toys, and I wonder if they will be available for us to look at in the way they are now?

THE COURT: You will be able to have any of the exhibits that you want in the jury room, and I am going to urge that counsel stipulate that at the beginning of your deliberations you will have the three accused devices plus also the patented device, plus a copy of the wording of each of those five elements whose equivalency is in dispute,

and perhaps a copy of the entire patent in suit.

JUROR TWO: And also the machines that they done things to?

THE COURT: Yes.

JUROR THREE: One other clarification, counsel for the defense referred to claim 20.

THE COURT: Claim 20 is a claim that was added to the patent application by way of amendment during the prosecution, and which was later cancelled before the patent issued.

We will see you at two o'clock or shortly thereafter.

(The jury left the courtroom.)

THE COURT: As I indicated to you earlier, I am going to tell you very briefly what I am going to do with respect to your proposed charges. The plaintiffs' proposed charges were substantially duplicated in the defendants' charges, so I am going to base my charge in part upon the defendants' charges, suplementing them as appears appropriate. I am going to change the working of the charges, but give substantially the substance of proposed charges one, two, and three. I will not give proposed charge four.

MR. SUTTON: Are you referring to the plaintiffs

or the defendants?

THE COURT: To the defendants.

As I indicated, I will give the substance of proposed charges one, two and three with minor modifications in the language. I will not give the substance of proposed charge four. I think it is unnecessary and confusing. I will give the substance of proposed charges five, six, seven, eight and nine with this exception, or I should say with these exceptions: In proposed charge five, I have stricken the portions relating to estoppel based on amendments, because I do not believe there is a file wrapper estoppel here, as I have already indicated in my memorandum denying the motion for summary judgment. I am aware of your argument with respect to claim 20. I do not think it creates a file wrapper estoppel. Although it does contain a couple of the elements that are missing from claim nine, claim nine contains certain elements that are missing from clain 20. So I don't think either one creates a file wrapper estoppel and, as you may or may not know, the law in the Second Circuit is that a file wrapper estoppel is not created by arguments that are made during prosecution but only by amendments to the claims. I have therefore re-worded proposed charge five so that it does not refer to estoppel, but only to arguments which are made to the

Patent Office with respect to the importance of certain features of the invention, and I have instructed the jury that they may take these arguments into consideration in determining the interpretation to be given to those elements in the claims.

I am giving the substance of proposed charge six, including submitting for special verdict the question whether or not the defendants in the construction of their accused toy musical instruments are employing only the prior art plus variations which would have been obvious at the time of the patented invention to persons having ordinary skill in the art.

I am giving the substance of the first sentences of proposed charges seven and eight. I am not giving the remainder of those charges, which refer to special verdicts because I am not asking for special verdicts on those matters. I am merely instructing them that these are matters that they should consider in determining the proper range of equivalence, but I am not asking for special verdicts on those matters.

I am giving the substance of proposed charge nine. I am also giving the substance of proposed charge ten, and I have prepared here a form for the special verdict which includes two questions. The first one was

the question I referred to a minute ago which concerns whether the defendants in their accused devices have used the prior art plus obvious variations, and in the second question I have asked them to indicate whether in the accused toy musical instruments the defendants have incorporated means which perform the same function in substantially the same way to accomplish substantially the same result as the elements of the patent claims which are listed, and I have listed the five claims in dispute, and I have provided blanks in tabular form for the jury to indicate yes or no whether each of the three accused structures incorporate the equivalence of those elements, and I will give you copies of those forms, so that you may consider them over the noon hour and make exceptions or suggestions as you see fit.

With respect to the handwritten supplemental request that I received yesterday afternoon from the plaintiffs' counsel, I will give the charge to the jury that in determining the matter of equivalence, the jury should disregard the exterior shapes, colors and non-functional design features of the accused structures. I will not give the proposed charges relating to disregarding the Jolly Jingle Tone item, because I think it has some possible relevance in connection with determining variations

which would have been obvious to persons having ordinary skill in the art, which is the subject of the first one of the special verdict questions.

I think that is probably sufficient indication to you of the nature of the charges that I will or will not give.

MR. SUTTON: Your Honor, one quick question, on charge number ten that the defendants have proposed, are you going to eliminate the special verdicts within that?

THE COURT: The only special verdicts that I will refer to are the ones on the special verdict form. They will be the only special verdicts that I am asking them to give.

MR. SUTTON: Thank you.

(Luncheon recess.)

AFTERNOON SESSION

2:00 p.m.

(In open court. Jury present.)

THE COURT: Mr. Sutton.

MR. SUTTON: Your Honor, before making our closing statement, plaintiffs would like to read from both Mr. Crain's testimony, the deposition testimony, and from Mr. or Dr. Musser's testimony.

On November 20, 1973 at 10:00 a.m. the plaintiffs through their counsel, myself, took the deposition or testimony of Mr. William Crain under oath at my offices. I am reading at page 50, line 12, and in questioning the President of the defendants Child Guidance Corporation about the source of these items, the Big Mouth Singers, the accused devices and the Melody Bell O-Phone, and the issue of infringement, I asked at line 12, page 50:

"Question: Such as in the case of this Big Mouth Singers and the Melody Bell-O-Phone?

"Answer: Correct. Or they can come from outside inventors here in the United States.

"Question: Where the invention comes from outside of your company how do you know when you are marketing a new item that the rights of other parties are not being infringed?

"Answer: Well, it depends again on the circumstances. In general we are dealing with a United States inventor, a contract is signed in which that individual warrants that he does have rights to this item and holds us harmless if he does not. In the case of Japanese companies, since our agreement with them is to buy finished good products we have just purchased the product.

"Question: I think you recognize that a finished good product, as you have characterized it, could in some instances infringe the rights of third parties. You could conceive of such a situation, couldn't you?

"Answer: Perhaps.

"Question: How do you protect your company against the eventuality or the possibility that such an infringement would occur?

"Answer: We have not taken precautionary steps."

Finally, in California, in Los Angeles, the deposition or testimony under oath of the inventor of the patent in suit, Dr. Musser, who is listed as the inventor. He was deposed or questioned under oath. This was done September 21, 1973 in Studio City, California. I refer on page 94, and I was questioning Dr. Musser:

"Question: Dr. Musser, you have before you three different devices or toys. On your left is the

Melody Bell-O-Phone previously designated Exhibit G, in the middle of the three you have the Big Mouth Singers device previously designated Exhibit E, and on the righthand side constituting the three you have the Bell Organ previously marketed by the Knickerbocker Plastics Company Incorporated. Is it a fair and truthful statement that all three items before you essentially function in a similar manner to produce a similar type of sound, disregarding any specific structural differences inherent in three items?

"MR. BAHR: I object to that question as being leading, this is your witness."

MR. RUSSELL: May we have a ruling on the objection?

THE COURT: Read the question and the objection.

MR. SUTTON: "Question: Dr. Musser, you have before you three different devices or toys. On your left is the Melody Bell-O-Phone previously designated Exhibit G, in the middle of the three you have the Big Mouth Singers device previously designated Exhibit E, and on the right-hand side constituting the three you have the Bell Organ previously marketed by the Knickerbocker PlasticsCompany Incorporated. Is it a fair and truthful statement that all three items before you essentially function in a similar manner to produce a similar type of sound,disregarding any

specific structural differences inherent in the three items?"

And, your Honor, before you make your ruling I would like to say that this was Mr. Bahr's examination, and I was now cross examining Dr. Musser.

THE COURT: This is cross examination?

MR. SUTTON: Correct.

MR. RUSSELL: But it is examination of the inventor of the patent in suit.

THE COURT: I am going to sustain the objection. The answer may not be read.

MR. SUTTON: "Question: Dr. Musser, in looking at the three items and the internal workings of the three items, would it be your opinion that a very strong possibility exists that the Big Mouth Singers item might have been derived from or copied from the Knickerbocker Bell Organ item in front of you?", and in this case Mr. O'Brien, counsel for Mr. Musser, objected to the question and Mr. O'Brien said, "Counsel, I object to that question as having too many opinions, assumptions and what have you. I can't follow it."

And I said, "Okay, let me rephrase the question."

Mr. O'Brien said "I don't think it is a proper question."

And I said, "Let me rephrase the question."

"In looking at the two items, do you notice what might be apparent as interchangeability of any of the parts before you between these two items, the Big Mouth Singers and the Bell Organ device?"

And there is a transcription error. I will skip over the error because I am not sure what the reporter meant.

"Answer: Upon analytically studying the Big Mouth unit I found to my utter surprise, which can be substantiated by every one here, that not only was the general item a virtual copy of my invention, but the copy was to such an extent that my units are interchangeable, and will play in the Big Mouth."

Then Mr. Bahr asked, "Could I ask the witness two -- "

And the witness said, "I will be very pleased."

And Mr. Bahr asked, "Which parts are interchangeable?" and the witness answered -- I will continue.

I asked Mr. Bahr, Why not wait for your cross examination as you have urged me to all afternoon, all right, I know you are anxious about this point. Let the record show Mr. Bahr's surprise at this statement that Mr. Musser just made, and Dr. Musser continued:

"Well, a particular novelty of these instruments

is the sustenudo, meaning a continuous sound musically when you push down a key like this rather than a toy piano goes like that," and he was indicating. "And this unique system is brought about by the striking unit with the washers."

The witness goes on and unless you object to my characterization, the witness physically removed the rod and washers from the Bell Organ, placed them in the Big Mouth Singers and the Big Mouth Singers operated. That is basically what happened.

MR. RUSSELL: Implying there was anything more than the rod interchangeable?

MR. SUTTON: Only the rod assembly with the washers and striker bars --

MR. RUSSELL: All right.

MR. SUTTON: I have no other case prior to my closing statement.

THE COURT: All right, thank you.

We are now at that point of the trial where counsel will make their closing arguments or summations. I caution you again that the summations of counsel are not evidence in the case. They are only an indication by counsel as to what they think the evidence has or has not shown. Your verdict will be based on the evidence, that is the testimony from the witnesses, the exhibits that were

introduced into evidence, the stipulations of fact made by counsel, and the out of court testimony or depositions which were read.

All right.

MR. SUTTON: Ladies and gentlemen of the jury: What the plaintiffs have attempted to show in this case is that there is equivalence in at least a number of respects between the item which we referred to as the Bell Organ here corresponding to what is in the patent that this lawsuit is all about, that there is equivalence between elements within the Bell Organ and what is now three accused devices that the plaintiffs are accusing the defendants of infringing this patent on.

The three items are the Big Mouth Singers item which you have seen testified about in this trial, and two forms of a unit called the Melody Bell-O-Phone. These are the bases of the units and, of course, the top fits on these units when assembled.

It is the plaintiffs' position that all of these three items that are accused and the Bell Organ basically function in the same way to produce the same sort of carillon sound. They have attempted to show, both through the testimony of Mr. Ellman and also through the testimony

of Mr. Wuertemburg and Dr. Kern that all of these elements include tone bars, that when struck produce a sound, that the tone bars are supported. They are all, in all of these elements, supported on a portion of a key or a key assembly. In the case of the Melody Bell-O-Phone there are two different structures which act cooperatively to produce the same result as the single key structure in the Big Mouth Singers. The plaintiffs have attempted through a crude chart, Plaintiffs Exhibit 6 D, we have attempted to show that the principle, the concept, equivalent structures in all three of these devices, the Bell Organ which is the subject of the patent, the Big Mouth Singers and for our purposes this portion, the Melody Bell-O-Phone. This was made up for the one with the springs. During the trial we discovered there was another item also being marketed by the defendants;without attempting to characterize that model for this later discovered one, let me just say that it is the plaintiffs' position that all three of these items function in the same basic way. In order to produce a sound a tone bar has to be brought up into contact with a rotating rod, which carries washers on the end of it. Yes, there are washers in Bienengraber. I know that. I assume you know that. The examiner knew that, because the examiner in the Patent Office when he granted the patent in suit had

Bienengraber before him. It was cited in the patent.

Let me go through these items very briefly. In order to produce the sound you press the key, the tone bar is raised, and this is a crude model, the red tone bar is raised into the path of the washers, and the repetitive striking of the washers against the tone bars produces this sound. The same is true with the Big Mouth Singers that I just played. You press the key and in this case it is an integral piece, it is not broken into two pieces. You press the end of the key, it is a lever and it pivots. There are pivot points. All three of the accused items pivot on a rod.

In the Musser patent there is no rod, there are projections. It is the plaintiffs' position that the rod serves the same function of the pivoting of that key. That is also true with the Melody Bell-O-Phone.

As far as language, and I will get to that in a minute, about a key support ledge which is recited in the claim, claim one being representative of the two independent claims, claim one and seven, and here is claim seven, which recites a ledge and I have already stipulated that that ledge must mean the key support ledge, because there is no proper antecedent in the claim, something in every device that we have played for you during this trial

here stops the movement of that key. If it didn't stop, you saw what happens. It moves too far and it simply stops the motion because it gets in the way of the washers instead of just coming to a point where the washers can strike them.

It is the plaintiffs' position, we don't see any descriptive language in this claim about this key support ledge, and its function. It recites the element the key support ledge. We understand and the plaintiffs contend that the key support ledge has as its primary function a stop to limit the movement, that rotary movement of the key. In the case of the Bell Organ that is simple, because you simply use what has been described by Mr. Russell as the base of the keyboard. There is a structure here that stops the keys from going any further.

The other devices which we contend have the same type of mechanism for producing the sound don't have a protruding ledge. We don't need a protruding ledge in each of these cases to perform the same function. In the case of the Big Mouth Singers we see that we can stop the movement of that key by placing the cover on and now something in the cover stops the movement of that key.

Mr. Wuertemburg contended that it was something to do with the heads, something in the structure here where

the limited movement of the head stopped the movement of the key.

You saw me give him, or you saw me remove one of the heads and put the top back on, and you saw that I was able to play that piece with the key being limited, with the head not there, with the yoke under the head not there.

It is the plaintiffs' contention that the key support ledge may include the front ledge in this slot arrangement here. Even if Mr. Wuertemburg were right with the head, there is a stop, there is an equivalent structure to serve that purpose, to stop the key from moving that far.

In the case of the Melody Bell-O-Phone a different appearance. These items were marketed at the same time, the Big Mouth Singers and the Melody Bell-O-Phone, and they have a different outer appearance and a different color arrangement.

In order to stop the keys in the Melody Bell-O-Phone I don't know whether you can see here, but there are little upstanding projections molded into the base, and when you press the key down its movement is limited.

I don't know if everybody saw that. In the second Melody Bell-O-Phone you will notice that a change

was made and I can't tell you why the change was made. But in this one you still have something stopping these keys, in this case in the rear they placed the bar and part of the resilient rubber comes in to contact with the bar, and that is what limits the movement.

There is also in the front here an upstanding ledge, but I think for our purposes, and whether or not that ledge is engaged, it doesn't appear to be engaged. But what I am attempting to show you here is that there is structure, equivalent structure for purposes of stopping the movement of those keys from pivoting too far.

The structure isn't identical. It is not the same color. It is not the same shape, but it performs, in our opinion, the same function in substantially the same way. You saw when I presented the plaintiffs' case that the stop placement could be in at least a number of different circumstances, or a number of different locations. Here is a stop beneath the key, as in the Bell Organ. This was pre-made with this hole for purposes of demonstrating that the stop could be placed elsewhere to likewise limit the upward movmenet so that this tone bar would not come crashing into those washers and stop their rotation, because then you would not get the sound.

Reference was made many times to this

Bienengraber patent drawing. You haven't been shown, I don't believe or you may have buried in that book, I think you have a translation of the German. Bienengraber does disclose what appear to be washers. It also appears from Bienengraber that a form of carillon sound is produced. When I say carillon, the same repetitive type of sound. We don't say that that is not the case. The examiner in the Patent Office had Bienengraber before him and notwithstanding the fact that there were similarities in some respects to the structure, he felt that the claim recited structure that differed from what was shown in Bienengraber. What was in the examiner's mind the plaintiffs can't say. We do say that there is a linkage required.

The tone bar is over here, mounted resiliently on this member. Whether or not this is integral, I don't know. This member is a different member from the drawing in this, and whether or not it is integral as yet another member here and then the key shown horizontally here is yet another member. Whether or not they are integral or not, I don't know. We can't tell. Bienengraber, the Bienengraber patent was granted well prior to the Musser patent. Bienengraber was granted back in 1931. Musser's patent was granted on February 17, 1959. This Musser patent will expire this coming February 17, 1976.

The plaintiffs contend that these devices, the Bell Organ covered by the patent and the Bienengraber patent, those devices are different types of items.

The problems associated with marketing something the size of an upright piano and something that is a ten dollar plastic item, the plaintiff contends, are very, very different. We do not say that it is as simple as scaling up or scaling down the dimensions of the parts. The mechanism is different, and we believe the examiner recognized this when he allowed the patent. The plaintiffs purchased the patent. Musser's attorney in arguing, as Mr. Russell has read to you from the file history or the file wrapper, he was presented with the Bienengraber patent and argued the differences and the patent was granted. The fact is that a patent was granted.

You heard testimony today from both Mr. Wuertemburg and Dr. Kern. When I asked each of these individuals, and experts within their fields, whether any of the patents, the 20 patents in this patent book that they were referring to, disclosed a toy musical instrument having the elements of the claim, and it is the claim that defines the scope of the patent, they each answered no. They did answer, and I think at least Mr. Wuertemburg answered, that apart from the toy, the Bienengraber patent did disclose a

device for producing a carillon or continuous type of sound. But he admitted that it was not a toy, and there were no other patents in this book that disclosed such a device.

Yes, these patents disclose all kinds of structures and levers and linkages and keys. Most of them or all of them produce sound. Whether they be xylophones or toy pianos that in order to get a sustaining sound you have to keep hitting the key, we don't argue that. The plaintiff recognizes that these type of items have been around a long time. But as of the time when Dr. Musser came up with his invention, which was nearly seventeen years ago, and this was filed back in 1958, that is why it is about to expire, the prior art at that time did not include any patents that showed a toy musical instrument that produced the carillon sound.

Yes, today nearly seventeen years later we can say well, it is obvious that if he did this and he did that -- the fact is it wasn't done. Why wasn't it done? I don't know. But either no one invented it or it didn't come to the market, and maybe they tried it with this device and it cost too much. I don't know the reason. But the fact is you have heard testimony that establishes that no one prior to Musser has come up with his type of device for producing that sound. As an example of what can be done

today, you have seen the Schroeder's Piano as the latest in a line of products being marketed by the defendants. The plaintiffs do not accuse the defendants of infringing this item in this lawsuit, so that I want to make that clear. However, what I would like to show is a similarity between the Melody Bell-O-Phone mechanism with rotating means and keys, the Big Mouth Singers item with rotation and keys, and now the latest one, these items are no longer on the market, and this is the latest item.

They are shaped differently, they are different items, but I would like to call to your attention the similarity in means of operation.

The plaintiffs find interesting some of the similarities. The fact that the number of keys in the Bell Organ is the same as the number of keys in the accused devices, the coincidence that the rod and washers of the Bell Organ was interchanged by Dr. Musser during his deposition, as I read to you earlier, and as Mr. Ellman testified he himself has done the same, the interchangeability of this sub-assembly, and I am talking about this rod here that is spinning now, this rod is the item that was interchanged within the Big Mouth Singers accused device.

We can't prove to you, quite honestly, where these designs came from. We don't know. All we have been

told is that they come from the Orient, as Mr. Wuertemburg has testified.

Now, just before closing, I would like to direct my attention to the specific items that were gone over in detail, and I am not going to go through this again now. But you will recall that with Mr. Ellman the plaintiffs attempted to show that every item, and if you remember I had to amend the language so it met the claim language precisely, every item A, B, C, D and E had either its counterpart or its equivalent that worked the same way and performed the same function in substantially the same way. Every one of these elements, we attempted to show, and we believe we have, are present in the patented devices, the Bell Organ, the Melody Bell-O-Phone, the two different structures, and the Big Mouth Singers item.

As for the items themselves, I think I am going to rely purely on your own witnessing the means of operation of these items. You will have an opportunity when you are rendering your verdict to play with these yourself. I would like very briefly here to show you that by turning a switch, and I don't know if you can see the rubber band is off the pulley, and by bringing the key up in contact with that rotating washer we get that sound. This is a prototype and cut apart. We get that continuous, or sustenudo, or sustained

continuous tone. This is the patented device. The accused items that we the plaintiffs have accused of infringing this patent are these three. Like that, they have a motor. By closing this electrical contact here through the same type of rubber band and pulley arrangement, same type of washers are rotated and you get the sound. I have taken the covers off these. These are not how you would buy these, but I wanted you to see how the internal mechanism for producing the sound works. That is in the case of Exhibit 5.

In the case of Exhibit 5 A, the same way, and in the case of Exhibit 4 you press the contact, you have a motor, here is the motor with the same rubber band pulley arrangement. I can't push it too far. If I had the housing on, I explained previously that it would not stop but I will hold it here. The sound is produced the same way. Each of the tone bars are mounted on the keys by means of these rubber bands or grapplets or washers or whatever you want to call them, so the tone bar can vibrate and give it that ringing sound. If they didn't, you touch the tone bar and see what happens. It is dead and doesn't have the ringing. That is why these rubber resilient means are present. In each case I pressed what we call the key. Here is the key through a linkage and we have a tone bar

over here in Bienengraber. I won't say how much more, but it is complicated.

Finally, I just want to summarize the circumstances behind the plaintiffs having to be involved in this lawsuit. We have heard testimony from Mr. Ellman that both he and Mr. Lerner collaborated and came up with their own product. They approached Ideal Toy Corporation. Ideal Toy Corporation was interested. However, they were afraid to go ahead. They were afraid because of the existence of a patent. It turns out that that patent was the same patent we are involved with today. Mr. Ellman got a copy of this patent, looked at the name of the inventor Musser, they had already developed this item, they wanted to sell it and he contacted Mr. Musser. Dr. Musser. He has an honorary doctor's degree.

They negotiated a price, they were straightforward with him. They sent him copies of what they came up with. They purchased it. They paid $1,000 for it. They went back with the patent, or the option to buy the patent, they had something in writing now, and Ideal, from Mr. Ellman's testimony, was interested. He testified that they were interested to the point where they sent it to their engineering staff to come up not with a prototype, a crude prototype like this as good looking as it is, but

the finished type of drawings. They priced it out at approximately ten dollars or whatever. But they discovered, and through Ideal Toy, Mr. Ellman and Mr. Lerner discovered that there was another item on the market. The item on the market was the Melody Bell-O-Phone. I can't say with certainty to you people that this item was on the market at that time. This appears to be the later model. This item was. It turns out that Ideal Toy, as Mr. Ellman states, did not want to go into what he called a diluted market, implying that with Questor and Child Guidance marketing a toy that produced this continuous sound, Ideal would be second in the field.

They, and when I say they, the plaintiffs, have thus been forced -- they were unable to come to terms with the defendants and they have gotten involved in this lawsuit to recover what they have lost by being unable to market their own item.

In closing, we ask that you carefully consider all the evidence that you have heard by both sides, and consider that the invention that was covered by this patent was not made today or yesterday, but nearly seventeen years ago. So the more recent devices that you see have come in to the market place after that time. The patent book showing all of the prior art includes patents that predate,

that go back before the Musser patent. We ask that you go through these if you want, and see if you can find a toy musical instrument, using the words of the plaintiff, a toy musical instrument, not just a full size musical instrument, that includes the features that we have tried to show you.

That is all. Thank you.

THE COURT: Mr. Russell. I hope your statement of time is a little more accurate than Mr. Sutton.

MR. RUSSELL: He has given me a little more to go on, your Honor. I think I probably will go over a little, but I hope not.

I wanted to start with a few isolated answers to some of the things that Mr. Sutton has said. That is, picking them out in particular and then go on to general flow of my planned remarks.

Mr. Sutton raised the question about the way that his clients were forced into the suit, and I think that you ought to consider perhaps a critical point is the fact that when they bought the patent and went back to Ideal and therefore there was no reason to be afraid of somebody else's patent, they paid $1,000 for it, Ideal was still not interested in it. Not because of a device that

had just been on the market, a device that had been on the market for nearly three years. It went onto the market February 1, 1970. I think it raises a kind of credibility issue. You have the problem of these gentlemen who are very very versed in this field. They go to the shows and see everything, and Ideal Toy too are very interested in everything about it. They didn't ever hear about the Melody Bell-O-Phone going on the market, being at the show. It all seems to me a bit strange that this thing pops up, they come up with a story that they didn't know about it, came up with their in December of 1970, some eight months after Melody Bell-O-Phone is on the market. They said they never saw other musical instruments, never looked inside of them, even though they are very interested in the field. Ideal Toy does not know about it, even knowing about the Musser patent until subsequently. I simply say that to show that it seems to me kind of strange.

On the subject of interchangeability, a child's hands. Number one, an octave is an octave, and that is what you put in a child's instrument. Number 2, a child's hand is about the same around the world. You are going to make a toy instrument for a child about the same dimensions. The fact that a rod goes from one end to another to a device that is going to be naturally the same dimension

seems to be a natural consequence. It so happens that it is only that one thing that was interchangeable, just that rod. I don't think it is necessarily a strange coincidence.

On Schroeder's Piano, here is a device that does all of the magical things that my brother has pointed out to you not being accused of infringement.

MR. SUTTON: Your Honor, if I may, we discovered Schroeder's Piano during this lawsuit and it was stipulated that it would not be part of this lawsuit.

MR. RUSSELL: It was not, you withdrew it.

MR. SUTTON: We withdrew Melody Mike. Schroeder's was never here.

THE COURT: I take it you are not making a concession of noninfringement by Schroeder's Piano?

MR. SUTTON: That is right.

THE COURT: But merely indicating to the jury that it is not one of the accused devices that they need consider in this lawsuit.

MR. SUTTON: I am sorry to interrupt you.

MR. RUSSELL: If your Honor please, I understand that if a device is not brought in to a suit of this sort its accusation is waived.

THE COURT: It depends on when you discover it. If you discover it in time to bring it in and don't bring

it in, you may be right. But if you discover it immediately prior to the start of trial so that it is too late to bring it in, obviously there shouldn't be waiver or estoppel in a situation like that.

MR. RUSSELL: We have correspondence with my brother for six to eight months on the subject, your Honor.

THE COURT: I won't rule on the legal effect of that correspondence without having seen it.

MR. RUSSELL: My brother has continuously talked about how the marketing aspects of a piano such as Bienengraber's and the Melody Bell-O-Phone, for instance, or some of the other things is completely different. Yet we have the testimony of one of the parties that the thing that is important for marketing is the outward appearance. This is a field in which you have gimmicks, such as little mannequins with big mouths coming to the top to attract the person to buy the thing, to amuse a child, for instance.

The mere fact that the internal workings, the method of making the sound, the carillon sound that my brother has mentioned so much, is not an item which commands the market and pulls people in to play them as shown by the fact that the Bell Organ, this one here about which all the fighting is about, was not on the market. It had gone off the market but yet it provided that very same thing.

All of those same things that my brother has mentioned. He hasn't mentioned to you the fact that it was not on the market, and none of the fellows that were inventors and people versed in this field ever heard of it. So that is fairly good evidence to show that that in itself, the ability to make that carillon sound was not what was doing it. After all, in 1931 we got the carillon sound and whether or not it could be scaled down economically to sell it at an under ten dollar price is probably the key to the thing. You have to make it in Hong Kong or Japan, and then you can have something to sell at that price. I think you will recall Mr. Wuertemburg said they had to go off the market with one of them because the price from the Orient went up too high and they could not meet it. It is considerations of that sort which make the things sell, and not the magical things about the carillon and the keys and the projections. They are all in Bienengraber. True, you could not sell a thing that big as a toy. But that is not really the issue.

Carrying on, I think that the principal thing which I will bring my remarks on to is that my brother has not actually talked about the claims of the patent. He has said look at this device and look at this device, and see aren't they the same. But our evidence, and in my view

the important evidence, is to draw your attention to what Mr. Musser patented and compare it to these devices and to Bienengraber, because that is the thing which will focus you on to the evidence which is important to you.

I would like to bring together certain of these rather widely distributed areas of evidence from the record. This is one of the problems with the record. As you see it, isolated bits come from different witnesses, and it is better to try to bring them in to categories so you know where various parts of the evidence apply.

Here, as you have been told before, the plaintiff has admitted and stipulated that there is no literal infringement. In other words, they agree that the items underlined in color here, including black, are not in the accused structures and they are requesting leniency of the doctrine of equivalency. So you can take those items as they are literally shown and ignore them and say that something else is equivalent.

What have you heard? You heard Mr. Ellman parrot the famous words, do the same thing in substantially the same way -- I have to get them right. Do the same work in substantially the same way to accomplish the same result and he would say no. I am sorry, he would say yes, the accused devices would do the same thing in more or less the

same way. He had a lot of difficulty because when he would come to something like this element of the Melody Bell-O-Phone where the key is the thing you press, really isn't connected to the tone bar, he had to say that really does not matter because you see the little button is pushing the end of the tone bar, and even though they are not connected it is operatively connected. And it could be regarded by yourselves as being the same.

Of course, they run into problems when they try to say that you take a linkage over here and you push down here and it pushes against there and it brings up the tone bar. They have to find some way of saying that is different, and at the same time in order to get infringement they have to say this is the same. In fact, they actually showed this as a connected element, but counsel made it quite clear to you that he didn't intend it that way. It was intended to be two separate parts.

Contrasting that type of evidence that you will have to sift, you will find or you heard Mr. Wuertemburg talk about the housing and the elongated slot, and you heard him say that the slot provided a mechanism for holding the keys down. He went at great length into the fact that there were projections in the front of the housing that stuck up and the keys had little recesses in the bottom

dimensions just the right length to keep the keys apart, and that there was a cooperative relationship between the keys dropping under these projections and holding the key and then the top comes down so that the child can't turn the thing upside down and the keys fall out. That is the claim, and Mr. Wuertemburg said when you have a device that has those things in it, it does the same work in substantially the same way to accomplish the same result. Quite different. The accused devices have little holes that take the keys in. The holes themselves don't hold the keys in, not the entire key. The keys are held on a rod. We are quite frank to say that when you look at the thing across the room and you can hear a child play it is just as irritating one way or the other, but the point is what is this function in terms of that claim? Is it doing generally the same thing, making an instrument that irritates you but, on the other hand, what is it doing in detail? Is it doing the same job in substantially the same way for substantially the same result? The answer has to be no, because it is doing it in a completely different way. Here the keys are held in right but they are held in by that clamping element at the bottom on to a rod. The rod pivots, the longitudinal motion of the rod is limited not by any upstanding projection in the housing, but by the abutting shoulders that are

molded onto those keys. In fact, they are not really limited until you get them all in there, and then they occupy the space and can't move.

So that you have an expert engineer telling you that these are functioning in a different way to accomplish, in the end, the same result.

I think it is relevant to look at the qualifications of the witnesses that have been before you. Mr. Ellman in his deposition denied any ability to understand engineering drawings. I asked him specifically what was the purpose of the slots and things and he didn't know at the time, and that was 1973. The important thing to him was what the device would do, it would make a carillon sound, and the price and its outward appearance. These are the important things, because that is what you can sell with. On the other hand, he didn't know anything about engineering drawings. He said he had never looked inside a musical instrument before. Perhaps he has learned his lessons between then, since 1973.

On the other hand, I think you should take into consideration that here is a man who is a party to this suit and is being offered as an expert, but has a background of that sort.

We were shown, you and I, and the Court, a

stack of patents in Mr. Ellman's name and a stack of toys. We weren't shown what they were. We weren't shown as to whether they had anything to do with the suit or constructions that would have anything of relevance or interest to the suit.

On the subject of the closeness of the prior art to the patent in suit, you will understand that it is important in obtaining a patent, and it is even important in the questions that are coming before you as to closeness of the prior art, and we have read into the record the fact that Mr. Musser's attorney was pleading with the Patent Office saying that we have a very small invention in the prior art, and therefore we should have this specific claim and be allowed it. I wanted to show that in terms of the prior art the only thing in this claim, and this was backed up by the witnesses -- and incidentally, Mr. Wuertemburg was questioned on this very specifically as to all of the elements of the claim, were they in Bienengraber. His answer was yes, with the exception of one, the tone bar resiliently attached to each of the keys.

Mr. Sutton pointed out the word toy, as to whether that construction here requires it to be a toy is denied in effect by the fact that everyone of the elements in there operating relationship is in the 1931 patent.

So to just say I am going to take a 1931 patent and make a toy out of it is what has happened with the exception of this one thing, the tone bar resiliently attached to those keys. This evidence, incidentally, was not denied by the plaintiff. So here you have that one thing and the evidence comes full circle when you find that Mr. Ellman himself had to say it didn't really matter that the tone bar would be mounted on an element which was not the key.

I want to conclude with the statement that Mr. Musser's attorney -- my brother has said that Bienengraber was argued before the examiner and the examiner knew about Bienengraber and yet he allowed the claim. All right. You have the picture of Mr. Musser's attorney saying "Look, give me your patent, just however small it can be because this is a crowded art and an invention comes in little steps, and Bienengraber does not mount his key directly on the tone bar, and I will read the words." However, this reference does not really anticipate the claims in this case, because of the fact the keys are employed to operate this reference structure do not carry the tone bar employed.

You have Musser pleading to get the patent, the examiner saying all right, you can have it with this specific element, and the examiner does not, however, have

before him several critical things. He does not have the arguments that are being made today by plaintiff. He does not have him saying that these things are all equivalent to prior art. He has in his mind that the inventor has the movements in there specifically as stated. That is the thing that makes it important information which was not before the examiner which is the tack they are taking now.

What it comes down to, ladies and gentlemen, is this, he wanted this patent badly and asked for it on a very narrow basis. Now he wants it the other way around, and wants it on a broad basis. I think the evidence shows a verdict of nonequivalence, which is your first special verdict.

Thank you.

THE COURT: As I told you at the beginning of the trial, we have divided the trial into two parts. The first part is devoted to the issue of infringement and the second part will be devoted to the issue of validity, that is, is the patent valid or invalid. We have now come to the conclusion of the first part that directed to the issue of infringement. You are about to retire to the jury room to deliberate with one another and arrive at a verdict on that issue of infringement.

As I told you at the outset, the patent includes

drawings, specifications and claims. The question of infringement comes down to whether or not the claims are applicable to the accused devices, either literally or under the doctrine of equivalence. If the working of claim one, which we have accepted here as typical of the patent claims and which is on the board in front of you, applies word for word to the accused devices, then there is what we call literal infringement. So we don't need to worry in that case about the doctrine of equivalence. It is only where we do not have literal infringement that we need to go to the second question, and that is the doctrine of equivalence. Even though there is not literal infringement the claim may still be infringed if the defendants' accused device contains elements which are equivalent to those called for in the claim.

I will define for you in a moment the term equivalence. It has been stipulated by counsel that in claim one, the typical claim, there are five elements or features which do not literally apply to the defendants' accused musical instruments. So all you will need to determine is whether or not the defendants' instruments include elements or features which are the equivalent of those five disputed elements or features of the claim.

It has been stipulated that all of the remaining

elements or features of claim one are present in the accused devices. So you need direct your attention to only those five disputed elements, and as to those you need consider whether or not the defendants' three accused devices contained elements which are the equivalence of those five. That is all you have to determine on the first part of the trial.

In determining that question, you will rely upon the evidence which you have heard and which has been introduced during the trial. This evidence has come to you in four different ways. First, there has been the testimony of the witnesses on the stand. Second, there has been the physical exhibits and the documentary exhibits that have been introduced into evidence. Third, there have been the stipulations of fact made by counsel, that is the agreements between counsel that a certain state of facts exist, which agreements are binding upon you. Fourth, there is the out of court testimony or depositions which have been read into evidence, and which have the same force and effect as in court testimony.

Those are the only things that you will consider in determining your verdict. You will not consider the opening and closing statements of counsel. They are not evidence. They are merely a guide to you, to help you in

locating the evidence on which you will base your verdict. Likewise, the comments that I may have made during the trial including my opening statements and this closing summation are not evidence in the case. They are only an indication to you of the applicable law.

In your oath as jurors you bound yourselves to apply the law as I give it to you. So you don't have to agree that this ought to be the law. I am telling you that it is, and you are stuck with it whether you like it or not. But in determining the facts of the case you as members of the jury are the sole and exclusive determiners of the facts, and your verdict is the result of applying the facts as you have found them in your deliberations to the law as I give it to you in my instructions or charge to you.

You will rely on your recollection of the facts, not the recollection which counsel have given you. If you remember the facts or the evidence differently than counsel have characterized it, it will be your recollection which governs. You don't have to rely completely on your recollection. You may have with you in the jury room any of the exhibits that have been introduced into evidence. I am going to suggest that you take with you when you go in certain of the exhibits, so that you will be spared the necessity of calling for things that I am sure you will

want during your deliberations. One is the patent in suit. I think each of you has his or her own copy of that patent. Second, the actual accused devices, the Big Mouth Singers and the two models of the Melody Bell-O-Phone. Also you will probably want the original, I think it is called Bell Organ, which is made very similarly to the structure shown in the patent drawings. I think for all present purposes it is identical to the structure shown in the patent drawings.

In addition, I am going to give you a sheet which I will explain to you more in detail in a moment, which is called a special verdict, and which will list the elements of the claims which are in dispute and you will be able to write over here in vertical columns under headings indicating the three accused devices yes or no to indicate whether the accused device contains an equivalent of the elements which are listed in the lefthand column.

If you want any other exhibits with you in the jury room during your deliberations, all you have to do is to send out a note to me through the marshal, who will be posted at the door of the jury room and we will be glad to send those exhibits in for you. I think at the outset those will be the ones that you will be most interested in having.

Likewise, if you cannot remember any of the

testimony that was given and want to hear that again, if you will send out a note to me through the marshal we can have the Court Reporter re-read that part of the testimony from his notes.

Now, how do you go about determining the facts based on the evidence? Well, you use your common sense. You have heard the testimony. You have seen the exhibits. You have heard the arguments of counsel. You will be given this form that contains certain questions on it and you will have to answer each of those questions, and you will discuss back and forth among yourselves your views as to how the questions ought to be answered, and as I will indicate further in a moment, you will attempt to arrive at a single verdict which represents the conscientious decision of eac nd every one of the six members of the jury that will pa icipate in the deliberations.

I want you, in making your determinations, to put out of your minds everything except the evidence. I want you to ignore not only my opening and closing remarks, but also any comments I may have made during the trial, for example, in ruling upon objections, or in saying anything else to control the progress of the trial. Those are legal matters that need not concern you at all.

Don't try to guess what my thinking is. It is

your decision that is going to determine the outcome of the case.

You should perform your duties as as a juror as objectively as you can. Forget who the plaintiffs are and who the defendants are, whether you like their personalities or whether you like the personalities of their attorneys. You should determine the issues in as objective and impartial a manner as possible.

In every case we begin with the fundamental principle that the plaintiffs who have brought the lawsuit have the burden of proving all of the material allegations of their complaint by a fair preponderance of the credible evidence. That term, fair preponderance of the credible evidence, simply means the greater weight of the evidence. It refers to the quality of the evidence rather than the number of witnesses or the number of documents. It means that the evidence in behalf of the party on whom rests the burden of proof must have more convincing weight than that of the opposing party. You may say that a fact has been proven by a fair preponderance of the credible evidence when after considering all of the credible evidence relating to that fact you are persuaded to believe the existence of the fact. If you find that the credible evidence relating to a particular fact is evenly divided between evidence

tending to prove the fact and evidence tending to disprove the fact, then you must decide that particular fact against the party who has the burden of proof. If the evidence is equally divided on both sides, then the party who has the burden of proof has failed to carry that burden, because he must establish his case by a preponderance or a greater weight of the evidence.

On the other hand, if after considering all of the evidence relating to the issues before you, you find that the evidence in favor of the plaintiff is of greater weight than that in favor of the defendant, then the plaintiff has sustained its burden of proving its case by a fair preponderance of the evidence.

Now let's turn to the specific question that I have indicated you are supposed to determine here, and that is the question of equivalency. As I have already indicated to you, the five elements that you have got to determine the issue of equivalence with respect to are shown in color on claim one before you on the board, and they are listed on the special verdict form. I have changed the special verdict form here because I based this upon a list that was in one of the proposed charges submitted to me by counsel, and then I discovered after this was typed up that it omitted the language that was added to that plaintiffs Exhibit 6 A.

So I have added the same language here to the first element and I am going to pass these to you in a moment, and I have enough for each of you but I have only inserted on the first copy which will be your official copy that Mrs. Smeltzer will get, since she is the foreman or forelady, if she would prefer, of the jury, and will preside at your deliberations and will sign the special verdict form after your deliberations are complete.

I want to define for you the term equivalence. It has a particular meaning in the patent law, and that meaning is this: If two devices do the same work in substantially the same way and accomplish substantially the same result, they are equivalents. Repeating the three necessary elements, the two devices in order to be equivalent must, one, do the same work. Two, they must do that work in substantially the same way. And third, they must accomplish substantially the same result.

That definition is also on your special verdict form in case you forget it. You can refer to the form to refresh your recollection.

In determining that question of equivalence, there are certain factors that you should bear in mind. The first is this: equivalence should be determined not on the basis of the overall combination, but on an element

by element basis. In other words, if you found that one piano over here is so constructed that you push a key and you hear the so-called carillon sound, and the other one is also so constructed that you push a key and you hear the same or a similar carillon sound, that does not mean that they are equivalents in the eyes of the patent law, because you don't determine equivalence on the basis of the overall combination but on the basis of the individual elements in question.

As I indicated to you earlier, claim one and each of the other claims in suit is a combination claim, that is, it covers a combination of elements. One of the elements is, for example, a housing having a front side with an elongated slot located therein. That is an element. In order to find equivalence in the eyes of the patent law, you must find that that element and each of the other four of the disputed five elements finds its equivalent in the defendants' accused device, that is that the defendants accused device has an element or group of elements which performs the same function in substantially the same way to accomplish substantially the same result, and you must make that determination with respect to each of the five disputed elements, and you must make it for each of the three accused structures. So you have got on that question of equivalence

fifteen determinations to make. That is why in this form I have listed the five elements in the lefthand column and then in vertical columns to the right of that I have listed the three accused structures, the Bell Mouth Singers, which is Exhibit 4, the Melody Bell-O-Phone, the first model which is Exhibit 5, and the Melody Bell-O-Phone second model which is Exhibit 5 A. You have five elements as to each of three accused devices, a total of fifteen yes or no answers you have to give in making the determination of the issue of equivalence for all of the elements, and all of the accused structures.

The second thing that you should bear in mind in determining the question of equivalence is that you should disregard the exterior shapes and the colors and the design features, for example in the Big Mouth Singers the heads and the mouths that move as the keys are pressed, and in the Melody Bell-O-Phone you should disregard the little telephone hand piece and the dial on the top of the case. They are not part of the working part of the invention that is relevant to this lawsuit. You can have infringement in a device which does not look at all like the device which is shown in the patent drawings. As long as it contains all of the mechanical elements or features which are described in the patent claims or the equivalence

of those elements or features.

The third factor that you should consider in determining equivalence is the file history or file wrapper of the application for the patent in suit. As has already been indicated, after a patent application is filed the Patent Office will issue an official action which is mailed back to the applicant's attorney, and which frequently rejects the claims on the basis of unpatentability in view of the prior art. When I use the term prior art, as a number of the attorneys have used it during the trial, I simply mean in this case the prior patents. They are part of the prior art. The prior art also includes prior publications, it includes prior commercial devices and so forth. In this case we are concerned with prior patents as part of the prior art. So the Patent Office comes back with an official action and in this case they said we reject your claims over, for example, the Bienengraber German patent and other patents. Then the applicant's attorney files a response to that official action, and in his response he may amend the claims and he may introduce limitations into the claims, that is additional features or additional elements or additional limiting language in claim features that are already present, and at the end of his amendatory portion of the response he may add remarks

in which he argues that the claims as now amended or perhaps even the claims before amendment were patentable over the prior art cited by the Patent Office in rejecting the claims.

In this case the defendant has argued that some of the arguments which were made by Dr. Musser's attorney in trying to persuade the Patent Office to allow the claims are statements which are contrary to the position which the plaintiffs are now taking in attempting to obtain a broad construction of the patent claims, that is a construction broad enough to cover the accused devices.

You will have to determine whether or not any arguments were made which should be considered by you in determining your question or in your determination of the question of equivalence.

It is up to you to determine the weight and significance to be given the arguments that were made by Dr. Musser's attorneys to the Patent Office in emphasizing certain features or aspects of the claimed invention as distinguishing that invention from the prior art cited by the Patent Office.

The fourth factor that you should consider in determining the question of equivalence is the fact that insofar as the patent in suit is concerned any member of the

public is entitled freely to practice any invention which was in the public domain, that is which was known to the public or which was described in expired patents or even in pending patents of others prior to the application for the patent in suit. In other words, no one can obtain a patent which prevents members of the public from using things that were in the public domain that were known and available to them before the patent issued. So in determining equivalence you cannot give to the patent claims an interpretation so broad as will take from the public domain things which were in the public domain prior to the issuance of the patent.

That is why in the special verdict form I have included a first question which reads as follows: "Do you find that defendants in the construction of their designated toy musical instruments are employing only the prior art, plus variations that would have been obvious at the time of the patented invention to persons having ordinary skill in the art?" And I ask you to answer yes or no with respect to each of the three accused devices, the Big Mouth Singers and the two models of the Melody Bell-O-Phone.

If your answer to that question is yes, that is if you find that the defendants have only used in their accused devices the elements of the prior art plus variations that would have been obvious at the time of the

patented inventions to persons of ordinary skill in the art, then you will have found that the claims of the patent in suit cannot be interpreted so as to cover the defendants' accused devices and that will dispose of the issue of equivalence, and you don't even need to answer the second question. However, if you answer no as to any of the three elements or any of the three accused machines or devices, then you must answer the second question as to that device. If you answer no as to all three then, of course, you will answer the second question as to all three of the devices.

I should say that I may have misled you a moment ago when I referred to elements of the prior art. It isn't sufficient to find that every one of the elements in defendants' devices is old and may be found separately in the prior art. That would not prevent the claims of the patent in suit from being interpreted to cover them, because you can get a patent on a combination of elements every one of which is individually old. What you must find in order to answer the questions under part one affirmatively is that the prior art teaches the entire assembly or at least that the entire assembly in the defendants' device was obvious to a person having ordinary skill in the art at the time that the patent in suit was filed, which is October 1958.

The fifth factor that you should keep in mind

is that the range of equivalence for a basic or pioneer patent is broader than that for a patent in a crowded art.

Now you will recall that during the prosecution of the application for the Musser patent in suit Dr. Musser's patent attorney in the portion which Mr. Russell read you from the file history said that this patent application is in a crowded art. That is one element which you may consider in determining whether this is a pioneer patent or a patent in a crowded art. If you find that it is a patent in a crowded art, then you may give the claim a narrowed range of equivalence as compared to the range you could give it if it were a basic or pioneer patent.

As I already told you with respect to the issue of infringement, the plaintiff has the burden of proof. That burden applies to each of the five elements in question. You must find that that element or its equivalent is present in the accused device by a preponderance of the credible evidence in order to find that the claim has been infringed by that device. If you find less than a preponderance of the credible evidence that such an element or its equivalent is present, then you must find a noninfringement, that is nonequivalence as to that claim. You must find that all five elements or their equivalence are present before you can find infringement.

We have had testimony from witnesses for both sides. To some extent their testimony has been contradictory. Well, how do you reconcile contradictory testimony? How do you determine an issue of fact when there is evidence which is in conflict, some on one side of the issue and some on the other side. Well, just the way you would determine the truth of the matter if two people whom you know told you conflicting stories. You would have to decide which one to believe. You must make that decision here, and you will base that decision upon all of the factors which bear upon credibility in determining such a question in your ordinary life. You use your common sense. You say what kind of a man was this? Did he seem worthy of my belief? What was his demeanor on the stand? Did he seem frank and open, or was he evasive? Did he have any motive or incentive for telling anything other than the truth? Did his testimony make sense to me as a practical matter? Was it corroborated to any extent by other evidence in the case? Was it in conflict with or contradicted by any other evidence in the case? If you find that a witness testified falsely in any one respect, you may decide the effect which that should have in your determination of the credibility of the remaining part of his testimony. You may decide to disregard the rest of his testimony altogether, or you may

decide that he testified falsely about only one matter, and truthfully about all other matters. It is entirely up to you to determine the weight and credibility to be given the remaining part of his testimony. The testimony of an expert witness should be appraised just like the testimony of any other witness with the qualification that when he speaks in a field with which he has specific experience then obviously his testimony is entitled to more weight than a similar opinion expressed by someone who has not had that experience. Where you have experts for two sides, for the two sides, giving contradictory testimony, then you weigh their testimony and decide which is worthy of your belief in exactly the same way you would weigh the conflicting testimony of an ordinary or non-expert witness.

The opinion testimony of an expert witness is not binding upon you merely because he is an expert, and you are free to disregard his testimony or to form your own conclusions about the subject of his testimony, whether it is contradicted or whether it isn't.

When you get into the jury room you will undoubtedly find that you start out with a lot of different points of view. The purpose of your deliberation is to exchange your points of view, and each of you should participate in the deliberations and express your points of

view freely. The objective, of course, is to arrive at a single verdict which represents the conscientious beliefs of all of you if that is at all possible. So do not let the fact that you may have expressed a particular point of view at the outset of the deliberations embarrass you or impede you in any way in changing your point of view and in embracing a new point of view if after considering the arguments and discussions of your fellow jurors you now find that you can conscientiously adopt a different point of view than the one you originally expressed. Don't be stubborn, don't be proud about your other point of view. Keep an open mind and be very free about changing it but, of course, do not feel that you must adopt a new point of view simply because you are outnumbered. The ultimate verdict must represent the conscientious point of view of all six of the members of the jury who will be deliberating.

As I have already told you, you will start out with certain exhibits in the jury room with you. If you want any additional exhibits you may have them, and if you want any portion of the testimony re-read you may have that re-read. If you can't remember any part of the charge, or if it is unclear and you want it clarified, then if you will send a note out to me through the marshal I will be glad to explain it or to repeat it.

I am going to pass to you now a number of copies of the so-called special verdict. I have here six copies, one of which has the additional letters written in in red ink, which will go to Mrs. Smeltzer. The others are identical except for those additions. You need fill out only the official copy, that is the one that Mrs. Smeltzer has, with the red ink on it.

As I have already indicated to you, if your answer to all three parts of the first question is yes, then you need go no further. You need not answer the second question.

If your answer to any part of question one is yes, then you need not answer the corresponding part of question 2. With that exception, all of the blanks should be filled out, either with a yes or a no, and each yes or no must represent the conscientious vote of all six of the deliberating members of the jury.

It won't be necessary for you to return any general verdict of equivalence or nonequivalence with respect to the accused instruments, because the special verdict will make that clear. If you have answered yes as to any one of the three devices listed in part one, then that will mean that there is no equivalence and therefore no infringement as to that device. If you have answered no as to all three

of the devices in part one and then have answered no as to any element with respect to that device in part two, then there will be no equivalence and no infringement with respect to that device. If your answers are all no in part one and all yes in part two, then there will be equivalence, and therefore infringement as to all of the devices. If your answer is no in part one as to any one device and all of your answers with respect to that device are yes in part two, then there will be equivalence and therefore infringement with respect to that device.

Have you any questions with respect to the special verdict form?

I will see counsel at the side bar.

(At the side bar.)

THE COURT: Any exceptions or suggestions?

MR. RUSSELL: No, your Honor. I thought it was fabulous.

MR. SUTTON: Likewise.

MR. RUSSELL: Mr. Messing brought up one point that had not occurred to me, being a patent lawyer. He said maybe the jurors ought to be told that just because it is a patent doesn't mean you can't copy it. You have to copy what is claimed.

THE COURT: I think the special verdict form

makes that very clear. They have to find equivalence as to each of those five elements. If they don't there is no infringement.

(In open court.)

THE COURT: You may now retire or at least the six main members of the jury may retire to consider their verdict. Normally at this point we release the alternate members of the jury. We can't do that in this case, because we have a second part of the trial, and we have to keep you in case one of you has to take the place of one of the other members of the jury for the second part of the trial. So I will ask that you come back tomorrow at ten, and bear with us until we get the verdict as to the first part of the trial, and that may be a while in the morning so bring some reading material with you, so that you won't be bored to death while you are waiting for the six deliberating members of the jury to reach their verdict on this first part of the trial.

Have a good evening to the two alternates. You may go now, but we will see you at ten o'clock in the morning. As to the remaining six, I will ask that you remain seated until we can swear the marshal.

The marshal has stepped out for a minute. The six members of the jury can go ahead and start their

deliberations and my deputy clerk will stand guard at the door to make sure that you are not disturbed until the marshal shows up, and he will swear the marshal and the marshal will releave his sentry duty if that is agreeable with counsel.

JUROR 6: I do have a question, your Honor. If our answers are not the same for one and three, for instance, with reference to the three accused devices, how does this affect our ultimate decision?

THE COURT: What do you mean, your answers are not the same?

JUROR 6: If we answer yes for one and no for another. Is the decision a final decision, your decision based on the sum total --

THE COURT: My decision really is your decision. The ultimate decision will follow automatically from your answers on this special verdict form. Let me say this, and this maybe is the source of your doubt. Each one of these accused devices stands independently of the others. You may find that one is an infringement and the other two are not. You may find all three are infringements. You may find all three are not. You may find that two are infringements and one is not. Each one is independent of the others and must be considered by you just as if it were

the only one involved in the lawsuit.

The marshal is here.

(The marshal is sworn.)

THE COURT: Before you start your deliberations the two alternates can go in with you to get their wraps or coats.

As I indicated to you earlier, you need not be concerned about being kept to a very late hour tonight. If you have not reached a verdict by a quarter of seven, you will come back and release you until tomorrow morning at that time.

JUROR 6: I have one other question. In my own mind if I know of something which I would like to hear the testimony on again. Do I give the marshal the note?

THE COURT: Not yet. It is possible one of your fellow jurors will remember that testimony so it won't be necessary to call the Reporter back to re-read that part of his testimony. That is why we have six jurors and not one.

You may retire.

(At 3:52 p.m. the jury commenced their deliberations.)

THE COURT: Thank you very much, gentlemen, I think both counsel did a fine job.

(Two notes were received from the jury, marked Court Exhibits 1 and 2.)

(At 5:37 p.m. the jury returned to the courtroom.)

(Jury roll called - all present)

THE CLERK: Madam Forelady, has the jury agreed upon a verdict?

THE FORELADY: Yes, we have.

THE CLERK: How do you find to question one, Big Mouth Singers, Exhibit 4?

THE FORELADY: No.

THE CLERK: Melody Bell-O-Phone, Exhibit 5?

THE FORELADY: No.

THE CLERK: Melody Bell-O-Phone, Exhibit 5 A?

THE FORELADY: No.

THE CLERK: How do you find to question two, part one?

THE COURT: Let's ask first as to Big Mouth Singers, Exhibit 4, part one.

THE FORELADY: Yes.

THE COURT: Part two under that same column?

THE FORELADY: Yes.

THE CLERK: Part three?

THE FORELADY: Part three is yes.

THE CLERK: Part four?

THE FORELADY: Yes.

THE CLERK: Part five?

THE FORELADY: Yes.

THE CLERK: As to Melody Bell-O-Phone Exhibit 5, part one?

THE FORELADY: Yes.

THE CLERK: Part two?

THE FORELADY: Yes.

THE CLERK: Part three?

THE FORELADY: Yes.

THE CLERK: Part four?

THE FORELADY: Yes.

THE CLERK: Part five?

THE FORELADY: Yes.

THE CLERK: As to Melody Bell-O-Phone Exhibit 5 A, part one?

THE FORELADY: Yes.

THE CLERK: Part two?

THE FORELADY: Yes.

THE CLERK: Part three?

THE FORELADY: Yes.

THE CLERK: Part four?

THE FORELADY: Yes.

THE CLERK: Part five?

THE FORELADY: Yes.

(Jury polled -- all answered in the affirmative.)

THE COURT: Anything further?

I want to thank you very much for the obvious care that you gave to your deliberations, and the obvious attention that you paid during the trial. I think we have an unusually intelligent jury here if I can judge by appearances, and we will come back at ten o'clock in the morning to continue the remainder of the trial on the issue of validity of the patent. Thank you very much, and have a good evening. I will see you in the morning at ten.

(The jury left the courtroom.)

THE COURT: I have here the special verdict form as signed by the jury foreman, Gertrude Smeltzer, and I will have that marked as Court Exhibit 3.

Thank you very much, gentlemen. I will see you tomorrow at ten.

MR. SUTTON: Just to confirm the scope, the question in your chambers was raised about the prior art having been raised in this trial. We have already stipulated between counsel that prior art or prior patent art would be used in terms of invalidating the patent if the defendants

can do so. Can I ask what the scope of this trial will be as concerns the same prior art that has been presented in this case?

THE COURT: I don't know what you mean by the term scope of the trial. The objective of the trial, of course, is to determine whether or not the claims of the patent in suit are invalid in view of the prior art which consists of the patents in the prior art book, Defendant Exhibit B, either as fully anticipated under 35 USC Sec. 102 or as obvious under 35 USC Sec. 103. I assume there is not complete anticipation with the possible exception of equivalence in view of the German patent, which is tab 19 in Exhibit B.

With respect to covering ground we have already covered, I don't think that is necessary. We are going to have the same jury for the question of validity that we had for the question of infringement. There will obviously be references again to some of the same patents because before the patents were referred to in connection with the issue of infringement, and I don't think that ought to bar reference to them again in connection with the issue of validity. It is unnecessary to repeat anything that is already in the record, it is so fresh in the minds of the jurors.

Anything further?

MR. RUSSELL: The question of making formal motions with respect to the verdict moving to set aside the verdict as being contrary to the evidence, and for a new trial, your Honor.

THE COURT: Motions denied.

Good evening.

I have here defendants requested instructions, gentlemen, or rather plaintiffs requested instructions on the issue of validity. I don't have anything from the defendants yet. Do you have any proposed charges on the validity issue, Mr. Russell?

MR. RUSSELL: Yes, your Honor, you will find in my proposed charges that I did submit that there is a second section at the end.

THE COURT: All right.

MR. RUSSELL: Following on page 16 you have now found the equivalent of each of elements in the accused structures and also a proposed amendment to it was filed earlier today.

THE COURT: I don't see it. I have two volumes here. Maybe it is in the volume I have upstairs. Is it bound like this?

MR. RUSSELL: Yes, entitled Defendants Proposed

Charges and Requests for Special and General Verdicts. What you have, I believe, is the obsolete one that I filed a long time ago.

THE COURT: Maybe the other one is in chambers. I do have one upstairs, I believe, and perhaps that is the one you referred to.

All right.

MR. RUSSELL: I know that you used it in connection with development of the charges to the jury on the validity issue. I am sure you have it, your Honor.

THE COURT: All right.

MR. RUSSELL: And you have the proposed change that I filed this morning? I will give you a copy in case you don't.

THE COURT: Amendments to defendants proposed charges, is that the one you are talking about?

MR. RUSSELL: Right, your Honor.

THE COURT: All right.

(Trial adjourned to December 17, 1975, at 10:00 a.m.)

jqkm

GEORGE LERNER, et ano.

vs.

CHILD GUIDANCE PRODUCTS, INC., et ano.

73 Civ. 2006

December 17, 1975
10:00 a.m.

(In open court. Jury present.)

THE COURT: I might tell our two alternate jurors who left us early yesterday, that while you were gone your fellow jurors deliberated and reached a verdict on the question of equivalency, that is the question of infringement, and they have ruled that all three of the defendants accused devices, the Big Mouth Singers and the two models of the Melody Bell-O-Phone, do infringe the claims of the patent in suit. However, that leaves us the question whether those claims are valid.

The mere fact that a patent is issued does not mean that the patent is valid. The Court, in this case the jury, must determine whether or not the patent should have been issued. The fact that the patent issued gives a presumption of validity. The patent is presumed to be valid, but that is what is called a rebuttal presumption. In other words, it can be overcome by evidence that the patent is invalid.

The particular defense that is being relied on here to the validity of the patent, or perhaps I should say the particular attack against the validity of the patent that the defendant is employing, is the argument that the invention which is claimed in the claims of the patent in suit would have been obvious to a person having ordinary skill in the art at the time the invention was made. That is a statutory test of validity which is established by the patent laws.

If the invention would have been obvious at the time it was made to a person having ordinary skill in the art to which the invention pertains, then the patent is invalid. In determining that question of validity, as I will tell you in greater detail later on, you will be required to give the claims the same breadth of interpretation as you gave them in determining the question of infringement. In other words, you can't construe the claims broadly for the purpose of infringement and then narrowly for the purpose of validity. You must give them the same consistent breadth of interpretation for both infringement and for validity.

We will have the same procedure at this trial of validity as we had for the trial of infringement. That is, we will begin with opening statements of counsel and then

we will have evidence and then we will have closing statements, and then the Court will give you its instructions or charge. With this one difference: With respect to validity, the defendant has the burden of proof because, as I indicated to you, the patent is presumed to be valid until proven otherwise. So the defendant will put in its case on validity, or more properly in validity since that is what the defendant contends, first, and then the plaintiffs will have their opportunity to put in evidence bearing on the question of validity, and finally the defendants will have the opportunity to put in a rebuttal case.

We will have the opening statement now from the defendants' attorney, Mr. Russell.

MR. RUSSELL: Thank you, your Honor.

Ladies and gentlemen of the jury, it will be our objective in an attempt to show you that this structure was old or essentially old, to put on our witnesses who will describe what was available to the man skilled in the art. This man skilled in the art is somebody who you must appreciate would be a man who is working in this field and not just the ordinary person without any training. The easy way to look at this thing is to imagine that the man has this book. These references are being offered to you to show you what was available, the design choices available

to the man skilled in the art. The way it has been phrased in the past is to picture this man sitting in his study, and he has these pictures on the wall and he is being told here is what you can do, you can take the knowledge of these things and you can use it. These are your choices and now what are you going to come up with. Also the objectives. For instance, as you will recall in the first part of the case, there was a good deal of emphasis made on the fact that this was a toy, the Musser was a toy. The other one, Bienengraber, was a 200 pound thing and therefore thinking of the objectives we intend to show that the objective of taking a big piano and making an imititation in toy size for a child was an ancient objective known long before. Patents were not cited to the examiner, we will show this. These things he was not aware of. The same idea, we will show that the fact that a tone bar could be mounted directly on a key to move into an area where it could be stricken to make a sound likewise was an element which was not before the patent examiner when he decided there was an invention involved here.

So it will be our objective to show that given these design choices, the man skilled in the art given the objective which was also the old objective, to make a toy that has a carillon sound, what are you going to do? It

will be our intention to show you, and hopefully convince you, that it is just one simple change from here to here and you end up with the exact toy that Dr. Musser has patented. It will be our intention to show you that this is a mere use of available alternatives, and arrives at the identical result.

Now in stating that it arrives at the identical result, I have to rely, as your Honor pointed out, on the holding that you have rendered yesterday that as far as these things are concerned a change, for instance, from prongs and slots to a bar is not an important change. As you have held,that is a change which does the same job in substantially the same way to achieve the same result. Ignoring those differences then, you see we can say that they are identical.

So that is part of what his Honor was saying with respect to the consistency of the decision.

When you do that you can simply take one little thing and put it there and you have gone the whole way home to the invention in suit, and at that point we will attempt to show that that would be the type of thing which would be a merely routine design choice. The one that makes it arrive at the exact invention of Musser would have been a little bit more expensive. That is something to consider,

because you may ask why wasn't it done. One good reason is expense of doing that. The design choices that you have available, some of them as we will show you, are simply to push an element and another little striker comes and hits a xylophone bar as a typical child's toy, extremely inexpensive to make the thing add to that mechanical drive, motor, etcetera, any little complexity raises the price. So that the only distinction between the really simple ones and the Musser one is the addition of the carillon producing element, which was known and could be plugged simply from one reference and put into the box of the other without any other change.

That will be the extent of our proof except that beyond that in terms of whether or not the item was a significant contribution, you will have to assess, as I understand it, that all changes, any change need not be patentable. It has to have some significance so that you will have to assess was there a function from this change which was unexpected, would have been unexpected to this man sitting in his study, because anything this man in sitting in his study could do and would naturally do from what he is looking at would not be inventive. It has to be something that would not occur to him, would not be obvious to this man looking at these references, then it is

inventive. It is quite possible that he could come up with some combination that was not previously known but you will be asked -- we will present evidence to show that when he pulls this from here and puts it there, it does exactly the same thing here as it did over there, no new unexpected result. That is one of the key elements that would be part of our proof.

In the new instrument which would be derived from taking one small part from one device and putting it in another, which we will attempt to show, that this is a combination which functions in exactly -- I shouldn't say the word exactly, because it is the word that you used yesterday in your holdings, substantially in the same way substantially to accomplish the same result.

MR. SUTTON: Good morning.

The plaintiffs, while they don't carry the burden of proving the validity of the patent, will attempt to show you a great many things. They will attempt to show you that they purchased what was then and is today a valid patent which was issued in the Patent Office, not with a rubber stamp type of procedure but with an existing procedure of examination and consideration by an examiner in the Patent Office who does nothing else or, as far as

this specific task of his is concerned, but examine and pass upon the patentability of inventions in this particulr area. There are many examiners in the Patent Office. Some handle pumps, some handle toys, others handle lasers and television sets. The plaintiff will show you, so you will appreciate, why I am holding what is presumptively a valid patent in my hand, why this came to be issued by the Government. I want to show you why the plaintiffs relied upon what the Government did in issuing that. I would also like to show you that, yes, this patent and its invention, a toy musical instrument that produces a carillon sound, is far from the most important invention made during this century. It is a toy. If it was never made, maybe the history of civilized man would not be changed that much. It is not a light bulb or a phonograph. But I will attempt to show you that you don't have to come up with a light bulb and a phonograph to be granted a patent. You have to come up with some sort of an improvement which is considered to be an invention and novel by the man in the Patent Office passing judgment.

The plaintiffs will show you how that procedure works, and we will attempt to show you that in a little bit of detail.

Also I think something that is important to be

kept in mind is this claim is a combination of various elements. If you took one word such as a housing, it would be kind of hard to get a patent on a housing. There are housings and have been housings for hundreds of years. This claim is a combination of elements that work together to produce something that the inventor thought was new, and that the Patent Office agreed was new enough almost seventeen years ago to grant him that patent. We will show you that contrary to what has been said, and this is the drawing of the patent, the examiner in issuing and granting that patent that is the subject of this lawsuit had not only this drawing and the entire Bienengraber patent before him, it was not something that sat on the side of his desk and it was before him physically,that he didn't refer to; the plaintiffs will show you that he actually corresponded with the inventor's attorney and at first actually rejected the patent application and the claims as originally filed, because his first reaction was that taken by my opponent, it was not patented, the claims first presented were not patentable. The examiner not only had Bienengraber, and in some respects I am repeating what I said yesterday, but the examiner -- we were shown a prior art book here. What you were not told was that this prior art book contains at least ten out of the twenty patents shown here, at least

ten of these were in front of the examiner, were cited by the examiner and were considered. A number of these have key arrangements, a number of these have all kinds of expedients known to the art, and we will show you that the examiner knew what the state of the art was when he granted the patent that is the subject of this lawsuit.

We will show you that the inventor, Dr. Musser, came up with this thing. This was not a one-shot situation with Dr. Musser. I will be able to show you, I believe, that Dr. Musser actually patented between 70 and 80 different types of inventions, so that this was not something that was thought of as one idea in a lifetime. He got his patent and he sold it for $1,000. We will be able to show you, contrary to what you have been told, that the device, the Bell Organ was marketed. It was marketed. We will be able to show you that tens and tens of thousands were sold here, Great Britain, in South America. We will be able to show you that the Rockettes, believe it or not, had these things on Radio City Music Hall, it was in the Jackie Gleason show in nationwide television, on the Perry Como show. This was not something that sat in Dr. Musser's cellar and then sold to the plaintiffs. This was a commercial success, and we will be able to show you that.

We will also be able to show you that statements

by Dr. Musser in his deposition under oath were made after he sold the patent and no longer had any interest in the patent, or the outcome of this lawsuit, so that we will attempt to show you that he was credible when he was saying what he was saying. We will also attempt to show you that despite the arguments of the defendants about patentability and so forth, we will be able to show you that the defendants have attempted, and I believe have obtained, a patent of their own on this Big Mouth Singers item with respect to the heads, so that I want you to keep that in the back of your minds when we present evidence to that effect.

Finally, you are going to hear, I am sure, a lot of arguments concerning obviousness, that it was obvious to take a key and a tone bar and to go into this book of patents nearly seventeen years ago and take a linkage arrangement and pick from here and here and here. The question is why wasn't it done? Why wasn't it done by the defendants? Why did they go to the Orient to buy it? If it is so obvious and they wanted to produce a carillon sound why did they go to the Orient to buy the item? Why didn't somebody on their staff invent it?

I think the point I am trying to make is that we are here now in a courtroom fighting about the validity

of a patent. What is obvious to us today with all of these patents assembled in a book, and all of these charts and all the evidence today, nearly seventeen years later, may not have been quite so obvious to someone seventeen years ago coming up with a toy musical instrument producing a carillon sound, and you have heard both experts, Dr. Kern and Mr. Wuertemburg, say that they could not in this book find any device that produced a carillon sound, any toy musical instrument that produced a carillon sound.

That is all we have for our opening statement, and you will have to rely on the evidence.

THE COURT: I probably should caution the jury again, that the opening statements made by counsel are not evidence in the case. They are merely an indication of what counsel think the evidence will or will not show. The evidence again will come to you in the same form that it came to you in the first part of the trial, that is, testimony and exhibits, depositions and stipulations.

I want you to put out of your mind what counsel said they were going to prove when you come to deliberate. What counts at that time is what they did prove, not what they said they were going to prove. As a matter of fact, some of the things they said they were going to prove they may fully intend to prove and find when they try to introduce

the evidence that the Court rules that the evidence is inadmissible.

So base your decision on the evidence, and not on the hopeful predictions of counsel as to what the evidence will or will not show.

We will begin now with the defendants' opening case on the question of validity. Mr. Russell, call your first witness.

MR. RUSSELL: Dr. Kern, please.

F R E D R O B E R T K E R N , having been previously sworn, resumed the stand, and testified as follows:

MR. RUSSELL: I assume there is no need to repeat the qualifications?

THE COURT: No. I will instruct the jury that all the evidence introduced at the first part of the trial is still before you. It isn't necessary to repeat that same evidence all over again. So Dr. Kern has already explained his background and I hope you will recall what that was, and if Mr. Russell wishes, of course, in his summation he can refer not only to the present testimony but also to the previous testimony of this witness, and any other witness.

DIRECT EXAMINATION

BY MR. RUSSELL:

Q Now, Doctor, I would like to ask you several questions and to assume as I mentioned to the jury a few minutes ago that you are relying on the knowledge that you have of this book.

I assume from your previous testimony that you have read the patents in Exhibit B, the patent book?

A Yes, that is correct.

Q On the basis of using that as the scope of your knowledge, I want you to picture yourself as of 1957 sitting in your study, these patents are all there available and the drawings are on the wall, and you must regard yourself as being familiar with those patents.

Can you state for the jury from these patents what you see with respect to what I will call the design objective, perhaps I will look for a more common word, the fact that someone has attempted to scale down a piano and make a toy piano for a child which would be roughly the same size as the Musser device, Exhibit 3, is that something on the wall of your study that you see that someone has attempted to do prior to 1957?

A Yes, certainly. There are several examples.

Q Can you give some appropriate examples?

A Tab 2, for example, will show what appears to be a toy instrument.

Q I notice, Doctor, it does not say toy. How do you get the idea that is a toy?

A Basically from the number of keys that are involved. They are not an equivalent number to what would be on a normal piano. You can only play one octave on it.

Q Any other patents in this group?

A Tab 3, we see a device that is somewhat similar to the one shown in tab 2, but it is titled a toy piano, and again is a relatively simple device that looks similar to a piano. Tab 4 shows again a device that is literally called a toy piano.

Q May I stop you on tab 4, and put in front of you the Exhibit 3, Bell Organ.

Do you see in tab 4, that is the Colwell Patent, the little key support ledge sticking out from the front?

A Yes.

Q A little housing is more or less square?

A Yes.

Q I notice, Dr. Kern, the date of these patents, 1873, 1900, 1904. Would you state for the jury whether or not the objective of scaling the piano down to toy size was an ancient objective or whether or not it was an

objective which had been solved previously to 1957?

A Yes, clearly. 1904 is well before 1957.

Q Have you studied the file prosecution of this patent in the Patent Office, sir?

A Yes, I have.

Q Can you state to the jury whether or not these three references were listed by the examiner as being references that were before his consideration?

A No, they were not cited.

Q Doctor, among these alternatives that you got up here in the wall before you, things that you could use, I notice, for instance, one thing we had in the first part of the case which is of quite importance, that the tone bar was resiliently attached to each of the keys, are you familiar in this group, actually the book that we have here, Exhibit B, and the group of patents I have pasted on your study wall, any references where you had the tone bar mounted directly on the key?

A Yes.

Q Will you point that one out to the jury, please?

A Yes, reference in tab 20.

Q What figure?

A Figure 20.

Q What does that patent say about where the tone

bar could be placed?

A In several places in the patent, including the introduction, the description of the figures and in the claims themselves there is mention made of the fact that the tone bar could be attached either to the housing or to the key.

MR. RUSSELL: Your Honor, we have had a clerical error on this. We have a Berlitz translation of tab 20, which was inadvertently omitted from the book. It has not caused us any trouble, because we could understand the drawing just looking at it. But last night we went to look for the exact wording and found out that the translation had been left out.

THE COURT: The translation is in my book. Right at the end, the last thing in the book.

MR. RUSSELL: If anyone wishes to have the translation we will get it.

THE COURT: The last thing in the book, there should be an English translation of the Belgium patent.

MR. RUSSELL: The clerical error was only in my own and Dr. Kern's.

THE COURT: How many members of the jury have the translation? All except the Forelady has it.

Well, she has it too. They all have it.

Q Now, Doctor, among these patents that are up in front of you, will you state what the possible ways that come to your mind from this knowledge you have in front of you for making the noise, sound producing elements? Just briefly describe the possibilities that you have in front of you.

A I have several choices in the various patents. Some of them are tone bars that are struck percussively, some of them are vibrating elements that are picked up, the vibration is picked up and amplified electronically and played with speakers, and there is also an indication of a device that will produce a carillon sound by repeatedly striking the tone bar.

Q Would you illustrate, for instance, in tab 4 for the jury the possibility of a percussive striking of a tone bar?

A Tab 4, figure 1, the bar in the upper part of the housing labeled M is a tone producing type bar, and it is struck by a percussive instrument I that is actuated by basically the key mechanism C. When C is pressed down, the percussive element I mounted on a bar which appears to be Q is deflected up into contact with M, creating a sound.

Q Doctor, you mentioned a carillon element for producing carillon tone. Which tab are you referring to

for that?

A That would be tab 19.

Q That would be the Bienengraber that we talked about so much before?

A Yes, that is correct.

Q Do I understand from that carillon sound that you have little washers that are on the rotating member that strike the bar?

A Yes, repeated striking.

Q Isn't it a fact that you also have here a percussive effect, a little hammer strikes the bar?

A Yes, that is true. The carillon sound was basically described as a repeated striking, but again it is a percussive type instrument.

Q You have been given the objective of making a toy instrument that is going to not just create one strike, but to have a repeated striking, carillon sound -- let me backtrack. If you had been given the objective to make a toy instrument that has an element which strikes a tone bar and you have the possibility of making one which has a repeating and coming out with a carillon tune, or the other alternative which is just a single element, will you speak to the jury on the subject of the expense involved between the two choices?

A Generally speaking, expense goes up as the complexity and number of elements in a given device would go up. The simplest device would be the device where you had a tone bar and it was basically struck by a single element, and it would be struck once. In increasing complexity you have the situation where you would have a motor or in the example of Bienengraber a treadle that would rotate a series of elements that would repeatedly strike, and that would clearly be more expensive to produce than would the items shown in tab 4, for example.

Q Back again to your study in the pre 1957 period, and someone comes in and says all right, that carillon producing is more complex and more expensive, as you testified, but I think we could have that made in Hong Kong at a pretty cheap price. So now would you design for me and build for me, using nothing but what you have there in front of you, a toy instrument that is going to produce a carillon sound for the child? Would you now describe for the jury what you would do with these design alternatives in front of you?

A Starting with a toy piano shaped device such as is shown in tab 4, where we have a series of keys and a series of tone producing elements, if I wanted the carillon sound the first logical thing to do would be to remove the

elements that presently produce the sound. That would be the single striking element for key I, and the tone bars M.

MR. RUSSELL: I would like to offer for identification Defendants Exhibit F.

(Defendant Exhibit F marked for identification.)

Q What does Defendant Exhibit F illustrate?

A Exhibit F illustrates outer structure and the key shown in Figure 1 of tab 4 with the sound producing mechanism eliminated.

MR. RUSSELL: I offer Exhibit F, your Honor.

MR. SUTTON: No objection.

(Defendant Exhibit F received in evidence.)

THE COURT: You are only interested in Figure 1 of Exhibit F, I assume?

MR. RUSSELL: Yes, your Honor.

Q Now, Dr. Kern, what would you do to carry out the remaining part of my instruction to you as to using only the knowledge that you have got here in the book to produce your carillon sound?

A The next thing I would do would be to take the carillon sound producing mechanism that is shown in Bienengraber and mount it over the keys.

MR. RUSSELL: I offer Exhibit G.

(Defendant Exhibit G marked for identification.)

Q What does Exhibit G illustrate, Doctor?

A Exhibit G illustrates the inclusion of one of the tone bars and the striking element mechanism which was physically cut out of a copy of the Bienengraber patent and laid down in a respective position as shown in Exhibit G, so that when the key C is depressed the tone bar will be moved into a playing position and actuated by the rotating washers, and this would produce the carillon sound desired.

Q What other changes have you made?

As I understand your testimony, you made a simple clip-out of a portion of the Bienengraber patent without any change at all in its dimensions?

A Yes, that is correct. If you compare the size of the structure shown in the Bienengraber patent and the size of the structure shown in the tab 4, both of them being within your book so they are basically the same scale, then you find that the housings are approximately the same size so it was not necessary to do anything except cut out the one on the 8 1/2 by 11 size piece and to lay it into the position shown.

MR. SUTTON: If I may, your Honor, perhaps the

form of the question, the form of the answer is what I object to. I think it should be emphasized here --

THE COURT: Don't make an argument. You can make an objection.

MR. SUTTON: I make an objection because statements are being made about the size of these two items.

THE COURT: I will instruct the jury that the testimony of the witness should not be construed as meaning that the size of the device shown in Bienengraber is at the same scale as that of the device shown in the Colwell patent, tab 4.

It only means that the illustration of that device in the Bienengraber patent, tab 19, makes it possible to cut out a part of that illustration and superimpose it on the illustration of the device in the Colwell patent.

Q Doctor, does it illustrate what would be a possible design choice for you from the knowledge you have in front of you here in 1957?

A Yes. It is clearly a simple choice, taking one element from one and adding it to the other.

Q I would like you now, looking at Exhibit G, to state for the jury whether that combination does the same job in the context of a toy as the Musser device, Exhibit 3?

A Yes, it does the same job.

Q Does it do it in substantially the same way to achieve the same result?

A Based on the finding of the jury yesterday as to what the width of doing the same job in substantially the same way, yes, clearly. You depress the key and the tone bars are moved into playing position.

Q I notice in Colwell, that the key, however, is not mounted on upstanding projections fitting into slots, dimension slots at the bottom of the key. And we all know that that is in the Musser patent.

Will you comment on that?

A That was, as I understand, one of the findings of the jury, that whether or not you mount the key on a rod or whether you mount it on projections as was done in the Musser patent, both devices are considered to do the same job in substantially the same way to achieve the same result.

Q I notice also, Doctor, that in Exhibit G the tone bar isn't connected directly to the key. The key goes in and pushes against an end of the tone bar.

Will you comment on that distinction because, as we know in Musser, the tone bar is resiliently attached to the key.

A Again, yesterday the jury's finding was that in

the case of the Melody Bell-O-Phone that the key could be separated from the arm that carried the tone bar, and it was still considered to do essentially the same work in substantially the same way to achieve the same result.

(Defendant Exhibit H marked for identification.)

Q Will you describe for the record and for the jury what Exhibit H shows?

A Exhibit H was again derived from tab 4 by first removing the tone producing mechanisms shown in tab 4 and placing the tone bar and the resilient mounts and the rotating washer mechanism from the Biengraber patent directly onto the key that is shown as number C, tab 4, so that I obtained in this case a tone bar mounted resiliently with the mechanism taught by Bienengraber to the key.

Q Doctor, if when you put this thing together you found that the key in moving downwardly to the key support stop B caused the bar to move too closely to the striking element, what would you do, using knowledge as of 1957?

A I would have probably increased the thickness of the stop which is indicated as B in figure 4, so that the key would not go down quite so far, or I would have changed the position of the tone producing mechanism and the tone bar to move it closer to the fulcrum point so that there

would not be as much motion. So that would be an engineering choice, and you would choose a device that would move the tone bar into the correct position as was taught basically by Bienengraber, who had a mechanism that did that.

Q Coming back to Exhibit G, which is the combined one showing Bienengraber, could you state for the jury whether the key in this combined one G is performing a function which it was not performing before the change? State what the function of the key is in tab 4, and Exhibit G.

A The function performed by the key in tab 4 was to actuate a hammer mechanism I, the percussive mechanism and to move it into contact with the tone bar M, to produce a tone. In the Model G that we have here, Exhibit G, you press the key C and it moves the tone bar to the point where it is struck by the percussive washers.

Q Will you state for the Court whether or not the moving of the key to produce the tone in either tab 2 of Exhibit B or Exhibit G produces a surprising result, a result -- first say a surprising result to anyone as of 1957 having this knowledge?

A No, it would not be surprising. It would be the exact intended purpose.

Q Would it produce a new result that was not accomplished before? In other words, in Bienengraber it made a noise when it moved into contact with the rotating washer. Now in Exhibit G is there some new result because it moves into contact with the rotating washer?

MR. SUTTON: I merely want to object to the form of what I consider to be leading type of questions, since this is the defendant's own witness.

THE COURT: Objection sustained.

Q In Exhibit G, Doctor, can you point to a function with respect to the production of sound in the context of Exhibit G which was not performed in the context of tab 19 of Exhibit B?

A No, there is no difference.

Q Doctor, in Exhibit B, tab 4, the key goes through a housing -- through an elongated slot in the front of the housing. Can you point to a change in the function of that elongated housing brought about by inserting a different sound producing element as in Exhibit G?

A No, I don't believe there is any change.

Q Between the tab 2, Exhibit B which is the Colwell reference, and the reference showing the insertion of the change in the tone producing element, have you brought about any difference in function with respect to

the support of the keys?

A No, the key is supported in substantially the same way, identically the same way in either case. There is no difference.

Q Will you state your opinion, sir, with respect to whether or not the change you have performed between tab 4 of Exhibit B and Exhibit G is or is not anything more than a routine use of the design choices you had available in front of you in your study in 1957?

MR. SUTTON: I object, only insofar as there being a design change. We are working with illustrations that are being interchanged and superimposed, and as long as the record reflects that fact as far as this question is concerned I have no objection to the question, but I think the form is such that it implies that there has been a design change, when it has been a superimposition of some figures of drawings on other figures of drawings.

THE COURT: I don't think that is an objection to the question. I am sure you have misstated the intent of the question. The question is not whether it would have been routine to clip out part of one patent drawing and place it on another, but whether it would have been routine to make the design change that is reflected by that superimposition.

MR. SUTTON: If that is clear, I have no objection.

MR. RUSSELL: His opinion on that.

Q Would you so state your opinion on the routine nature of making the drawing changes?

A Yes, with these patents in front of me, it would have been a reasonably routine thing to do if I was given the objective to produce a carillon sound in the toy instrument.

Q When you got through with it, can you state for the Court what you would have felt with respect to whether you had made a significant contribution to knowledge of the art?

A I think it would have been simply an application of the various pieces that I had in front of me in a way that came up with the obviously desired result. I don't think that would be an inventive type of contribution.

Q Can you state whether or not it would have been an obvious thing to you having been given this objective of making a toy box with a carillon sound? That is, to do what is in Exhibit G.

A That is about the most obvious thing I could think of doing with my objective.

Q Can you now state, Dr. Kern, whether the device

shown in Exhibit G meets the claim which we have in suit, and we will deal only with claim one, and in giving your answers I want you to employ the standard with respect to Exhibit G and variations between the equivalence which has been set yesterday by the verdict of the jury. Can you state whether you have a toy musical instrument of the class described in the Musser patent?

A Yes.

Q Does it include a housing in the front side formed with an elongated slot therein?

A Yes, it does. That would be in the vicinity of what is labeled F.

Q The key support ledge attached to the front side of said housing, so as to project parallel, generally parallel to said slot?

A Yes, that owuld be shown as B on Exhibit G.

Q A plurality of projections capable of serving as fulcrums mounted on said housing adjacent to said slot so as to project upwardly from the lower edge thereof?

A Here I find the equivalent rod that supports the key.

Q As in the accused devices?

A Yes.

Q A support member positioned within the housing

so as to project generally parallel to said slot?

A Yes, I believe the item labeled B toward the back side would be performing that function.

Q A plurality of keys?

A Yes.

Q Each having a top and a bottom and a recess located in the bottom thereof positioned so as to project through said slot into said housing with each of said recesses receiving one of said projections?

A Here I would find again the equivalent as shown in the accused structures yesterday.

Q Said keys being supported in a normal position by said projections. What position have we got in Exhibit G?

A In Exhibit G we have the non-playing position, that would be in its normal position, and would be supported by the back member B.

Q Support member located within said housing. Said keys being capable of being engaged on the outside of said housing so as to be pushed into engagement with said key support ledge so as to rotate said keys about said projections to a playing position?

A Yes, that can clearly be done, key C would be pressed down into the key support ledge to the left side of the figure which is labeled B.

Q How would you obtain the correct position of the element, the ledge?

A As I said before, that would depend on the exact scaling that one does when one takes a device from Bienengraber and installs it into this toy piano. You might have to increase the thickness if the tone bar would tend otherwise to go further than necessary to strike the tone bars, or would tend to stop -- so the tone bars couldn't go too far into the rotating washer and tend to stop the tone bar striking mechanism.

Q Tone bar resiliently attached to each of said keys so as to be moved to a playing position when said keys are moved to a playing position. Do you have that in Exhibit G?

A In Exhibit G we have what was determined yesterday to be equivalent to that, and in Exhibit F we have something that would be basically identical. I think it is H.

Q A shaft rotatably mounted within said housing above said tone bars. Do you have that in Exhibit G?

A You have what is basically an equivalent of G on that, a support shown in Bienengraber and in H you have the rotating mechanism actually mounted over the tone bar.

Q That is not the right element. The shaft

rotated and mounted in the housing above said tone bars. You have to keep reading that one, because the shaft is the thing that carries the arms and the strikers.

MR. SUTTON: I object, your Honor. I would like to hear this from the witness and not confirmation from the witness as to what counsel is saying.

MR. RUSSELL: I should start it over again.

Q With respect to the next elements I will read the thing through, so the entire context can be obtained. A shaft rotatably mounted within said housing above said tone bars, said shaft being generally parallel to said slot means operatively associated with said shaft and mounted in said housing for rotating said shaft. A plurality of arms attached to said shaft so as to project therefrom. Each of said arms being located generally above one of said tone bars, means operatively associated with each of said arms for periodically striking one of said tone bars when said keys are actuated so as to rotate about said projections in a playing position.

I would ask you in Exhibit H, which is the item that has the tone bar mounted directly on the key, to state for the jury where the shaft which is rotatably mounted is.

A That is above the tone bar.

Q Would that shaft be generally parallel to the

slot?

A Yes, that is the way it was installed in Bienengraber, and that is what I would do here also.

Q In Exhibit G in the Bienengraber, can you see from there what the letter is for the shaft?

A I believe it is labeled C.

Q Means operatively associated with the shaft and mounted in the housing for rotating said shaft. State whether that means is in Bienengraber, which would be tab 19.

A Yes, it is shown there as the line coming in and going up around what is not shown clearly as a form of a pulley and that rotates the shaft C with the washers attached to it.

Q A plurality of arms attached to said shaft so as to project therefrom. Can you point to those arms in the Bienengraber?

A I don't have a terribly clear copy of that particular aspect as to what the arms are actually labeled as. I don't think the arms are actually labeled. They connect the washers D to the Shaft C.

Q What element? Can you come over here and point to the jury what element would correspond to the arms?

A Yes. The element that would correspond to the arms is this piece like out from the center C, and the

position where it basically holds on to the washer -- I am not convinced as to whether the E right here refers to the pulley around which the line goes, or whether it is actually pointed at the arms. There certainly is an arm here. That arm is duplicated in either G or H. That is in sub-scale form, of course.

Q The round hammers D which move on the axle C lie with measured holes on the rods E and are able to move radially so that the hammers,depending on the speed of revolution,can move more or less outwardly through centrifugal force.

The next element in the claims is a plurality of arms. Each of said arms being located generally above one of said tone bars. Would you now point to the jury in Exhibit H?

A Here in Exhibit H we see the mechanism mounted over a tone bar exactly the way it is stated in the claim.

Q And the final element of the claim is, means operatively associated with each of said arms for periodically striking one of said tone bars when said keys are actuated so as to rotate about said projections to a playing position.

A The means associated with the arms are the washers in this case which would be taken directly from the

Bienengraber, and when the keys are pressed down the tone bar would move up into position so the tone bar would strike.

THE COURT: Let's take our morning break now, ten minutes.

(The jury left the courtroom.)

(Recess.)

(In open court. Jury present.)

Q Doctor, with respect to the testimony we have just been through, we have been referring to claim one in both Exhibit G and Exhibit H. H is the one that has the tone bar mounted directly on the key.

Will you state for thejury with respect to all of the elements of the claim, not only individually but acting in concert in the manner intended in claim one, whether you see in Exhibit H all of those elements as so acting?

A Yes.

Q To keep the record clear, do you see all of those elements in Exhibit G acting in substantially the same way?

A Yes, I do.

MR. RUSSELL: No further questions.

THE COURT: Mr. Sutton.

CROSS EXAMINATION

BY MR. SUTTON:

Q Dr. Kern, my first question concerns the three exhibits, Defendant Exhibits F, G and H, that were referred to, all of which represent illustrations based upon the Colwell Patent, index number 4. Who physically made the drawings or modifications of the drawings that make up Defendant Exhibits F, G and H?

A The attorney Russell made them under my supervision.

Q You worked together with Attorney Russell in coming up with these exhibits, is that correct?

A That is correct.

Q Was this done since the verdict yesterday?

A Yes.

Q You were portrayed as sitting in a room as an expert seventeen years ago, or nearly seventeen years ago, with the information in front of you that you know today. Do you remember being asked that and setting that stage?

A It was with the information in this book.

Q Not with the other information, okay.

When you came up with the modifications of the illustrations last night, was your knowledge limited to the information in this book, or in fact weren't you present at

the trial and questioned with regard to the drawings of the very patent in suit?

A I had knowledge of the patent in suit, but I didn't use it when I made this combination.

Q Had you read it before you even came in to this courtroom, the patent in suit?

A Sure.

Q Did you look at the drawings?

A Yes.

Q I refer you to Defendant Exhibit H. Do you have a copy of that before you?

A No, I know what it looks like.

Q Is there a similarity between Defendant Exhibit H in terms of a key, a tone bar and some sort of a striking mechanism above the tone bar, a similarity between Defendant Exhibit H and let's say figures 1 and 3 of the drawing that you had seen before you got involved here testifying?

A Could you repeat the last part of the question, please.

Q Perhaps I ought to give this to you, so you can see it.

A Part of the question.

THE COURT: He wants to know whether there is a

similarity between the structure shown in Exhibit H and the structure shown in the Musser patent.

THE WITNESS: Is there a similarity between the two?

Q Yes.

A Yes.

Q Is it your testimony based on the records that you have reviewed in preparing for this trial that the examiner in the Patent Office did not have a toy piano structure before him in the form of a patent when he allowed the application that resulted in the patent in suit?

A No.

Q In fact, if you will refer to your book of patents, take a look at tab number 9, and I refer you to the second page of the drawings, figure 2. Do you see a key going through an opening?

A Yes.

Q Would you take a look at the last page of the patent, and I invite the jury's attention to the last page of the patent, column 6. Do you see the marks "Patent reflected by tab number 9 listed as one of the cited references?" The second item down.

A That is correct.

Q The examiner didn't have Colwell in front of

him, did he, tab number 4, is that correct?

A Yes.

Q He did have number 9 before him. Would you please turn to tab number 16, do you see the Duncan toy piano patent?

A Yes, I do.

Q I ask you once again to refer to the patent that is the subject of this lawsuit, and I ask you whether that patent was before the examiner?

A Yes, it was.

Q Do you see some sort of a key arrangement or keyboard arrangement there?

A Yes.

Q With the keys extending through some sort of opening into the internal housing?

A Yes.

Q In coming up with these designs, or what you have testified as being obvious modifications, were you given a patent book and told come up with a device for producing a carillon sound, and therefore you arrived at any one of Defendant's Exhibits F, G and H? Or did you have more information before you such as in the form of the patent that I just referred to?

A At that particular time I did not have the

patent before me, no, I just looked through the book.

Q When I say before you, you mean physically before you you did not have a patent?

A I didn't have it physically before me and --

Q You had read the patent at that time?

A Sure, I read the patent.

MR. RUSSELL: If your Honor please, I think the witness was not allowed to answer his question.

THE COURT: Did you want to add something there?

THE WITNESS: I was going to say that I was not using the teaching of the patent when I went through the book. I used the teachings only of the patents cited in this book.

Q This was last evening?

A I had to do the hypothetical question of is the information in this book disregarding the additional teachings that are made in the patent in suit.

Q Were these designs developed in their entirety last evening?

A The concept for them was done last evening. Some of the cutting was done this morning.

Q Were they done prior to the commencement of the first part of the trial in this matter?

A No.

Q My memory fails me whether it was yours or Mr. Wuertemburg's, did you say that you had obtained a patent yourself? Have you obtained any patents in your own name?

A No.

Q You have not.

Is it fair to say that the ability that you and Mr. Russell had in making up defendant's Exhibit F, G and H by cutting and pasting, I take it, is that fair to say?

A Yes.

Q And photocopying what was cut and pasted?

A Yes.

Q Were you able to do that by coincidence because the sizes of the drawings happen to be approximately the right size?

A Yes, that is true.

Q Do you know whether you would have been able to take the size of the key, let's take the key of the Colwell patent, which is tab number 4, and appears also in modified form on Defendant's Exhibits F, G and H, if you took the key and put it -- first of all, do you know if there ever was a Colwell device marketed, you of your own knowledge?

A No.

Q Do you have any idea what the size of that key would have been?

A I have an idea in general how big it would be. It would be about three quarters of an inch to an inch wide, and I would estimate it to be approximately five to seven inches long.

Q That is based on the fact that the title is a toy piano, is that correct?

A That is right.

Q If you took that key would you have been able to interchange the key within the life sized Bienengraber device, Defendant Exhibit C 3, I believe, apart from modifying the size and making other modifications, would that key have worked in the Bienengraber device?

MR. RUSSELL: The question is objectionable on the grounds that it is confusing to the extent of other modifications. I can't understand what the modifications might be, and I don't see how the witness can answer a hypothetical question with so many modifications.

MR. SUTTON: I will withdraw it and try again.

Q Do you know of your own knowledge whether any parts of the Colwell design would be interchangeable without modification with the Bienengraber device?

A Never having actually seen the Bienengraber device, I don't know what size it would be. I don't know that it could be. I also don't know that it could not be.

Q Have you during your experience performed a design function or have design responsibilities as a graduate engineer?

A Among other things, yes.

Q Can you tell us what types of items you have designed?

A I have designed test facilities and sporting goods equipment, and laboratories and trial seating systems for automobiles, small tubular structures for children.

Q Were any patents pursued on any of those designs, to your knowledge?

A Yes.

Q About how many would you guess, without the exact number?

A I know of specifically one to which I am a party.

Q Can you tell us what item that is?

A That is a sporting device.

Q What type of sporting device?

A A sail to be used in conjunction with ice skates or roller skates to propel a person around.

Q Please speak up. A sail?

A Yes.

Q Does it have sail cloth or some sort of flexible

material to act as a sailing surface?

A Yes, it does.

Q Prior to your coming up with this development, did sail cloth exist?

A Yes

Q Is there a support for the sail cloth in your device?

A Yes.

Q Did there exist prior to your developing this item and pursuing patent protection some sort of a support for a sail?

A Sure.

Q There were other features, I take it, in addition that are incorporated in your design, is that correct?

A Yes.

Q There are other structures for example?

A Yes.

Q Are there at least one other portion of that particular structure without going into the detail that existed in some form in the prior art at the time that you developed this, either alone or with someone else?

A Yes, certainly.

Q So you combined a number of known items. Is it

fair to say that the combination that you came up with produced what you felt to be an unobvious result, or something new?

A Yes.

Q If you look at that patent book, there are many housings shown, are there not?

A Yes.

Q There are tone bars shown, are there not?

A Yes.

Q There are keys shown, are there not?

A Yes.

Q The keys are meant to be pressed, are they not?

A Yes.

Q Musical tones are produced, are they not?

A Yes.

Q Some of them are toy musical instruments. Many of the keys are pivoted, are they not, some sort of fulcrum whether it be projections or a rod, is that fair to say?

A Yes, certainly.

Q Do you know whether the defendants in this action utilized the procedure that you have utilized here, the cutting and pasting design modification procedure to arrive at F, G and H, Defendants Exhibits F, G and H, whether those procedures were used to arrive at the accused

devices, the Big Mouth Singers, the Melody Bell-O-Phone, the two types of Melody Bell-O-Phone, do you know of your own personal knowledge?

A No, I don't know.

Q Do you know where these items were designed, or who designed them?

A No.

Q When you made your design that you are pursuing patent protection on, has the patent issued or are you pursuing it at this time?

A We are pursuing it.

Q Did you have a patent attorney as a co-designer and co-developer with you?

A I wouldn't say so, no.

Q Did you use a cutting and pasting arrangement similar to the type you and Mr. Russell used last night, or was it more of a theoretical --

A Simply we actually built various pieces of hardware and tested them out to see how they worked with each other in that particular instance.

Q Do you believe that the protection, the patent protection -- do you believe that you have a new item that is novel enough for patent protection in the item that you have designed yourself?

THE COURT: I think we have pursued this far enough. I am going to instruct the jury in my charge that the mere fact that all of the elements of the claimed combination are individually old does not mean that the combination of those items is not patentable. But there is no connection at all between his effort to get a patent on one combination and the effort of Dr. Musser to get a patent on a combination of entirely different elements.

MR. SUTTON: All right.

THE COURT: One may be patentable and the other unpatentable.

MR. SUTTON: I have no further questions of this witness then, your Honor.

MR. RUSSELL: Your Honor, I think that the question of Dr. Kern looking at a combination of previous elements and possibly finding something patentable in it merits a further question, and that is whether he felt upon looking at the combination he felt he had invented, and then looking at the prior art, he was able to see what he felt was an obvious and simple combination of prior known elements.

THE COURT: Are you talking about his invention or Dr. Musser's invention?

MR. RUSSELL: I was thinking about his own. In this case my brother has brought it up.

THE COURT: I am going to instruct the jury to disregard entirely the testimony about this witness having applied for a patent on a combination of elements embodied in a sail for roller skates or ice skates. That has nothing whatever to do with any of the issues in this case. I was anxiously awaiting an objection from opposing counsel about the irrelevance of that line of examination, and when it was not forthcoming I finally took the initiative. That has nothing to do with the issues in this case.

REDIRECT EXAMINATION

BY MR. RUSSELL:

Q Doctor, counsel asked you about the possibility of taking Colwell and putting it into Bienengraber. I want to know from you, were you asked at any time in our discussions of this case to analyze the question of scaling Colwell's toy piano up to make it a full size piano?

A No.

Q In looking over the prior toy piano switch, counsel pointed out to you there were two of them, tabs 9 and 16, and comparing it to tab 2, which is Colwell --

A I believe Colwell is 4.

Q I stand corrected, Colwell is 4.

Could you state for the Court and the jury whether the examiner had before him a reference into which

the sound element of Bienengraber could be so readily and simply inserted as in Exhibits G and H?

A I don't think it would be quite as simple. There are additional mechanisms and functions to the key shown in number 9, because it was also operating another device which would have to have been taken out. Was the other tab 16?

Q Yes.

A 16 just provided a smaller case, so that it would not be obvious that the elements would fit into it.

MR. RUSSELL: No further questions.

THE COURT: Thank you, Doctor.

(Witness excused.)

THE COURT: Call your next witness.

MR. RUSSELL: Mr. Wuertemburg.

C H A R L E S W. W U E R T E M B U R G, having been previously sworn, resumed the stand, and testified as follows:

DIRECT EXAMINATION

BY MR. RUSSELL:

Q Mr. Wuertemburg, you have been in the courtroom this morning, haven't you, hearing the discussions and testimony?

A Yes, I have.

Q And you heard my setting of my previous questions of a man being or having before him various prior art references and being given an objective of a design change. I would like you to state whether that is a familiar picture to you that I have described?

A Yes, I worked within that scenario many times.

Q Would you describe that, please. What do you mean by worked with that scenario?

A In many of the toy companies that I have worked for, quite often I would get an assignment as a toy designer to investigate a particular line of product and so it would be up to me to find the toy companies' current products that fall within that line, find the competitors' products that also fall within that line, and just take them apart, spread them out in front of me and start looking at how the current state of/art is, past state of the art, and how it can be improved on to come up with various new products.

Q You work only with devices? Did you work sometimes with drawings and documents?

A Absolutely.

Q Patents as well?

A Patents as well as devices.

Q So that the idea of a man sitting in his study with ideas pasted on the wall or drawings pasted on the wall

with you is not a farfetched hypothetical?

A No, during the new designing season of toys it occurs about from June on and we have meetings like this monthly.

Q Focusing your attention, Mr. Wuertemburg, on Exhibit B, and trying to imagine yourself just with that knowledge, again it is important in this particular question that you try to limit yourself to the four corners of the book of Exhibit B and not to include things that might have been developed and shown subsequently --

MR. SUTTON: May counsel approach the bench, your Honor?

THE COURT: All right.

(At the side bar.)

MR. SUTTON: I am compelled to ask whether we are going to have two experts on the same issue?

MR. RUSSELL: Yes.

THE COURT: On the same issue, the same testimony?

MR. RUSSELL: It is from a different standpoint, your Honor, of a man that is practical, skilled in the art.

MR. SUTTON: I thought we were going to limit ourselves --

THE COURT: We are not going to cover any of

the same ground covered before by the other witness. If you want to ask him the conclusion about whether taking these things that are before him it would be obvious to a person skilled in the art or would have been obvious in 1957, you may do that. But let's don't go through these patents again with this witness.

MR. RUSSELL: Your Honor, I feel that it is the impression of the jury, the outcome is rather obvious and I do need to establish my record, your Honor.

MR. SUTTON: It is for that purpose that I am objecting.

THE COURT: You knew in advance, I was going to permit only one witness on one subject matter. You made your election with the previous witness as to all the subject matter on which he testified. If you want to cover any other ground with this witness you may do so, but I made it clear in advance we were not going to have a contest to see how many witnesses each side could call.

MR. RUSSELL: I find myself at a great disadvantage, your Honor, if I can't put it in from two different points of view, the practical man who knows just what a man does and the other fellow who would say what a fellow skilled in the art would do.

THE COURT: I will permit you to ask him the

question as to whether it would have been obvious to a person having skill in the art because the other man didn't so testify and he was not a man skilled in the art. But to have him go through these same prior patents again and state what is in those prior patents is repetitive, and it is an imposition on the jury and the Court. I am not going to permit it.

MR. SUTTON: We won't put on an expert, so you won't be at a disadvantage.

MR. RUSSELL: I do have to have my record, which includes the practical matter. Why don't I go ahead on the basis of the broad questions that you found, your Honor, and if I start to encroach on the details I will stop and I will make an offer of proof.

THE COURT: I will consider your now making an offer of proof that you are going through this witness to say the same things and I am excluding that proof.

MR. RUSSELL: Very well, thank you. But I will still make any broad questions.

(In open court.)

Q Mr. Wuertenburg, I would like to ask you whether you have examined Exhibits F, G and H. I will show you copies of them.

A Yes, I have.

Q Do you understand what is involved in the substitution of self producing elements we have made in the Colwell patent?

A Yes, I do.

Q In view of the knowledge contained in the book, Exhibit B, and only that knowledge, not your subsequent knowledge, will you state whether a man skilled in the art as of 1957 would or would not have considered such a substitution as obvious to such a man skilled in the art?

A Yes, a substitution is obvious, given that he was looking for a particular type of sound, that is the carillon sound.

Q Will you state your opinion with respect to whether such a change would have been an unusual or a routine use of prior design alternatives?

A It would be a routine choice of design alternatives. It certainly would not have been limited to these two. There would have been several others. These would have been among the first that would have been thought of.

Q Do you see from the point of view of a man skilled in the art as of 1957 in Exhibits G and H any function of the components which they are doing in combination in Exhibit G and H which they did not do in

their prior context?

A By prior context, if you mean off of the carillon sounding from Bienengraber, there is no difference, if you are talking about the toy piano there is a difference.

Q What is the difference in the toy piano?

A The toy piano is a non-carillon sound and it now contains a carillon sound.

Q Is there any difference in carillon sound from Bienengraber --

THE COURT: You are referring to carillon as if it has an I after the L. It has been called carillon up to now.

MR. RUSSELL: I am sorry. He means carillon sound.

THE WITNESS: Correct.

Is there any other difference --

Q Is there any other change?

A No, there is no other change.

MR. RUSSELL: No further questions.

CROSS EXAMINATION

BY MR. SUTTON:

Q When did you first see Defendants Exhibits F, G and H before you now?

A This morning at nine o'clock.

Q Can you tell me, you have indicated that in the past, as part of your responsibility, you have done what you have referred to as a state of the art type of study?

A Correct.

Q Where you would have spread on a table before you representative examples of the art in which you were involved at the time?

A As much as we could discover, yes.

Q Do you know whether there was -- you work for the defendant Child Guidance Products Division of the parent Questor Corporation, is that correct?

A Correct.

Q Do you know of your own knowledge whether any state of the art study of this art was done prior to your company's marketing any of the accused devices?

A I have no knowledge whether it was done or not done.

MR. SUTTON: I have no further questions.

THE COURT: Any redirect?

MR. RUSSELL: No redirect, your Honor.

THE COURT: Thank you, Mr. Wuertemburg.

(Witness excused.)

THE COURT: Do the defendants have any further evidence on the issue of validity?

MR. RUSSELL: There is a problem. I would like to approach the bench briefly.

(At the side bar.)

MR. RUSSELL: The fact that Musser knew about Bienengraber beforehand and another fact relating to what he emphasized in terms of getting his patent all in the record to date, I want to re-emphasize that to the jury --

THE COURT: That is the function of your summation.

MR. RUSSELL: Thank you.

(In open court.)

THE COURT: Do the defendants rest?

MR. RUSSELL: Yes, your Honor.

THE COURT: Mr. Sutton.

MR. SUTTON: Other than the cross examination we have done of the defendants' witnesses, the only evidence that the plaintiffs will put in will be documentary evidence and evidence in the form of the testimony taken of witnesses depositions.

Firstly, your Honor, I offer into evidence a copy of a U. S. Department of Commerce publication entitled General Information Concerning Patents, as plaintiffs Exhibit number 9.

MR. RUSSELL: If your Honor please, I think

that this proposed exhibit is in the area of the type of thing your Honor will instruct the jury. I don't think that putting in by the circuitous route instructions on patent law is proper.

THE COURT: I don't think this is being offered for its content with respect to the patent law so much as procedure in obtaining patents, I assume?

MR. SUTTON: Yes.

THE COURT: I think it is probably the quickest way to get that kind of information into the record.

MR. RUSSELL: I think, your Honor, that statements in this book are bound to be statements of law. It can hardly be anything but. I think if the evidence on procedure is necessary there has been evidence already on how you apply for a patent, what you do, you see the examiner and get applications from him, etcetera.

THE COURT: There has been very little evidence. The file wrapper is in evidence as a specific example of what was done in one particular instance, and in my opening remarks I did tell the jury a little bit about the procedure for obtaining a patent. But I think it is not inappropriate to put this patent book in, in case Mr. Sutton in his summation wants to pick out some part of it as a layman's explanation of the procedure of getting the patent,

and I will instruct the jury that this patent is intended for laymen only and it is not necessarily complete or even technically accurate in every detail.

MR. SUTTON: If I may, for that purpose I had made copies to distribute to the jury. Perhaps in case there is an area of law that could be covered I will be happy to read from the copy as opposed --

MR. RUSSELL: That is precisely the area I think is improper to put in. I would not mind if he refers only to the method of obtaining patents and only to the workings of the Patent Office, and everything but when he gets in to saying what is patentable -- anything in the area of law, I object to it.

THE COURT: It won't be put in for that purpose. As a matter of fact, I would suggest this, Mr. Sutton, that instead of offering the entire pamphlet at this time you read the portions that you are interested in and we can make specific rulings on their admissibility or non-admissibility.

MR. RUSSELL: Would that then be out of the hearing of the jury?

THE COURT: Are there going to be a large number of these?

MR. SUTTON: Not that many.

THE COURT: Suppose you hand up the book to me and call my attention to the pages and I will rule on them, and you can object to anything you want to.

Suppose you take the copy that is marked, you read it and make any objection you want to and I will read the ones that you want to object to.

MR. SUTTON: I only have one marked copy. May I refer to this?

THE COURT: You may.

MR. RUSSELL: I think this is precisely in the area --

THE COURT: Tell me which ones you object to.

MR. RUSSELL: Every one of the ones underlined in red there.

THE COURT: All right.

I am going to sustain the objection. To the extent that the jury needs to understand the patent system I will instruct them, and I will receive suggestions from counsel as to the instructions that I should give them.

MR. SUTTON: If the Court please, the next do document I was going to offer into evidence for purposes of showing examing procedure was the forward of the Patent Office Manual of Patent Examining Procedure, which explains the function and duties of examiners.

THE COURT: Same ruling with respect to that. If you want any instructions about that I will give them.

MR. SUTTON: All right.

THE COURT: I am going to instruct the jury that the patent is entitled to a presumption of validity, as I have already indicated and further than that I don't really know how much they need to know about the procedure of the examination of applications.

MR. SUTTON: Your Honor, if the Court please, the only purpose I wanted the jury to know the procedure was for them to know that there is a thorough procedure and routine,and if your Honor will go over that I have no need to pursue that now.

THE COURT: I am not going to characterize the procedure as thorough or slipshod, either way.

MR. SUTTON: The next document I was going to introduce is a publication which illustrates a number of famous patents.

MR. RUSSELL: I think, your Honor, it is in an area that is totally irrelevant to this suit.

THE COURT: May I see the proposed exhibit?

MR. SUTTON: Yes.

THE COURT: I can't imagine the relevancy of this.

MR. SUTTON: If I am able to show the jury that one or more elements, that these devices represented advances in the art and yet comprised combinations of old elements, that was the sole purpose of my introducing them.

THE COURT: If you are going to open up that Pandora's box, then it would be permissible for the defendants to show that some of these patents had been ruled invalid and so on. We will be here until we are all old and gray.

I am going to instruct them, as I have already indicated, that the mere fact that all of the elements of the claimed combination are old does not mean that the combination isn't unobvious and patentable.

MR. SUTTON: I merely want to read from Dr. Musser's deposition. There was only one deposition, the same one I previously referred to that was taken on September 21, 1973 in Studio City, California. On page 112, line 18. Let's start on line 13. I asked Dr. Musser,

"Was the Bell Organ advertised?

"Answer: Extensively.

"Question: Was --

"Answer: May I just elaborate one little degree?

"Question: By all means.

"Answer: For the -- for everybody. Number one, the Bell Organ was taken to Russell Market at Radio City Music Hall and the Rockettes were taught to do a big production, each girl playing one of the organs with the big pipe organ, and it ran for many, many, many weeks. Number two, the Bell Organ was used in a coast-to-coast column by CBS Broadcast with Jackie Gleason and the June Taylor Dancers. Immediately after that, Perry Como produced a one hour show and featured 36 of the Bell Organs in his show.

"Question: Dr. Musser, to the best of your recollection were more than 180,000 Bell Organs sold within the territorial limits of the United States?

"Answer: Sold I don't know.

"Question: All right. What would you estimate, and I recognize that you don't have records to refer to now, but what would you estimate -- "

MR. RUSSELL: Objection.

THE COURT: What ground?

MR. RUSSELL: It is mere speculation on the part of the witness. He said he didn't know.

THE COURT: It is admittedly an estimation. Overruled.

MR. SUTTON: "Answer: Tens of thousands in the United States supported by royalty statements of sales.

"Question: The royalty rate was what in those instances?

"Answer: Five percent.

"Question: Five percent. Were these items sold, the Bell Organ item sold extensively in Great Britain?

"Answer: Yes.

"Question: Were the Bell Organ items sold extensively in South America?

"Answer; Yes.

"Question: Dr. Musser, you are giving testimony today under oath. Is this testimony being given of your own free will? I will develop that further, but I want to get a specific series of questions.

"Answer: Unquestionably.

"Question: Have you been paid by anyone for the testimony that you are giving today?

"Answer; No, indeed I have not."

The final evidence is also from this, page 115, line 6, the next questions concern the Bienengraber patent which is Defendants Exhibit C 3 in this litigation:

"Question: Have you seen this exhibit before?

"Answer: Yes.

"Question: Can you --

"Answer: Not this exhibit, but a --

"Question: Is this exhibit a copy of what you have seen before?

"Answer: It certainly is, here it is.

"Question: Can you please explain to us the nature of the circumstances in which you previously saw what amounts to this Exhibit H?"

And Exhibit H is the deposition exhibit.

"Answer: Restate that question.

"(Read back.)

"Answer: Yes, after having the United States Government use that patent as a reference to the patent which was granted me, I was curious to see what this instrument was like, and I simply obtained -- wrote and obtained a copy and then I had a translation made from the German in order to know more about it and talk intelligently on it, and that is what I am about to do, so you can ask me further questions on it.

"Question: Do you believe that this drawing shown within the single sheet of Exhibit H represents your invention as --

"Answer: No.

"Question: -- disclosed by the patent in suit?

"Answer: No, no. May I amend the answer by telling you why?

"Question: By all means.

"Answer: In my invention and in our claims, our tone producing element, in other words, the tone bar, is mounted on a key. Their tone bar or tone producing element is mounted on a mechanism which is connected with wires which you have to eventually pull. It is very cumbersome. There it is. It is self explanatory, and it is -- even in their terminology, gentlemen, I shall read the German translation. 'The lever presses the tone bar holder.' They call that a tone bar holder up there, and it is entirely remote from the keyboard. We state in our claims, which we can refer to, that the bars are mounted. Our tone elements are mounted on the keys as are yours, as are the Big Mouth and the --

"Question: Melody Bell-O-Phone.

"Answer: Yes, Melody Bell-O-Phone.

"Question: Dr. Musser, is the item disclosed within Exhibit H a toy?

"Answer: Oh, no, indeed no, no, no. It is a massive big thing. It weighs a couple hundred pounds. I saw one in Neuremburg."

If your Honor will give me one second, I will see if I am ready to conclude.

THE COURT: All right.

MR. SUTTON: Your Honor, plaintiffs rest.

THE COURT: Any rebuttal?

MR. RUSSELL: Would this be an appropriate time to take lunch, and I can make whatever rebuttal I might make extremely brief?

THE COURT: Do you know now whether you are going to have any?

MR. RUSSELL: I just wanted to check and see whether there is a point in attacking Dr. Musser's last statement.

THE COURT: I will give you a moment to consult your associate counsel if you want to.

MR. RUSSELL: Thank you.

No rebuttal, your Honor.

THE COURT: We will take our noon break now, and we will come back at two o'clock at which time counsel will make their closing statements and I will give you my final instructions or charge. Don't discuss the case with your fellow jurors or anyone else in the meantime.

(The jury left the courtroom.)

THE COURT: I might say to counsel that the only requested instructions I have on the issue of validity are plaintiffs requested instructions and amendment to defendants proposed charges which list at the end --

MR. RUSSELL: There is a grave error here, your Honor. I had a large instruction that was incorporated. In fact, I am sure you had it because you used it on your instructions on infringement.

THE COURT: Do you have a copy?

MR. RUSSELL: Yes, sir.

THE COURT: Are there any supplemental requests that counsel want to give me?

MR. SUTTON: May I just comment on amendments to defendants proposed charge?

THE COURT: All right.

MR. SUTTON: On page 2, there are three pages in total, if your Honor intends to go into special verdicts on the second page --

THE COURT: No, I do not.

MR. SUTTON: The only other change I requested was in the very last line of this document, disclose the claimed invention as opposed to disclose the invention.

THE COURT: Yes. All right.

MR. SUTTON: I didn't see these validity charges, your Honor.

I would request, your Honor, that without referring to the competence, the nature or the quality that some kind of statement be made to the jurors so that they

will understand that the mere filing of an application does not result in a patent, that there is an examining procedure. I believe you alluded to it previously, but I request that that just be referred to.

THE COURT: Is there any objection to that?

MR. RUSSELL: I think to say that there is a presumption, your Honor, is sufficient. I think there has been much too much dramatization of this examination. Your Honor and I both know, we have been through compact prosecution, that sometimes the examination is slipshod. To characterize this thing in front of this jury as a great fabulous exercise of very great care is misleading.

THE COURT: That comment isn't really responsive to the present situation. The question now before us is whether or not you would object if I tell the jury that not every patent application results in a patent, some patent applications are rejected.

MR. RUSSELL: I think you should say the other end of the scale, and also that the Patent Office makes errors.

THE COURT: I think I should probably tell them both, that the Patent Office does not grant all applications, they reject some, and that all issued patents are not held valid.

MR. SUTTON: That is fine.

THE COURT: Anything further?

MR. RUSSELL: I want to make a motion for a directed verdict, and I assume that this is the appropriate place for it.

THE COURT: This would be the appropriate place for it, and I am going to withhold ruling on it. In other words, I am not going to direct a verdict but I do not preclude the possibility that I will grant a verdict non obstante veredicto.

MR. RUSSELL: You don't wish to hear my reasons at the moment?

THE COURT: No. I think the most prudent course for the Court to follow at this point is to let the jury express its views on the issue.

MR. RUSSELL: Thank you, your Honor.

MR. SUTTON: Your Honor, in the proposed charges of the defendants on page 69, I haven't had a chance to study these, but they do refer to both the independent as well as the dependent claims, and the jury has been presented only with the representative claim number one. I appreciate what we are doing, but I am wondering whether they are going to be considering something that they have never seen.

MR. RUSSELL: I am perfectly willing to let the

validity of the claim stand or fall on claim one. I think it is to your disadvantage to do that. The infringement went on claim one totally. I only put it in that way really expecting your insistence on it. I am not insisting on it. One is good enough as far as I am concerned.

MR. SUTTON: How would we get these other claims before the jury?

THE COURT: I would say your concern about that is a little untimely. I wondered as we were going along whether there was going to be any mention of the other claims. I frankly think that the course of prudence lies in allowing the jury to determine the question of validity of the entire patent on the basis of claim one. Some of the dependent claims add structures that are not in the accused devices such as the resonating columns.

MR. SUTTON: That is correct.

THE COURT: Others add details which are present in the accused device, but are also clearly present in Bienengraber, such as the arms projecting radially from the shaft.

MR. RUSSELL: That is in claim one.

THE COURT: No, claim two.

MR. SUTTON: I am prepared to stipulate right now with counsel that claims four to six and ten and twelve

simply, because of the resonating tone columns, have no business in this lawsuit.

THE COURT: All right. Are you willing to stand or fall on claim one with respect to validity? Let me say this: It would be a more important question if the patent had a long time to run. Since it only has a couple of days to run, it doesn't make any difference.

MR. SUTTON: We will stipulate to do that.

THE COURT: All right. I think that will simplify it for the jury.

(Luncheon recess.)

AFTERNOON SESSION

2:00 p.m.

(In open court. Jury not present.)

THE COURT: Gentlemen, I have been giving further thought to the motion to dismiss which defendants made at the conclusion of the evidence on validity, and I indicated at the time of that motion that I would take it under consideration, and that my disposition at that time was to permit the question to go to the jury. However, on further reflectic I think I would like to hear some argument on that. Particularly I would like to have Mr. Sutton answer this question: The Supreme Court in Graham v. John Deere, 383 US at pages 17 and 18, stated that in determining the issue of validity the Court should first consider the scope and content of the prior art, the differences between the prior art and the ims at issue, and the level of ordinary skill in the pertinent art, and against this background the Court might then consider such secondary considerations as commercial success, long felt but unsolved needs, failure of others and so forth, which might have relevancy as indicia of obviousness or non-obviousness. It seems to me that with respect to the background considerations, that is the scope and content of the prior art, the differences between the prior art and the claims at issue

and the level of ordinary skill in the pertinent art, the evidence is virtually all, if not completely all, documentary in nature. I would like to ask you, Mr. Sutton, what non-documentary evidence is there, either with respect to the background considerations or the so-called secondary considerations on the issue of obviousness?

MR. SUTTON: Your Honor, I have attempted, perhaps unsuccessfully, to rely on testimony in the first portion of the trial of Mr. Ellman, which this jury has heard, the same jury has heard. On reflection during lunch time I asked myself whether or not I should call or request the Court's permission to put Mr. Ellman, the expert that we relied on during the first portion of the trial, on the stand to give his opinion as a toy designer and inventro and one skilled in the art concerning this issue and the differences.

THE COURT: I am not the least bit interested in his testimony about what the prior art is. That is documentary and I can read that fully as well as he can or you can. I am not the least bit interested in his testimony about the differences between the patented invention and the prior art, because that is all documentary and I can read that as well as he can or as well as you can. I am asking you what non-documentary

evidence there is in the record as to those background considerations or as to the secondary considerations?

MR. SUTTON: I believe the testimony of the experts that the defendants have put on is relevant here, because these gentlemen, when they came up with defendants Exhibits F, G and H -- I think the fact that the defendants did not design their own items, yet were seeking to solve this problem, and I think that the evidence produced today, Defendants Exhibits F, G and H, which I question the credibility of because the experts in designing this worked with the assistance of defense counsel and had not only the solution but the patented solution of the problem in their minds when they were working on this problem.

THE COURT: That is not responsive to my question. I am not asking you what non-documentary evidence there is of invalidity. I am asking you what non-documentary evidence there is of validity. In other words, what is there of a non-documentary evidence on which the Court following the standards established by Graham v. John Deere could rule the patent valid?

MR. SUTTON: May I have a second to think about that?

THE COURT: You may.

Let me say this with respect to the charts that

the defendants' witnesses put on. I am sure these were very helpful to the jury in visualizing the changes that were necessary. They were not necessary to me and I am sure they weren't necessary to you in your understanding of the changes that were necessary. If I take the case away from the jury, I won't give any weight at all to that kind of evidence which is based upon documentary evidence, because I can read the patents as well as Dr. Kern can, and so can you. We don't need him to tell us that you can take this element from Patent A and combine it with this element from Patent B and come up with the claim combination. I don't mean to depreciate the value of his testimony to the jury. I am sure it was of great assistance to the jury, but it is a superfluity as far as the determination of that question by a Court experienced in patent law or by yourself, an attorney experienced in patent law.

MR. SUTTON: If I can just have a second.

THE COURT: Yes.

MR. SUTTON: Your Honor, in the time I have to think about this now, the only evidence that comes to my mind and I can advise the Court of at this point is the fact that I think it has been established on the record that none of the prior art, prior to Musser, contained -- in other words, the absence in the prior art prior to

Musser filing his application of a device that did what his device did in the manner in which it did, is evidence that -- the absence of art produced at this trial is evidence that no one prior to him had come up with this specific solution to this problem.

THE COURT: Again, that is documentary, isn't it?

MR. SUTTON: Perhaps I don't know what you are saying, non-documentary.

THE COURT: Let me express it a slightly different way.

The Court of Appeals of this Circuit has ruled in the case of Julie Research Laboratories Inc. against Gill Line Instruments Inc, 501 Fed. 2d, 1131 at 1136, and that is a decision of 1974, that although the preliminary considerations and the secondary considerations prescribed by Graham v. John Deere involve factual determinations, once those factual determinations have been made the resolution of the ultimate question, whether the differences between the claimed invention and the prior art would have been obvious at the time the invention was made to a person having ordinary skill in the art, is a question of law for the Court to determine. And in that case the Court of Appeals reversed a decision of the District Court that the

patent in suit was valid and said, "Even taking the District Court's findings of facts as binding upon us under the Rule 52 A which requires the Court of Appeals to accept those findings unless they are clearly erroneous, the Court of Appeals would make its own determination of the ultimate issue of law, obviousness or lack of obviousness,"and they did so in that case.

We have pretty much the same relationship here between the Court and the jury as there was there between the Court of Appeals and the District Court. What I am really asking you is: What issues of fact are there to go to the jury and what non-documentary evidence is there on which those issues of fact should be determined? If the evidence bearing on those issues is all documentary, and there is no real question about what the prior art shows, what the patent claims are, what the differences are, is there any reason for the Court to let the jury go back to the jury room with those documents instead of having the Court sit down with the documents and apply the legal standards?

MR. SUTTON: MayI just advise my clients?

THE COURT: Yes.

Let me help you a minute before you make a commitment that you may wish later you shouldn't have made.

You haven't pointed out to me any evidence bearing on these issues of facts other than the documentary evidence. But there is one item that in the press of the moment you probably overlooked. There was some testimony by Musser bearing on the question of commercial success. He talked about the Rockettes playing this thing in unison. He talked about exposure on certain television shows and he talked about a substantial volume of sales both here and abroad.

There has been no contradiction or no question concerning that evidence, so I consider it more or less undisputed that the other device shown in the patent, the so-called ~~Melody Bell-O-Phone~~ Bell Organ, did enjoy a substantial degree of commercial success, and I am willing to accept that in my determination.

MR. SUTTON: If you are willing to accept that in your determination, I believe the plaintiffs, the individual plaintiffs, understand the substance of what you have said. At this time I have no further non-documentary evidence that I can present to the Court, so that I believe the Court can now make its determination as to whether or not the jury is to consider this issue of validity.

THE COURT: Do you want to comment on that,

Mr. Russell?

MR. RUSSELL: It is certainly agreeable to me, your Honor. On the issue of commercial success, as I understand it, it is a secondary one and I believe my recollection of the law is that if in cases where validity is adjudged to be a close question it is generally held that commercial success does not tip the balance in that case.

THE COURT: Well, that is --

MR. RUSSELL: That is a matter of law, of course. That is not something for the jury.

THE COURT: What I wanted to hear from you was, number one, do you dispute that the Bell Organ enjoyed significant commercial success and, number two, have the defendants any objection to the Court's taking the issue of validity away from the jury in view of the fact that I am not aware of any other issues of fact than commercial success to be determined in determining the question of validity, and no one has suggested any.

MR. RUSSELL: On commercial success, your Honor, as I understand it there should be a relationship between what brought about the sales and the internal structure which is defined in the claim of the patent. Here I certainly have to agree, I have no evidence to dispute the

fact that the thing went into commercial success. I think your Honor has to weigh, or somebody has to weigh, whether that commercial success was due to the internal structure claim or perhaps to other promotional factors. I think you have all the facts, though, on which a determination of that can be made.

THE COURT: Since there is no evidence which would indicate that the commercial success was due to an overwhelming promotional effort, I will have to assume that the commercial success was due in significant part to the intrinsic merit of the article. That is not to say it was patentable. It is one element that the Courts have said is a secondary consideration in determining validity. You are quite right that the Courts have said where the evidence of invalidity is clear, commercial success can't tip the balance. That is, commercial success alone can't tip the balance.

MR. RUSSELL: On this basis I have absolutely no objection.

THE COURT: Then I take it that both sides are agreeable to calling the jury in and dismissing them?

MR. RUSSELL: Yes.

MR. SUTTON: Yes, your Honor.

(In open court. Jury present.)

THE COURT: I apologize for keeping you waiting. We were discussing a legal matter, but the discussion proved fruitful in that counsel have agreed that with respect to the issue of validity, since there are no disputed issues of fact which the jury needs to resolve, but only a legal issue as to whether or not the facts establish the invalidity of the patent, stated another way whether the facts overcome the presumption of validity that attaches to the issuance of every patent, they have decided to let that matter go to the Court for decision, and to excuse the jury from any further deliberations in the matter.

I want to thank you very much for the obvious attention that you have paid during the trial, and for the obvious care that you gave in deliberating and reaching your decision. As I indicated earlier, I see a lot of juries and I get a fair indication, I think, of whether the jury is a good one or a bad one, and I think we have had a very good one here, far above the average jury in its attentiveness and its intelligence, and I want to thank you very much for your time and your efforts. You can go back to Room 109, if you will, please.

(Jury excused.)

THE COURT: How would you gentlemen like to proceed? Would you like to make final summations to me, would you like to submit post-trial memoranda, or would you like to have me take the matter under advisement on the basis of the evidence, on the basis of the pretrial memoranda and proposed charges, and what I think are your respective contentions?

MR. SUTTON: Speaking for the plaintiffs, your Honor, being that the closing statements don't contain evidentiary matter, I would be prepared to do away with our closing statement and permit your Honor to take this metter under advisement.

MR. RUSSELL: May I confer with my clients, your Honor?

THE COURT: Surely.

MR. RUSSELL: Your Honor, I have had a chance to confer with my clients, and we are of the same mind as the plaintiff. We will rest and leave the case in your hands.

THE COURT: All right. I want to thank counsel on both sides for a very well tried case. I appreciate all your efforts and your cooperation.

MR. SUTTON: Thank you, your Honor.

(Trial concluded.)

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C-1, C-2, C-3		122
F	305	305
G	306	
H	309	